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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION TO:** **1. ROUND 3 DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY UNDER 35 U.S.C. § 112 OF THE '992, '863, AND '702 PATENTS; AND** **2. SATELLITE DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF THE '992, '863, AND '720 PATENTS** Date: TBD Time: TBD Ctrm: 8, 4th Floor Judge: Hon. James Ware

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I. INTRODUCTION

With their motions for summary judgment of invalidity of the '992, '863' and '720 patents ("Yurt Patents"), Defendants ask that the Court hold that, as a matter of law, almost every limitation recited in forty-eight (48) claims are neither enabled nor adequately disclosed by the specification. Defendants' motions are fatally flawed on multiple levels. Fundamentally, however, Defendants have simply failed to show that there exists no material dispute of fact as to whether the claims are invalid by clear and convincing evidence such that summary judgment may be entered as a matter of law.

Tellingly, Defendants' briefs never mention the presumption of validity or Defendants' burden of proof. Instead, Defendants attempt to convince the Court to reject the determinations of patent examiners when examining and issuing the five Yurt patents by finding that the specification of the Yurt patents are deficient in wholesale. In doing so, Defendants provide a litany of alleged deficiencies in the specification, each of which are either (1) features not claimed or required by any construction adopted by this Court and therefore do not require a disclosure in the specification, or (2) information that was well-known to persons of ordinary skill in the art in 1991 or merely minor design details that the Federal Circuit has held repeatedly need not be included in the specification, or both. Underscoring the trivial nature of the defects alleged by Defendants, not once did a patent examiner who issued the Yurt patents ever find there to be a single enablement or written description problem in any of the office actions issued over the near decade of patent examination of the Yurt patents' specification.

Worse, Defendants ask the Court to invalidate these patents based on this minutia without presenting any expert testimony or any other evidence to support their arguments that these examiners were each sweepingly and independently wrong in their issuance of five patents based on this same specification. Rather than presenting competent expert testimony on these critical matters, Defendants rely almost exclusively on the legally irrelevant determinations of the Sarnoff Report, which itself admits to provide no meaningful "evaluation of patentability." Simply put, Defendants have not met their burden sufficient to overcome the heavy presumption of validity and have certainly failed to present the absence of material disputes of fact necessary for entry of summary judgment on these issues. Acacia, on the other hand, has presented expert testimony from Mr. S. Merrill Weiss addressing and rebutting each of Defendants' contentions.

In the absence of undisputed evidence supporting their overreaching invalidity positions, Defendants rely on a variety of misstatements of law and fact, each of which is independently fatal to their motions.

First, by arguing that expert testimony is irrelevant in this case, Defendants contend wrongly that the Court need not consider either the knowledge or level of ordinary skill in the art. Federal Circuit law makes clear that Defendants are flat wrong and that the Court must consider the knowledge of a person of ordinary skill in the art in making the determinations presented by Defendants' motions. Defendants' failure to present any evidence regarding the level of skill in the art and the knowledge of a person of ordinary skill is also, in itself, a sufficient basis to reject Defendants' motions.

Second, Defendants attempt to conflate the written description and enablement requirements. But these are two separate requirements carrying two different legal standards. Defendants' failure to address separately these requirements in itself renders their motions deficient.

Third, Defendants ignore entirely the most significant aspects of the legal standards for enablement and written description. With respect to enablement, the test is whether one of ordinary skill in the art, using his knowledge and the description in the patent would have been able to make and use the claimed invention without undue experimentation at the time that the patent application was filed. Although the focus of the test is on "undue experimentation," Defendants completely ignore the "without undue experimentation" requirement and make no effort to prove it (let alone by the requisite clear and convincing evidence). Defendants also ignore the knowledge of a person of ordinary skill in the art at the time the patent application was filed. With respect to written description, the test is whether the original disclosure of the patent reasonably conveyed to one of ordinary skill in the art that the inventors were in possession of the claimed invention. Defendants ignore this standard, providing no evidence or argument regarding whether the patent disclosure conveys the inventors' possession of the invention to a person of ordinary skill.

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Fourth, Defendants state that a patent specification describing the components of the preferred embodiments primarily in terms of their functions fails to meet the enablement and written description requirements as a matter of law. This is not the law, and Federal Circuit authority makes clear that describing the various components in terms of the functions they perform is perfectly appropriate, particularly in the context of computer-related patents.

Fifth, Defendants predicate their arguments on the false notion that the this Court's claim constructions somehow imported every single component disclosed in every single embodiment the specification into the claims. The Court has never adopted such a construction, and Defendants' mischaracterization of the claim scope throughout their briefs is fundamentally flawed and fatal to their motion.[1]

Sixth, Defendants' motions also address certain indefiniteness questions previously raised by the Court. As to each such question, Acacia has presented expert testimony that one of ordinary skill in the art in 1991 would have understood the claims, when read in light of the specification.

Finally, as a threshold, Defendants fail to appreciate the full implications of this Court's determination that each of the claims is indefinite. This Court cannot reach a determination on enablement or written description as requested by Defendants, because those determinations first require the Court to properly construe the claims. This Court, however, has concluded that the claims are not amenable to construction and are indefinite, and in the absence of properly construed claims, this Court cannot, as a matter of law, reach the enablement and written description issues presented by Defendants.

These fundamental flaws are common and fatal to each of the purported invalidity grounds that Defendants present. The Court should deny Defendants' motions on any of these independent

[1] To the extent the Court believes that its prior constructions do impose such a requirement, Acacia urges the Court to reconsider its constructions. Importing into the claim limitations every aspect of every embodiment disclosed in the specification, including those denoted clearly as "optional" features, violates black letter Federal Circuit law regarding claim construction. This is particularly true where such a construction renders the claims invalid in sweeping fashion, as Defendants contend is the case here.

grounds, and need not consider each of the over-forty purported defects Defendants throw against the wall in the hope that one of them will stick.

Besides these defects common to all of Defendants' arguments, Defendants also misstate the disclosure of the specification as to each of the purported defects raised by Defendants. The Yurt patents easily meet both the written description and enablement requirements as to each of these elements. At a minimum, there exist material disputes of fact precluding the entry of summary judgment of invalidity on all of these grounds.

II. AS THE COURT'S PRIOR CLAIM CONSTRUCTION RULINGS HAVE RENDERED EACH ASSERTED CLAIM INDEFINITE, THERE ARE NO CONSTRUABLE CLAIMS REMAINING AND THE COURT CANNOT, AS A MATTER OF LAW, ANALYZE ANY ENABLEMENT OR WRITTEN DESCRIPTION ISSUES.

As an initial matter, as a result of the Court's claim construction rulings, the parties agree that all of the asserted claims of the Yurt Patents are indefinite and therefore invalid.[2] The fact that the asserted claims are indefinite, and therefore invalid, prevents this Court from properly analyzing the enablement and written description issues raised by Defendants in their motions for summary judgment.[3] Although no Federal Circuit case addresses this issue directly, several Federal Circuit decisions are instructive.

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[2] The parties agree that all of the asserted claims are indefinite, based on the Court's prior holdings that: (1) the terms "identification encoder" and "sequence encoder" are indefinite; (2) the term "transmission system" requires an "identification encoder"; and (3) the term "central processing location" requires a "transmission system." Each asserted claim contains one or more of these terms. (*See*, Acacia's Motion for Summary Judgment, D.I. Nos. 287-289, filed on June 17, 2008 and Round 3 Defendants' Motion at 54:1-23). Although the Court denied Acacia's Motion for Summary Judgment seeking entry of a judgment that the asserted claims are invalid, there is no issue of fact or law that the asserted claims are indeed indefinite based on the Court's constructions and therefore the asserted claims are invalid as a matter of law for that reason.

[3] The invalidity of the asserted claims for indefiniteness is also relevant to Acacia's contention that the Court has no subject matter jurisdiction to consider the alternative grounds of invalidity of lack of enablement, lack of written description, and indefiniteness raised by Defendants' motions. These issues are mooted by the Court's findings of indefiniteness, and the Court would be improperly issuing an advisory opinion as to these alternative invalidity grounds. (*See, e.g.* Joint Stipulation and Case Management Statement, D.I. No. 274 and Reply to Summary Judgment Motion, D.I. No. 311). Acacia continues to object to the Court's jurisdiction to consider this motion

One prerequisite to a determination of whether the enablement and written description requirements of Section 112 have been satisfied is a properly construed claim. *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1253 (Fed. Cir. 2004) ("'Because a patent specification must enable the full scope of a claimed invention, an enablement inquiry typically begins with a construction of the claims.' *AK Steel*, 344 F.3d at 1241."); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) ("The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*.") (emphasis in original); *Amgen, Inc. v. Hoescht Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003)*; see also, The Regents of the University of California v. Micro Therapeutics, Inc.*, 03-CV-05669-JW, 2007 WL 2580594 (N.D. Cal. 2007) ("Thus, the factual analysis [of the written description issue] begins with the claim, properly construed."). By definition, however, a claim that is indefinite is incapable of being construed,[4] and without any construable claims, the Court cannot perform the analysis required to determine whether any claim violates the written description or enablement requirement. *See Honeywell International, Inc. v. ITC*, 341 F.3d 1332, 1342 (Fed. Cir. 2003), *citing, Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

In *Honeywell*, the ITC let stand the determination that certain claims were not infringed, even though the ITC also held that the claims were indefinite. The Federal Circuit, however, vacated the ITC's infringement determination, because no infringement analysis could have been performed, as the claims-at-issue were indefinite and therefore were not construable. The Federal Circuit reasoned that "Because the claims are indefinite, the claims, by definition, cannot be construed … ***Without a discernable claim construction, an infringement analysis cannot be performed***." *Honeywell*, 341 F.3d at 1342 (emphasis added).

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and its opposition to these motions for summary judgment shall not in any way be deemed a waiver of any right for Acacia to object on appeal to the Court's jurisdiction to consider these motions.

[4] To be definite, a person skilled in the art must have been able to understand what is claimed when the claim is read in light of the specification. *Bancorp Services, LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004). Thus, an indefinite claim term is one which cannot be understood by one of ordinary skill in the art.

Although these cases are not directly on point with the situation here, the same logic should apply. Here, an analysis of whether the Yurt patents are valid under 35 U.S.C. §112 for written description and enablement requires properly construed claims. Because the Court has found that all of the asserted claims are indefinite, and thus incapable of construction, the Court cannot determine the written description and enablement issues raised by Defendants. Thus, the Court should deny Defendants' motions for summary judgment without prejudice.

III. DEFENDANTS' FAILURE TO PRESENT ANY EXPERT EVIDENCE IS ALONE SUFFICIENT TO DENY DEFENDANTS' MOTIONS.

Defendants carry a heavy burden with their motions. They must show that there does not exist any material dispute of fact precluding a finding that the Yurt patents are invalid by clear and convincing evidence. Remarkably, Defendants argue that such undisputed evidence exists—justifying the rejection of the determination of five (5) separate patent examinations in wholesale fashion on summary judgment—without presenting any expert testimony in support of their motions. Defendants' reliance on attorney argument alone simply does not suffice for the difficult showing required by Defendants' motions.

A. Defendants Bear the Burden of Proving Invalidity Under Section 112 By Clear and Convincing Evidence.

Defendants are only entitled to summary judgment if they can prove that "there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law" Fed.R.Civ.P. 56(c); *Rockwell International Corp. v. U.S.*, 147 F.3d 1358, 1362 (Fed. Cir. 1998), *quoting*, *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575 (Fed. Cir. 1994) ("The moving party 'bears the burden of demonstrating the absence of genuine issues of material fact.'") To defeat the motion, Acacia, as the opposing party, must "point to an evidentiary conflict created on the record." *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1116 (Fed. Cir. 1985) (*en banc*). In considering Defendants' summary judgment motion, the Court: (1) must view the evidence presented through the prism of the substantive evidentiary burden that would adhere at trial; (2) may not make credibility determinations, and (3) must view all evidence favorably to Acacia, the non-movant, with all doubts resolved and reasonable inferences drawn in Acacia's favor. *Rockwell International*, 147

F.3d at 1361-62, *citing*, *SRI Int'l*, 775 F.2d at 1116; *Anderson v. Liberty Lobby*, 477 U.S. 242, 254, 255 (1986).

Although strikingly absent from Defendants' motions, Defendants must prove invalidity for failure to comply with the written description and enablement requirements **by clear and convincing evidence**. *Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1072 (Fed. Cir. 2005) ("invalidating a claim requires a showing by clear and convincing evidence that the written description requirement has not been satisfied."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 941 (Fed. Cir. 1990) ("Invalidity for lack of enablement … must be supported by facts proved by clear and convincing evidence, for the grant of the patent by the PTO carries with the presumption of validity including compliance with § 112.").

If Defendants fail to meet their burden of proving invalidity due to lack of enablement, lack of written description, and indefiniteness by clear and convincing evidence, the Court must deny Defendants' motions. *See, e.g., Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226, 1239 (Fed. Cir. 2003) (affirming denial of summary judgment motion of non-enablement where accused infringer "failed to show by clear and convincing evidence that a person would be required to engage in undue experimentation to practice the full scope of the claimed invention."); *The Regents of the University of California*, 03-CV-05669-JW, 2007 WL 2580594 (denying summary judgment motion of written description finding that passing reference in background section was sufficient to create factual dispute as to written description); *Intertrust Technologies Corp. v. Microsoft Corp.*, 275 F. Supp. 2d 1031, 1046 (N.D. Cal. 2003) (denying motion for summary judgment of indefiniteness).

B. Each Examiner Who Issued Each Of The Yurt Patents Is Presumed To Have Properly Done His or Her Job In Issuing Each Patent, Including Complying With Specific Examination Requirements Relating To Computer Inventions.

Defendants' motions ask the Court to disregard entirely the deference to which the Patent Office is due for having examined and approving the Yurt Patents' applications ***five times***. Each of these Yurt patents include claims having the terms "transmission system" and/or "reception system" and never once did the Examiners reject any claim for any alleged written description or enablement violation.

Every time that a Yurt Patent application was examined, the patent examiner had a duty to issue only valid patents, which included following the special examining procedures for computer-related applications set forth below. According to the version of the Manual of Patent Examining Procedure ("MPEP") in effect in January 1992 when the first Yurt Patent application was filed, Patent Examiners were instructed (as they always thereafter have been) to examine patent applications to ensure that every standard for patentability is met, before any patent can be issued. (MPEP, 5th Ed., Rev. 13 (Nov. 1989), § 706, at 700-5 to 700-6; Exhibit 1 to Block Declaration)[5] ("Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.")

The MPEP also included a special section devoted exclusively to the examination of patent applications related to computer programming. This section provided clear and unambiguous guidance to examiners regarding the written description and enablement requirements in computer applications. These standards were applied by the five Examiners who considered and issued the Yurt patent applications.

Particularly relevant here is the MPEP's express approval of the description of computer art inventions in the form of block diagrams describing the functions of various components. Defendants predicate their entire motions on the false notion that a specification may not describe components of the preferred embodiments primarily in terms of the functions performed by those components. The MPEP, however, provided specific guidance on how to determine if such functional descriptions are sufficient to meet the requirements of section 112:

> In a typical computer case, **system components are often represented in a "block diagram" format** … In order to meet his

[5] Unless stated otherwise, all references to exhibits as "Exhibit [number]" are to the exhibits attached to the accompanying Declaration of Alan P. Block in Support of Acacia's Opposition to Defendants' Motions for Summary Judgment. All references to exhibits as "Exhibit [letter]" are to the accompanying Declaration of Merrill Weiss in Support of Acacia's Opposition to Defendants' Motions for Summary Judgment. In short, numbered exhibits are attached to the Block Declaration and lettered exhibits are attached to the Weiss declaration.

> burden of establishing a reasonable basis for questioning the adequacy of such disclosure, the examiner should initiate a factual analysis of the system by focusing on each of the individual block element components. More specifically, such an inquiry should focus on the diverse functions attributed to each block element as well as the teachings in the specification as to how such a component could be implemented. **If based on such an analysis, the examiner can reasonably contend that more than routine experimentation would be required by one of ordinary skill in the art to implement such a component or component, that component or components should be specifically challenged by the examiner as part of a 35 U.S.C. § 112, first paragraph rejection** ... In programming applications whose software disclosure only includes a flowchart, as the complexity of functions and the generality of the individual components of the flowchart increase, the basis for challenging the sufficiency of such a flowchart becomes more reasonable because the likelihood of more than routine experimentation being required to generate a working program from such a flowchart also increases.

(MPEP, 5th Ed., Rev. 13 (Nov. 1989), § 2106.02, at 2100-5 to 2100-7; Exhibit 2 to Block Declaration). The Court must presume that the examiners who examined and issued each of the five Yurt Patent applications considered and followed these requirements. *See, American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984) (accused infringer "has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.").

C. Expert Testimony Is Critical To The Determinations Required By Defendants' Motions.

Defendants suggest that they need not present any expert testimony in support of their motions and that the Court should disregard completely the knowledge of a person or ordinary skill in the art. But the Federal Circuit has repeatedly made clear that, when assessing compliance with the written description and enablement requirements, the Court must understand what information was conveyed to the person of ordinary skill in the art at the time of the filing of the original disclosure.

For written description, expert testimony is critical for determining if the original disclosure conveys to a person of ordinary skill in the art that the inventors had possession of the claimed invention. *See, Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004) ("However, the Board never truly discussed the understandings of persons skilled in the art and whether Bilstad's written description would reasonably convey to a person skilled in the art that Bilstad had possession of the claimed subject matter at the time of filing."); *Moba v. Diamond Automation Systems, Inc.*, 325 F.3d 1306, 1320 (Fed. Cir. 2003) ("The possession requires assessment from the viewpoint of one of skill in the art.") (emphasis added); *Vas-Cath, Inc. v. Mahurkar,* 935 F.2d 1555, 1566 (Fed. Cir. 1991) ("Consideration of what the drawings conveyed to persons of ordinary skill is essential."); *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 1000-1001 (Fed. Cir. 2000) ("In written description cases, 'the primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure."). Indeed, the Federal Circuit has held that an unrefuted expert declaration as to the understanding of one of ordinary skill in the art is sufficient to defeat a motion for summary judgment seeking to invalidate patent claims for an alleged violation of the written description requirement. *Vas-Cath,* 935 F.2d at 1566 ("We hold that the Ash declaration and Vas-Cath's non-refutation thereof, without more, gave rise to a genuine issue of material fact inappropriate for summary disposition."); *see Hesston Corp. v. Sloop*, 1988 U.S. Dist. LEXIS 1573, *13 (D. Kansas) (summary judgment on § 112 'written description' issue inappropriate where resolution of what parent disclosure conveyed to those skilled in the art may require examination of experts, demonstrations and exhibits.")

For enablement, such expert testimony is essential for determining if undue experimentation is needed to make or use the claimed invention from the disclosure in the specification. This is because a patent specification preferably omits what was already known by one of ordinary skill in the art at the time of filing of the patent application. *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986). ("Furthermore, a patent need not teach, and preferably omits, what is well known in the art."); *Northern Telecom,* 908 F.2d at 931; *Christianson v. Colt Industries Operating Corp.*, 822 F.2d 1544, 1562 (Fed. Cir. 1987) *rev'd on other grounds,* 486 U.S. 800 (1988). The Federal Circuit's decision in *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1155 (Fed. Cir. 2004) made clear that a patent specification which omits implementation details can still meet the enablement requirement: "This Court has repeatedly explained that a patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art. We thus have noted that not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be. Unless there is evidence to the contrary, therefore, the lack of certain production details does not indicate failure of enablement." *Id.* (citations and quotation marks omitted); *see also*, *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004) ("As noted above, a patent disclosure need not enable information within the knowledge of an ordinary skilled artisan.").

In an effort to justify their failure to provide any expert testimony, Defendants contend that, as a matter of law, expert testimony "with respect to the ability of one skilled in the art to use the specification to make a 'transmission system' is irrelevant" to the written description and enablement analyses. (Round 3 Defendants' Motion, at 30:12-13). But as the Federal Circuit has held, "[u]nsubstantiated attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony." *Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1068 (Fed. Cir. 2005); *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.").

Not only do Defendants fail to recognize the importance of expert testimony to the determinations at issue here, Defendants go a step further making the claim that such evidence is "irrelevant," citing *Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1283 (Fed. Cir. 2007). (Round 3 Defendants' Motion, at 30:11-18). Defendants' contention misstates the holding of *Auto. Techs.* and ignores scores of Federal Circuit authority finding that expert testimony is critical in both the written description and enablement determinations. *Northern Telecom*, 908 F.2d at 941; *Elan Pharms., Inc. v. Mayo Found.*, 346 F.3d 1051, 1055 (Fed. Cir. 2003); *National Recovery Techs., Inc. v. Magnetic Separation Sys. Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999). Indeed, no Federal Circuit case, including *Auto. Techs.*, has ever held that expert testimony is irrelevant to the written description and enablement determinations. The Federal Circuit's decision in *Auto. Techs.* itself relies on the accused infringer's expert's declaration in determining that undue experimentation would have been required to make and use an electronic side impact sensor. *Auto. Techs.*, 501 F.3d at 1284 ("the district court properly relied on testimony from Delphi's expert [that]

… discussed at length how a 'great deal of experimentation' would have been necessary to make an electronic side impact sensor after reading the specification of the '253 patent.").

Defendants' contention that the knowledge available to the person of ordinary skill in the art is also irrelevant is also based upon a single sentence, taken out of context, from *Genentech, Inc. v. Norvo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997) ("the specification, not the knowledge of one skilled in the art … must supply the novel aspects of an invention in order to constitute adequate enablement.") (Round 3 Defendants' Motion, at 7:9-11). But this is not the holding of *Genentech* or any other Federal Circuit decision. In *Genentech*, the Court found that the enablement requirement was not met, because one of ordinary skill in the art would have had to engage in undue experimentation. *Genentech*, 108 F.3d at 1365 ("The question before us is whether the specification would have enabled a person having ordinary skill in the art at the time of filing to use cleavable fusion expression to make hGH without undue experimentation.") (emphasis added). The Court based this conclusion on the fact that the claimed invention was related to the field of biotechnology, which was unpredictable at that time. *Genentech*, 108 F.3d at 1367-68. In so holding, the Federal Circuit considered the knowledge of a person in skill in the art, but concluded that it was insufficient in that field to fill the specification's failure to provide any specific starting material or of any conditions under which the claimed process could be carried out. *Genentech*, 108 F.3d at 1366. This is in sharp contrast to the present computer-related invention, wherein the technology is developed and predictable.

Defendants also rely on *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002). Like *Genentech*, the *Enzo* case involved the unpredictable art of biochemistry. The Court emphasized that its holding cannot apply to other arts: "Compliance with the written description requirement is essentially **a fact-based inquiry that will necessarily vary depending on the nature of the invention**." *Id.* at 963 (emphasis added). Even in this unpredictable field, however, the Federal Circuit expressly rejected the proposition propounded by Defendants that functional descriptions are necessarily insufficient: "**It is not correct, however, that all functional**

description of genetic material fails to meet the written description requirement." *Id*. at 964 (emphasis added).[6]

Defendants also rely heavily the Federal Circuit decision in *Sitrick v. Dreamworks, LLC*, 516 F.3d 993 (Fed. Cir. 2008) for the contention that this Court may find the Yurt patents invalid without any evidence. But in *Sitrick*, the Federal Circuit predicated its decision almost entirely on the testimony of defendants' two experts stating that modifying the claimed invention from video games (disclosed in the specification) to movies would be a task outside the knowledge of one skilled in the art. *Id.* at 999-1001 ("Defendants supported their motion for summary judgment of invalidity by reference to the teachings of the specifications and the opinions of their two experts … Defendants' two experts explained that one skilled in the art would not be able to take the teachings regarding video games and apply them to movies."). Unlike the defendants in *Sitrick*, Defendants here have presented no expert testimony regarding what a person of ordinary skill in the art would or would not understand from reading the Yurt patent specification, and *Sitrick*, therefore, is unavailing to Defendants' motions.

Also, conspicuously absent from Defendants' motions is any discussion, let alone evidence, as to the level of ordinary skill in the art to which the Yurt Patents pertain. The level of ordinary skill in the art "is a factual question that must be resolved and considered." *Ryko Manufacturing Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991); *Abbott Laboratories v. Diamedix Corp.*, 969 F.Supp. 1064, 1070 (N.D. Ill. 1997) (denying motion for summary judgment on the issue of enablement where "a genuine issue exists as to who the person of ordinary skill in the field of art was as of the date of invention."). Absent evidence of the understanding of one skilled in the art, or even what level of skill that person would have had, Defendants have not met their burden of proving, by clear and convincing evidence, any violation of the written description and enablement requirement. Defendants' summary judgment motions should be denied on this basis alone.

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[6] Defendants also cite *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916 (Fed. Cir. 2004). In *Rochester*, however, the Federal Circuit based its decision on the patentee's failure to present expert testimony. *Id.* at 929 ("[Patentee] has not provided evidence that any such compounds were otherwise within the knowledge of a person of ordinary skill in the art."). Here, Acacia has presented detailed expert testimony regarding the knowledge of one skilled in the art.

D. The Sarnoff Report Is Inadmissible and Is No Substitute For Competent Expert Testimony.

Having presented no expert testimony, Defendants' motions rely heavily on the so-called Sarnoff Report as proof that the Yurt Patent specification was lacking certain details. But the Sarnoff Report is inadmissible and cannot be relied upon as a basis for summary judgment, because: (1) it is irrelevant to any issue of invalidity in this case under Fed.R.Evid. 402, (2) it is purported expert opinion testimony that does not meet any of the criteria for admission of such testimony under Fed.R.Evid. 702, and (3) it is inadmissible hearsay. Fed. R. Evid. 802-803. The same admissibility requirements apply to summary judgment motions as at trial. Fed. R. Civ. P. 56(e)(1).

The first paragraph of the Sarnoff Report, ignored by Defendants, states that it "**is not intended as an expert evaluation of patentability**." (Sarnoff Report, at 2). Nowhere in the Sarnoff Report does the author provide any opinion regarding the applicable legal standards for written description or enablement. In fact, by stating that it is not intended as an evaluation of patentability, the Sarnoff Report indicates that neither the legal tests for written description nor enablement were considered.[7] Instead, the Sarnoff Report author appears to evaluate whether the disclosure provides a step-by-step manual for manufacturing a video-on-demand system, but of course, a patent specification is not required to make such a disclosure.

Also, there is no evidentiary foundation for the veracity of the opinions of the Sarnoff Report, given that there is no evidence whatsoever regarding the author's qualifications to render those opinions. Further, the Sarnoff Report does not describe the facts or data used by the author to reach these alleged opinions, and therefore it is impossible to determine whether the alleged opinion is the product of reliable principles and methods. Fed.R.Evid. 702. Moreover, the Sarnoff Institute had every incentive to conclude that Yurt's disclosure needed additional research and development,

[7] Indeed, it would have been legally impossible for the author of the Sarnoff Report to have opined as to either written description or enablement, as both require examination of the properly construed, claimed invention. *Vas-Cath*, 935 F.2d at 1563; *Chiron*, 363 F.3d at 1253. The Sarnoff Report is dated April 17, 1992, which is after the initial filing date of the first-filed application (January 7, 1991), but before any of the Yurt Patents had issued. Therefore, the author of Sarnoff Report could not have been aware of any of the claimed inventions, as no patent claims were issued as of April 17, 1992, and certainly none were properly construed.

as the Sarnoff institute stood to profit greatly from Yurt's hiring of Sarnoff to help develop the disclosed inventions. The Sarnoff Report is therefore inadmissible, or at a minimum, entitled to very little weight, for purposes of Defendants' motions.

Not only is the Sarnoff report legally irrelevant and inadmissible, Defendants mischaracterize its content by cherry-picking only helpful portions of the report. For instance, the author of the Sarnoff Report stated that the Yurt patent application "outlines a comprehensive architecture for a video-on-demand system." (Sarnoff Report, Exhibit A to Benyacar Decl.; at 2). The author also made clear that the technology for video-on-demand systems was developed and predictable:

> Concepts for such video-on-demand systems have been under discussion in the telecommunication and video delivery industries for the last 5 – 10 years. While specific implementations may vary, the key building blocks of a video-on-demand system are: (a) a large digital video/audio library with appropriate logical organization, data compression, rapid access and multiple I/O capabilities; (b) a "head end" inquiry/response switching system capable of interpreting, packaging and switching subscriber requests for video/audio material; (c) a high-speed transmission system capable of timely and reliable delivery of digital information to subscribers; and (d) a subscriber receiving and storage unit capable of receiving the requested video/audio, decompressing information where necessary, and presenting the information to the user (with appropriate features such as schedule delivery, fast forward/reverse, scan, etc.)
>
> * * *
>
> Similar concepts for storing, accessing, transmitting and displaying compressed video and audio information are **widely understood by researchers** in the telecommunication and multimedia fields. In some cases, these concepts have also been **demonstrated in practice**, such as the MPEG-based video-on-demand/interactive multimedia prototype currently being shown at Bell Communications Research, Morristown by Dr. A. Gelman.

(Sarnoff Report, Exhibit A to Benyacar Decl.; at 2-3) (emphasis added). Thus, the Sarnoff report does nothing to help Defendants carry their burden.

IV. THE PROPER LEGAL STANDARDS TO BE APPLIED BY THE COURT WHEN CONSIDERING THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS.

In their motions, Defendants rely on a false description of the controlling Federal Circuit law regarding whether the written description and enablement requirements have been met. One of the many errors made by the Round 3 Defendants in their motion is that they analyze the written description and enablement under the same (incorrect) legal standard. This is impermissible.

The Federal Circuit has repeatedly emphasized that the written description and enablement requirements are distinct and that each must be analyzed separately based on the factors relevant to that particular requirement (as set forth below). *See, Vas-Cath* at 1563 ("35 U.S.C. § 112, first paragraph, requires a 'written description of the invention' ***which is separate and distinct from the enablement requirement***.") (emphasis added); *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 921 (Fed. Cir. 2004) (same); *see also*, *The Regents of the University of California*, 03-CV-05669-JW, 2007 WL 2580594 (N.D. Cal. 2007, Ware, J.) ("the 'written description' requirement is distinct and independent from the 'enablement' and 'best mode requirement.'"). The Federal Circuit has never held that the written description and enablement requirement can or should be analyzed together under the same legal standard, and Defendants do not point to any case so holding.[8] Defendants' improper conflating of the written description and enablement requirement is, in itself, fatal to their motion. Without providing any evidence, or even attorney argument, properly addressing these requirements separately and distinctly, as required by the Federal Circuit, Defendants cannot possibly have established that no factual dispute exists with respect to

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[8] The Round 3 Defendants rely on nothing more than the *dicta* in *LizardTech, Inc. v. Earth Resources Mapping, PTY, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) that written description and enablement "usually rise and fall together." (Round 3 Defendants' Motion, at 9, n 7). The fact that, in some cases, the written description and enablement requirements may rise and fall together does not mean that they can or should be analyzed together under the same standard. Indeed, it is possible for a patent claim to meet the written description requirement, but not meet the enablement requirement, and vice versa. *See, University of Rochester*, 358 F.3d at 921 ("Thus, an invention may be described without an enabling disclosure of how to make and use it…. Moreover, an invention may be enabled even though it has not been described."); *The Regents of the University of California*, 03-CV-05669-JW, 2007 WL 2580594 (same).

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Defendants' heavy burden of proving invalidity by clear and convincing evidence such that summary judgment may be entered.

A. The Federal Circuit Standards For Analyzing the Written Description Requirement

The written description of 35 U.S.C. § 112, ¶ 1 provides that"[t]he specification shall contain a written description of the invention." The Federal Circuit has consistently stated the written description standard as follows: "Although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Vas-Cath, Inc.*, 935 F.2d at 1563 (citations and quotation marks omitted). Thus, to determine whether Defendants have established that the asserted claims fail to satisfy the written description requirement, the Court must: (1) compare the "original disclosure" of the patent application to the properly construed, "later claimed subject matter"[9]; and (2) determine whether Defendants have shown, by clear and convincing evidence, that the "original disclosure" did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed[10], that the inventors were in possession of the invention (*i.e.*, the claimed subject matter).

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[9] The claimed subject matter is the claim as a whole, not just the "novel" or "important" portion of the claim: "We find the district court's concern with 'what the invention is' misplaced, and its requirement that the '081 drawings 'describe what is novel or important' legal error. There is 'no legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent.' *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345, 5 L. Ed. 2d 592, 81 S. Ct. 599 (1961). 'The invention' is defined by the claims on appeal." *Vas-Cath*, 935 F.2d at 1565.

[10] *In re Koller*, 613 F.2d 819, 823-24 (C.C.P.A. 1980) ("Compliance with § 112, paragraph one, is to be judged as of the date the application is filed.")

1. Whether The Written Description Requirement Has Been Met Is A Highly Intensive Factual Inquiry Determined On A Case-By-Case Basis And May Be Satisfied With Primarily Functional Descriptions.

Whether the written description requirement has been met is a highly intensive factual inquiry determined on a case-by-case basis. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) ("written description questions are intensely factual, and should be dealt with on a case-by-case basis, without the application of wooden rules.... Because of the fact-sensitive nature of the written description inquiry, this court has often warned against misapplication of precedents in this area."). In *Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005), the Federal Circuit explained that the written description requirement "is applied to each invention in view of the state of relevant knowledge, [and] its application will vary with differences in the state of knowledge in the field and differences in the predictability of the science … The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge."

In the context of computer-related patents, the Federal Circuit has held that disclosure of a microprocessor capable of performing certain functions may be sufficient to satisfy the written description requirement of section 112, first paragraph. *In re Hayes Microcomputer Products, Inc.*, 982 F.2d 1527, 1534 (Fed. Cir. 1992). In *Hayes*, the Federal Circuit found the functional description of a patent relating to the computer arts was sufficient under section 112. The Federal Circuit explained that "an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains." *Id.* In the context of computer arts, the Court held that "[d]isclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of § 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out." *Id.*

Further, because of the fact-intensive nature of the written description requirement, the "original specification" can meet the written description requirement in any manner and with any length of text. *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976) ("The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; ***how the specification accomplishes this is not material***.") (emphasis added), *citing*, *In re Smith*, 481 F.2d 910 (C.C.P.A. 1973); *Hayes Microcomputer*, 982 F.2d at 1534 ("While some inventions require more disclosure, the adequacy of the description of an invention depends on its content in relation to the particular invention, not its length."); *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002) ("While the contested language is not a model of clarity, it is also fairly simple and intelligible, capable of being understood in the context of the patent specification. It is thus reasonably clear what the invention is and that the patent specification conveys that meaning."); *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (written description requirement can be met "by such descriptive means as words, structures, figures, diagrams, formulas, etc.").

The written description requirement may be met when the claimed subject matter is ***inherently*** contained in the original application. *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352 (Fed. Cir. 2000) ("The fundamental inquiry is whether the material added by amendment was inherently contained in the original application."); *Tronzo v. Biomet, Inc*., 156 F.3d 1154, 1159 (Fed. Cir. 1998) ("In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure."), *citing, Continental Can Co. USA v. Monsanto Co*., 948 F.2d 1264, 1268 (Fed. Cir. 1991)

Moreover, when considering whether the written description requirement has been met, the originally-filed claims are considered part of the "original disclosure" to be compared against the claimed invention. *Union Oil*, 208 F.3d at 998; *In re Koller*, 613 F.2d at 819 ("In *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (C.C.P.A. 1973), this court noted that original claims constitute their own description. Later added claims of similar scope and wording are described thereby.")[11] In both of their motions, Defendants ignore the originally-filed claims of the Yurt Patents, even though they are part of the "original disclosure," which the Court must compare to the "later claimed subject matter." As Acacia demonstrates, these originally-filed claims (*See,* Exhibit 3 to Block Decl.) provide some of the support satisfying the written description as to certain elements of the asserted claims.

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[11] That the original disclosure must include the originally-filed claims is consistent with the fact that the standard for determining compliance with the written description requirement requires that the Court compare the original disclosure to the "***later claimed*** subject matter." *Vas-Cath Inc.*, 935 F.2d at 1563 (emphasis added). Thus, because the originally-filed claims are part of the original disclosure, the written description requirement only comes into play where claims not presented in

2. There Is No Requirement That The Original Disclosure Describe Every Detail of the Invention to Comply With The Written Description Requirement.

Although Defendants predicate most of their arguments on the notion that every aspect of the invention be described in the specification, no matter how trivial, there is no requirement that the original disclosure describe every detail of the invention. "It is unnecessary to spell out every detail of the invention in the specification; ***only enough must be included*** to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation." *LizardTech*, 424 F.3d at 1345 (emphasis added); *See also, Hybritech*, 802 F.2d at 1384; ("a patent need not teach, and preferably omits, what is well known in the art."); *Koito Mfg. Co.,* 381 F.3d at 1155 ("This Court has repeatedly explained that a patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art."). The Federal Circuit, in *Christianson v. Colt Industries Operating Corp.,* explained why the original disclosure need not describe every detail of an invention: "Patents are not production documents and nothing in the patent law requires that a patent must disclose data on how to mass-produce the invented product … And that is well, for such a requirement would be irrational." *Christianson v. Colt Industries Operating Corp.,* 822 F.2d 1544, 1562 (Fed. Cir. 1987).

The Round 3 Defendants attempt to convince the Court into adopting this "irrational" view of the law by contending that 35 U.S.C. §112 requires that a patent disclosure be a "blueprint." (Round

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the originally-filed application are presented thereafter, and in other similar situations. *Vas-Cath*, 935 F.2d at 1560 ("The cases indicate that the 'written description' requirement most often comes into play where claims not presented in the application when filed are presented thereafter."); *See also, Moba*, 325 F.3d at 1319 ("Since then [1981], this court has continued to use § 112 to ensure that a patentee had possession at the time of filing of subject matter ***subsequently*** claimed.") (emphasis added).

3 Defendants' Motion, at 2:13-15. The Court should reject Defendants' mischaracterizations of the applicable law.

Likewise, there is no requirement that the original disclosure describe every conceivable embodiment of the claimed invention to comply with the written description requirement. *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003) ("As our case law makes clear, however, an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention.") (citations and quotation marks omitted).

Moreover, contrary to Defendants' contentions, reciting claims that are more broad than the embodiments described in the specification is permissible, and is in fact, common. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) ("that a claim may be broader than the specific embodiment disclosed in the specification is in itself of no moment.") (quoting *In re Rasmussen*, 650 F.2d 1212, 1215 (C.C.P.A. 1981)); *see also, The Regents of the University of California*, 03-CV-05669-JW, 2007 WL 2580594 ("However, there is no general proposition in patent law that the written description requirement is violated if the original description is narrower than a broad claim."). The predecessor to the Federal Circuit, in *In re Smythe*, described a situation in which a narrow disclosure of a single embodiment could support a broader, later-filed claim, and comply with the written description requirement. *In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973) ("The broader claim language would be permitted because the description … would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a [invention] … regardless of its composition."); *See also, Bilstad*, 386 at 1124 ("Thus, this court has continued to apply the rule that disclosure of a species may be sufficient written description support for a later claimed genus including that species."). There is also no requirement that the original disclosure include examples covering the full scope of the "later claimed subject matter" to comply with the written description requirement, as Defendants claim. *See, LizardTech*, 424 F.3d at 1345 ("A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language."), *citing*, *Union Oil*, 208 F.3d at 997; *Falkner v. Inglis*, 448 F.3d 1357, 1365-66 (Fed. Cir. 2006) ("We conclude that the Board applied correct law. Specifically, we hold, in accordance with our prior case law, that … examples are not necessary to support the adequacy of a written description….”).

B. The Federal Circuit Standards for Analyzing the Enablement Requirement

1. A Broad Patent Claim May Be Enabled By Disclosure In The Specification Of A Single Embodiment.

The enablement requirement is set forth in 35 U.S.C. § 112, ¶ 1, which provides: “The specification shall contain a written description of the invention, and the manner and process of making and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected to make and use the same …” The Federal Circuit has repeatedly held that “[a] decision on the issue of enablement requires determination of whether a person skilled in the pertinent art, using the knowledge available to such a person and the disclosure in the patent document, could make and use the invention without undue experimentation. It is not fatal if some experimentation is needed, for the patent document is not intended to be a production specification.” *Northern Telecom*, 908 F.2d at 941; *National Recovery Techs.*, 166 F.3d at 1196 (“The scope of enablement is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.”); *Chiron*, 363 F.3d at 1253 (“Because a patent specification must enable the full scope of a claimed invention, an enablement inquiry typically begins with a construction of the claims.”) (quoting *AK Steel*, 344 F.3d at 1241.). “Enablement is determined from the viewpoint of persons of skill in the field of the invention at the time the patent application was filed.” *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345 (Fed. Cir. 2000); *Hybritech*, 802 F.2d at 1384 (“[Enablement] is determined as of the filing date of the patent application.”); *Chiron*, 363 F.3d at 1254 (Fed. Cir. 2004) (“a patent document cannot enable technology that arises after the date of application. The law does not expect an applicant to disclose knowledge invented or developed after the filing date. Such disclosure would be impossible.”), *citing*, *In re Hogan*, 559 F.2d 595, 605-06 (C.C.P.A. 1977).

The Round 3 Defendants’ articulation of the “enablement” standard at 7:4-8 of their motion is inaccurate and misleading. According to Defendants: “[t]he enablement requirement demands that the patent specification teach one skilled in the art how to make and use the full scope of the claimed invention." At best, this statement of the enablement standard leaves the false impressions that: (1) the knowledge available to the person of ordinary skill in the art is irrelevant (it is not), and (2) no experimentation is permissible in order to meet the enablement requirement (experimentation is permissible, so long as it is not undue experimentation). *See, Amgen*, 314 F.3d at 1334 ("The enablement requirement is often more indulgent than the written description requirement. The specification need not explicitly teach those in the art to make and use the invention; the requirement is satisfied if, given what they already know, the specification teaches those in the art enough that they can make and use the invention with 'undue experimentation.'").

Inexplicably, Defendants do not discuss the "without undue experimentation" requirement at all.[12] As the Federal Circuit has made perfectly clear, to prevail on a motion for summary judgment for lack of enablement, the moving party must show by clear and convincing evidence that one of ordinary skill in the art would be required to engage in undue experimentation to practice the full scope of the claimed invention. *See, Bristol-Myers Squibb*, 326 F.3d at 1239 ("The district court denied Bristol's summary judgment motion for lack of enablement because it failed to show by clear and convincing evidence that a person of ordinary skill in the art would be required to engage in undue experimentation to practice the full scope of the claimed invention."). Defendants' failure to even address the issue of undue experimentation, let alone actually demonstrate by clear and convincing evidence that undue experimentation would be needed, by itself, shows that Defendants have not met their burden of proof, which is fatal to their motions for summary judgment.

Moreover, a broad claim may be enabled by a single embodiment. "If an invention pertains to an art where the results are predictable … a broad claim can be enabled by disclosure of a single embodiment, and is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed." *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987) (citations omitted); *Engel Industries, Inc. v. The Lockformer Co.*, 946 F.2d 1528, 1533 (Fed. Cir. 1991) ("The enablement requirement is met if the description enables any mode of making and using the claimed invention.")[13]

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[12] In their articulation of the enablement standard, the Round 3 Defendants selectively crop the language of the Court in *In re Vaeck*, 947 F.2d 488, 496 (Fed. Cir. 1991) that makes clear that a patent claim is enabled, unless undue experimentation is required: "This means that the disclosure must adequately guide the art worker to determine, ***without undue experimentation***, which species among all those encompassed by the claimed genus possess the disclosed utility." *Id.* (emphasis added).

2. Whether Undue Experimentation Is Required Is A Conclusion Reached By Weighing A Number Of Fact-Intensive Factors.

"The fact that some experimentation is necessary does not preclude enablement; what is required is that the amount of experimentation 'must not be unduly extensive.'" *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1564 (Fed. Cir. 1996) (quoting, *Atlas Powder Co. v. E.I. DuPont De Nemours & Co.*, 750 F.2d 1569, 1576 (Fed. Cir. 1984)); *In re Wands*, 858 F.2d at 736-37 (Fed. Cir. 1988) ("Enablement is not precluded by the necessity for some experimentation … The key word is 'undue,' not 'experimentation.'"). Whether the experimentation by the person of ordinary skill in the art is undue is "not a single, simple factual determination, but rather is a conclusion reached by weighing many factual determinations." *Warner-Lambert Co. v. Teva Pharmaceuticals USA, Inc.*, 418 F.3d 1326, 1337 (Fed. Cir. 2005) (quoting *Wands*, 858 F.2d at 737.). The factors used for this determination are referred to as the *Wands* factors: "(1) the quantity of the experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims." *Warner-Lambert*, 418 F.3d at 1337. "A considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a

[13] *See also, U.S. v. Telectronics, Inc.*, 857 F.2d 778, 786 (Fed. Cir. 1988) ("Since one embodiment is admittedly disclosed in the specification, along with the general manner in which its current range was ascertained, we are convinced that other permutations of the invention could be practiced by those skilled in the art without undue experimentation. *See SRI Int'l*, 775 F.2d at 1121 (the law does not require an applicant to describe in his specification every conceivable embodiment of the invention).")

reasonable amount of guidance with respect to the direction in which the experimentation should proceed." *In re Wands*, 858 F.2d 731, 736-37 (Fed. Cir. 1988) (quoting *In re Jackson*, 217 U.S.P.Q. 804, 807-08 (Bd. App. 1982).). "The determination of what level of experimentation is 'undue,' so as to render a disclosure non-enabling, is made from the viewpoint of persons experienced in the field of the invention." *Elan Pharmaceuticals*, 346 F.3d at 1055..

Thus, enablement is based on a factually intensive underlying inquiry[14] regarding the amount of experimentation required, and these factual inquiries are to be evaluated on a case-by-case basis. *AK Steel*, 344 F.3d at 1245 ("However, whether a patent complies with the enablement requirement depends upon a factually intensive inquiry regarding the amount of experimentation required, *see Wands,* 858 F.2d at 737, an issue to be evaluated on a case-by-case basis."); *CFMT, Inc. v. Yieldup International Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003) ("The level of disclosure necessary to satisfy section 112 of title 35 varies according to the scope of the claimed invention."). The determination of the enablement issue is an objective one and enablement may be demonstrated "through broad terminology or illustrative examples." *Wright*, 999 F.3d at 1561; *Wands*, 858 F.2d at 736-37 ("'The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art.'"), *quoting*, *In re Jackson*, 217 U.S.P.Q. 804, 807-08 (Bd. App. 1982).

As with the written description requirement, Defendants predicate their enablement arguments on the false notion that primarily functional descriptions are inadequate as a matter of law. But the Federal Circuit has held that in the context of the art to which the Yurt patents relate (computers), enablement may be satisfied by the disclosure of the general functionality of the components. In *Northern Telecom*, the Federal Circuit explained that "[t]he amount of disclosure that will enable practice of an invention that utilizes a computer program may vary according to the nature of the invention, the role of the program in carrying it out, and the complexity of the contemplated programming, all from the viewpoint of the skilled programmer. The claimed invention…is not in the details of the program writing, but in the apparatus and method whose patentability is based on the claimed combination of components or steps." *Northern Telecom*, 908 F.2d at 941. Indeed, the Federal Circuit has expressly held that implementing a function described in a patent specification via a computer, as the Yurt patents do, does not require undue experimentation:

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[14] The Round 3 Defendants' motion leaves the misimpression that enablement is only a question of law. (*See*, Round 3 Defendants' Motion, at 8:15-16). The cases cited by Defendants and those cited herein, however, make clear that, although enablement is question of law, it is based on underlying facts. *See, e.g.*, *Sitrick*, 516 F.3d at 999 ("Whether a claim satisfies the enablement requirement of 35 U.S.C. § 112, ¶ 1 is a question of law, reviewed *de novo*, based on underlying facts, which are reviewed for clear error."), *citing*, *AK Steel*, 344 F.3d at 1238-39.

> In assessing any computer-related invention, it must be remembered that programming is done in a computer language. The language is not a conjuration of some black art, it is simply a highly structured language. Analogously, if a person were to express a complete thought in German, it would be no trick for a translator to convert that thought into a palpable English form. The thought, thus expressed, may not be worthy of Shakespeare, but it would be understandable to one who uses the English language. Similarly, the conversion of a complete thought (as expressed in English and mathematics, i.e., the known input, the desired output, the mathematical expressions needed and the methods of using those expressions) into the language a machine understands is necessarily a mere clerical function to a skilled programmer.

In re Sherwood, 613 F.2d 809, 817 n 6 (C.C.P.A. 1980).[15]

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[15] *See also, Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997) ("As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. It is well established that what is within the skill of the art need not be disclosed to satisfy the best mode requirement as long as that mode is described. Stating the functions of the best mode software satisfies that description test.")

V. ASSUMING *ARGUENDO* THAT THE ASSERTED CLAIMS WERE CONSTRUED, THE "TRANSMISSION SYSTEM" AND "RECEIVING SYSTEM" OF THE ASSERTED CLAIMS, AND THEIR CONSTITUENT COMPONENTS, MEET THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS.

In this Section, Acacia demonstrates that the "transmission system" and "receiving system," as construed by the Court and their constituent components meet both the written description and enablement requirements. At a minimum, Acacia demonstrates that there exist material disputes of fact such that summary judgment is inappropriate. In doing so, Acacia assumes, *arguendo*, that the claims were construed and have a definite meaning. In subsection A., Acacia addresses the "transmission system." For each component of the "transmission system," Acacia separately addresses the written description requirement and then the enablement requirement for that component. Thereafter, Acacia addresses each of Defendants' specific contentions, one by one. In subsection B., Acacia addresses the same issues in the same manner for the "receiving system."

A. Each Of The Components Of The "Transmission System" Meets The Written Description And Enablement Requirements.

In its Sixth Claim Construction Order, the Court construed the claim term "transmission system" to mean a transmission system having the components depicted in Figures 2a and 2b[16]:

> As used in Independent Claims 19 and 41 and their respective Dependent Claims of the '992 Patent[17], "transmission system" means: the configurable,

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[16] Defendants agree that the Court construed "transmission system" to mean "the transmission system depicted in Figures 2a and 2b." (*See,* Round 3 Defendants' Motion, at 14:6).

[17] The Court's construction is, by its terms, limited to claims 19 and 41 of the '992 patent and their dependent claims. Although the same claim terms used in different claims are presumed to have the same meaning (*See, Fin Control Sys. Pty., Ltd. v. OAM, lnc*., 265 F.3d 1311, 1318 (Fed. Cir. 2001)), the Court's construction for "transmission system" should not apply to any system claim, such as claims 1-17 of the '992 patent and asserted claims 1-42 of the '702 patent, which claims a "transmission system" and sets forth, directly in the claim elements themselves, the specific components of the "transmission system." If the Court's construction of "transmission system" were adopted in those claims, each of those claims would have the exact same scope, even though each of the claims recite different required elements of the transmission system. This outcome would contradict a "bedrock principle" of patent law, which requires that the claims must define the invention. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.' *Innova **NEED FULL CITE***, 381 F.3d at 1115; *see also Vitronics **NEED FULL CITE***, 90 F.3d at 1582 ('we look to the words of the claims themselves ... to define the scope of the patented invention'); *Markman*, 52 F.3d at 980 ('The written description part of the

> interconnected, assemblage of components labeled and described in the specification as "transmission system 100," a detailed block diagram of which is shown on Figures 2a and 2b.

(6th CCO, at 11:15-18).

In their motion, the Round 3 Defendants have parsed the "transmission system" into each of its separate components, and, separately for each component, have contended that there is no written description or enablement for those components. In so doing, as discussed herein, Defendants have, in effect, imbued each component with all of the features and functions described in the specification, whether claimed or not or whether described as optional or mandatory in the specification (and have, in some instances, imbued components with alleged functions and/or structures that are not even mentioned in the specification).

Under Defendants' interpretation of the Court's construction of "transmission system," every component described in the specification is included, together with every function attributed to that component, whether required by the claim or not. Of course, the Court has not construed the "transmission system" (or any of its components) to include all of the limitations of the specification, nor could it, as the law precludes the Court from reading the limitations of the specification into the claims. *See*, *Amgen*, 314 F.3d at 1325 (Fed. Cir. 2003) ("Because the claims are best understood in light of the specification of which they are a part, however, courts must take extreme care when ascertaining the proper scope of the claims, lest they simultaneously import into the claims limitations that were unintended by the patentee.") Additionally, a construction that imports all of the limitations from the specification into the claim would make the claims superfluous and meaningless. *SRI Int'l*, 775 F.2d at 1121 ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims.").

By the very terms of the Court's claim construction, the "transmission system" was adequately described in the original disclosure and that disclosure satisfied the written description requirement. The Court's construction indicates that a "detailed block diagram of [transmission

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specification itself does not delimit the right to exclude. That is the function and purpose of claims.')."

system] is shown in Figures 2a and 2b." The original disclosure included Figures 2a and 2b. Figures 2a and 2b show components of "transmission systems" and the interconnections between and among them. The originally-filed claims also described "transmission systems" comprised of various combinations of the components shown in Figures 2a and 2b.[18] (*See*, Exhibit 3 to Block Decl., the originally-filed claims). Thus, there cannot be any written description violation, as a matter of law, because: (1) the specification depicts the claimed transmission system as construed by the Court in Figures 2a and 2b; (2) the term "transmission system" was not added in a later-filed claim; and (3) the originally-filed claims provided their own adequate description of the transmission system. *See, Vas-Cath,* 935 F.3d at 1563 (referring to "later claimed subject matter"); *Union Oil*, 208 F.3d at 998 n 4 ("disclosure in an originally filed claim satisfies the written description requirement.")

The Court can therefore stop here and deny Defendants' motion with respect to the written description issue as to the "transmission system" and as to each component of the "transmission system." For completeness, however, Acacia shall, below, separately address Defendants' specific written description (and enablement) contentions with respect to each of the components of the transmission system identified by Defendants in their motions.

1. The "Source Material Library 111"

a) The Original Disclosure Contains An Adequate Written Description of the "Source Material Library 111."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "source material library 111" component of the claimed "transmission system." The Court construed the term "source material library" to mean: "a collection of original sources of information."[19] (1st CCO, at 25:11-17). In construing the "source material library," the Court clearly recognized that the specification provided a sufficient description of the claimed "source material library," *i.e.*, "a collection of original sources of information." Indeed, it is the description of the "source material library" in the specification that formed the basis of the Court's construction: "the specification defines the source material library as a collection of original sources of information." (1st CCO, at 25:11-17).

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[18] Originally-filed claim 1 is an independent claim which claimed a "transmission system," comprising certain identified components listed directly in the claim itself (claim 1 required only some, but not all, of the components of Figures 2a and 2b). (*See*, Exhibit 3). Originally-filed dependent claims 2-17 added limitations to the transmission system of claim 1, but still none of originally-filed claims 1-17 claim all of the components of Figures 2a and 2b (originally-filed claims 1-17 issued as claims 1-17, as amended, in the '992 patent.) Originally-filed claims 1-17 and issued claims 1-17 are descriptions of 17 different transmission system embodiments. *See, e.g., Jones v. Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984) ("Each claim must be considered as defining a separate invention.")

Moreover, the "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "source material library 111" component of the "transmission system" (*i.e.*, "a collection of original sources of information"), because, among other things:

- ***The "Source Material Library" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts a "source material library 111" that is interconnected with the "identification encoding process 112" (elsewhere defined as the "identification encoder 112" *e.g.*, 6:35-47[20]);

- ***The Specification Describes the Input to the "Source Material Library"***: The specification identifies examples of various types of original sources of information as being retained in the "source material library 111." (6:8-22). All of these types of original sources of information were known to persons of ordinary skill in the art at the time of the invention, and it would have been inherent to such person as that these original sources of information would have been input to a "source material library 111," *i.e.*, accumulated by ordinary methods for each type of media and added to, or used to form, a collection of original sources of information. (Weiss Decl., ¶¶ 58- 60 Exhibit B[21], at 1; *See, All Dental*, 309 F.3d at 779; *Schering*, 222 F.3d at 1347);

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[19] Defendants' contention that a "source material library" is a "collection of physical items and nothing else" is wrong. (Round 3 Defendants' Motion, at 16:1). The Court's construction is open-ended and does not exclude any other embodiments of a source material library, so long as the required "collection of original sources of information" is present.

[20] All references in this brief in the form of XX:YY-ZZ refer to column (XX) and line numbers (YY-ZZ) of the '992 patent, unless stated otherwise.

[21] "Exhibits B" is a table prepared by Mr. Weiss and attached to his declaration. Mr. Weiss analyzed the '992 patent to determine, for each subsystem described in the '992 patent, the inputs, functions, and outputs of the individual subsystems, including the sources of the inputs and the destinations of the outputs and whether the subsystem is mandatory, inherently required, or optional. (Weiss Decl., ¶¶ 54-57). Exhibit B provides the complete results of Mr. Weiss' analysis. (Weiss Decl., ¶ 54).

- ***The Specification Describes the Function of the "Source Material Library"***: The specification states that the "source material library 111" is, among other things, "for temporary storage of items prior to conversion and storage in a compressed data library means." (5:66-6:2; *See also,* 6:8-22; Weiss Decl., ¶ 58; Exhibit B, at 1); and

- ***The Specification Describes the Output From the "Source Material Library"***: The specification discloses that, among other things, analog or digital information from the original sources of information stored in the "source material library 111" is passed to the identification encoder 112, or directly to the converter 113 when the storage encoding process is not performed prior to conversion (*See,* 6:35-48; 6:55-62; Figure 2; Weiss Decl., ¶ 58; Exhibit B, at 1).

In their motion, the Round 3 Defendants conclude that the "source material library 111" lacks written description, but they do not present any evidence as to what one of ordinary skill in the art would have understood from the original disclosure at the time that the application was filed. Defendants provide nothing more than attorney argument that, contrary to the Court's construction, the "source material library" must perform certain functions and include certain structures not required by the claims or the specification and ignore the clear disclosure of the specification.[22] (Round 3 Defendants' Motion, at 14:22-24).

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[22] The Round 3 Defendants previously asked the Court to read certain, selected limitations into the construction of the "source material library," but the Court refused to do so. In its Claim Construction Memorandum Regarding the Asserted '863 Claims and the Previously-Construed Terms, the Round 3 Defendants asked the Court to reconsider its construction of "source material library," and instead, construe it as follows: "A source material library is a device which is capable of: i) storing different types of physical objects containing information, including but not limited to audio recordings, still pictures, files of documents, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects; and ii) automatically transferring a physical item containing information to an identification encoder in response to an electronically-received request which identifies the physical item containing information. A source material library must be capable of performing this function with physical items of any of the media types described in (i) above." (Round 3 Defendants' Memo, D.I. No. 198, August 11, 2006, at 13-21). The Court, however, rejected Defendants' proposed construction and held that there is "no reason to abandon this [the Court's prior] construction." (3rd CCO, at 30:15-20).

b) Defendants' Argument Is Predicated on Features Not Required By Any Claim Limitation With Respect To The Source Material Library.

Defendants identify five (5) purported defects with the Yurt Patents' written description of the source material library. Specifically, Defendants claim that the Yurt Patents fail to provide an adequate written description of the following features that Defendants contend are required by the source material library: (1) retrieval of information from the source material library, (2) receiving and processing communications from the identification encoding means, (3) retaining information, (4) communication between multiple source libraries, and (5) communication of user requests. None of these features is required by the Court's construction that the source material library is nothing more than "a collection of original sources of information." (Motion, pp. 14-17). Indeed, the Court rejected specifically Defendants' proposed construction that attempted to import into the meaning of "source material library" these various features. For some of these features, not only are they not claimed or part of any claim construction, the specification itself makes clear that the features are merely optional. For example, the specification makes it clear that the use of multiple source material libraries is a purely optional feature. (6:23-28). Because these mechanisms were not claimed, there is no requirement that a written description or enabling disclosure be provided. *See, Vas-Cath Inc.*, 935 F.2d at 1563; *Regents of University of California*, 03-CV-05669-JW, 2007 WL 2580594.

c) The original disclosure contains an adequate written description of the "source material library."

Retrieval of information from source material library

Even if deemed to be a requirement of any asserted claim, the specification does describe a "mechanism" for retrieving information from the source material library, which, as discussed below, is a playback device for playing back the various media formats on which the items are stored in the source material library. (Weiss Decl., ¶¶ 58, 60, 62; Exhibit B, at 1). The specification describes how the items in the source material are converted or recorded "on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in compressed data library 118," such as, preferably, "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges." (6:15-22).

In one example, the specification teaches one of ordinary skill in the art how the information in a film (an item in the source material library) is retrieved using a telecine machine (a type of playback device which electronically records the images from a film) and how accompanying audio information is retrieved by passing the "audio information through an optical or magnetic digital playback device."

> If, for example, the retrieved information to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a digital telecine device to the digital input receiver 124. Format conversion is then preferably performed by digital video formatter 125b. Accompanying audio information is passed through an optical or magnetic digital playback device.

('992 patent, 7:35-43).

This example of retrieving information from a film using a telecine machine and retrieving audio information using an optical or magnetic digital playback device would have been sufficient for one of ordinary skill in the art to have understood that, for all of the types of materials in the source material library, a playback device would have been used to retrieve the information in the items having information in the source material library. (*See*, Weiss Decl., ¶ 59; Exhibit B, at 1). One of ordinary skill in the art would have been aware of the playback devices required to retrieve the information in "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges" in 1991, as all of these formats and corresponding playback devices were known in 1991. (6:19-22); (Weiss Decl., ¶ 61). As discussed above in Section IV.A.2., the disclosure of a single embodiment can be sufficient to support written description of a broad claim which covers more embodiments. *See, In re Smythe*, 480 F.2d at 1384; *Bilstad*, 386 F.3d at 1124.

Receiving communications from the identification encoding means

The specification describes the fact that the source material library may communicate via any available method, which is sufficient to demonstrate that the specification reasonably conveyed to one of ordinary skill in the art that the inventors were in possession of a "source material library" that receives or processes communications from the identification encoder.[23] (6:33-34); (Weiss Decl., ¶¶ 63-64).

Retaining information

Underscoring the overreaching scope of Defendants' motions, Defendants argue that the Yurt Patents fail to disclose even the most trivial function of "storing" information. Yet one skilled in the art would have known how to store numerous types of items having information disclosed in the patent, such as digital or analog audio and video tape, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, cartridges, and film. (Weiss Decl., ¶ 59).

Communication between multiple source libraries

The specification describes how multiple source material libraries may communicate with one another and it satisfies the written description requirement showing that the inventors were in possession of the inventions. For example, the specification states that multiple source material libraries may communicate "using methods and channels similar to the methods and channel types which libraries may employ for communication with the receiving system 200 of the user, or the source material libraries may communicate via any available method." (6:28-34). One of ordinary skill in the art would have recognized that the specification disclosed how multiple libraries would have communicated with one another. (Weiss Decl., ¶ 63-64).

Communication of user requests

The specification provides a written description for the receiving and processing of user requests by the source material library at 6:28-34: "The plurality of source material libraries may communicate using methods and channels similar to the methods and channel types which libraries may employ for communication with the receiving system 200 of the user, or the source materials may communicate via any available method." (*See also*, 14:64-15:2; 15:61-16:15; and 16:53-16:68); (Weiss Decl., ¶¶ 63-64).

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[23] Defendants criticize the Yurt patent specification for its failure to disclose "how" to perform this communication function. As described above, however, a description of "how" to implement these functions is not a determination under the written description requirement, but rather an issue for enablement, which Acacia addresses separately (as Defendants should have).

d) The specification provides an enabling disclosure for the "source material library."

Defendants contend that the Yurt Patents do not provide an enabling disclosure of the "source material library 111" component of the claimed "transmission system." A skilled artisan, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "source material library" component of the "transmission system" without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Source Material Library"***: These are described in detail above in Section V.A.3.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in the Weiss Decl. at ¶¶ 59-63; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Source Material Library"***: The inventors provided sufficient information about the inputs, functions, and outputs of the source material library that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 64).

In their motion, the Round 3 Defendants contend that the "source material library 111" lacks enablement, but they do not present any evidence, let alone clear and convincing evidence, as to: (1) what knowledge one of ordinary skill in the art would have had available to them in January 1991, (2) what one of ordinary skill in the art would have understood from the disclosure of the Yurt Patents, or (3) what steps one of ordinary skill in the art would have had to undertake to make and use the claimed "source material library 111," including whether one skilled in the art would have had to engage in undue experimentation. Instead, Defendants provide nothing more than attorney argument that the "source material library 111" is not enabled, and Defendants wholly fail to satisfy their burden of proving lack of enablement by clear and convincing evidence. (Round 3 Defendants' Motion, at 14:10-17:11).

Regardless, each of the features purportedly required by the source material library is enabled by the Yurt patent specification.

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Retrieval of information

The specification describes a "mechanism" for retrieving information in the items, which, as discussed above in Section V.A.3.a., is a playback device for playing back the various media formats on which the items are stored in the source material library. Taking this disclosure, together with the knowledge available in 1991, one of ordinary skill in the art could have made and used a source material library having a "mechanism" for accessing physical items and retrieving information from them, without undue experimentation. (Weiss Decl., ¶¶ 59-61 and 64). As discussed above in Section IV.A.2., the original disclosure need not teach, and preferably omits, what is well known in the art. *See, e.g., Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Chiron*, 363 F.3d at 1254.

Receiving communications from the identification encoding means.

The specification describes the fact that the source material library may communicate via any available method. (6:33-34); (Weiss Decl., ¶ 63). Taking this disclosure, together with the knowledge available in 1991, one of ordinary skill in the art could have made and used a source material library capable of receiving and processing communications from the "identification encoding means," without undue experimentation. (Weiss Decl., ¶¶ 63-64). Any number of routine and commonly known communication methods would be known by a person of skill in the art to satisfy this function. (*Id.*)

Retaining information

One of ordinary skill in the art would have easily been able to make and use structures in January 1991 for retaining the original sources of information of the type described in the specification, *e.g.*, digital or analog audio and video tape, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, cartridges, and film from the specification and from the knowledge available to one of ordinary skill in the art. (Weiss Decl., ¶ 59). As discussed above in Section IV.A.2., the original disclosure need not teach, and preferably omits, what is well known in the art. *See, e.g., Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Chiron*, 363 F.3d at 1254.

Communication between multiple source libraries

If deemed to be a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation multiple source material libraries capable of communicating with one another from the specification and from the knowledge available to one of ordinary skill in the art. The specification states that multiple source material libraries may communicate "using methods and channels similar to the methods and channel types which libraries may employ for communication with the receiving system 200 of the user, or the source material libraries may communicate via any available method." (6:28-34). One skilled in the art would have known how to use the communication channels described in the patent, which were well-known in 1991. (Weiss Decl., ¶ 63-64). Again, the original disclosure need not teach that which is well known in the art.

Communication of user requests

The specification describes that the source material library may communicate with users via their receiving systems using communication channels. The specification also discloses several possible communication channels that were well-known at the time. (*See*, 6:28-34; 14:64-15:2; 15:61-16:15; and 16:53-16:68). Such communication channels were known and could have been implemented in 1991. (*See*, Weiss Decl., ¶ 63-64).

2. "Identification Encoder."

a) The Original Disclosure Contains an Adequate Written Description of "Identification Encoder 112."[24]

The original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "identification encoder 112," because, among other things:

- ***The "Identification Encoder" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts an "identification encoding

[24] The Court held that the "identification encoder" is an indefinite term. Therefore, the Court cannot, as a matter of law, determine whether this indiscernible claim limitation meets the written description requirement. *See, e.g. Vas-Cath*, 935 F.2d at 1563; *Chiron*, 363 F.3d at 1253.

process 112" (elsewhere defined as the "identification encoder 112" *e.g.*, 6:35-47) receiving information from the source material library 111 and passing that information to the converter 113;

- ***The Specification Describes the Input to the "Identification Encoder"***: The specification identifies the input to the "identification encoder" as being the audio and/or video information from the items in the source material library. Also input by a system operator are the unique identification code, file address data, and optional program notes and popularity codes. (*e.g.*, 6:62-64; 10:58-11:4; 12:28-35); (Weiss Decl., ¶ 65, Exhibit B, at 2);

- ***The Specification Describes the Functions of the "Identification Encoder"***: The specification conveyed to one of ordinary skill in the art that the "identification encoder" is for, among other things, storage encoding, which includes assigning a unique identification code to each item and, optionally assigning program notes and popularity codes, generating a unique address code, and optionally mapping item addresses to item names, and operating a program which updates a master item database." (6:35-48; 11:5-19; Weiss Decl., ¶ 65; Exhibit B, at 2); and

- ***The Specification Describes the Output From the "Identification Encoder"***: The specification conveyed to one of ordinary skill in the art that, among other things, analog and/or digital information and unique address codes is passed from the identification encoder 112 to the converter 113, or, if an inter-library transfer of an item is already in a compressed form, passing the compressed information directly to the compressed data formatting section (*e.g.*, Figure 2a, aka, the compressed data formatter 117, *e.g.*, 7:48-50; 8:10:23-26; 12:65-68) (*See*, 6:62-64; 7:1-50; 7:44-50; Figure 2a; Weiss Decl., ¶ 65, Exhibit B, at 2).

As the Federal Circuit has held and as discussed above, in the field of art of the Yurt Patents, describing the identification encoder in terms of its function in this manner is perfectly permissible, because a person of skill in the art would understand from this description that the inventors possessed the claimed invention. *Vas-Cath*, 935 F.2d at 1563; *Hayes*, 982 F.2d at 1534; *Capon*, 418 F.3d at 1357-58. The written description requirement has therefore been met for the "identification encoder 112."

b) The Specification Contains an Enabling Disclosure of the "Identification Encoder 112."

One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "identification encoder" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Identification Encoder"***: These are described in detail above in Section V.A.4.a.**;**
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 66-67; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Identification Encoder"***: The inventors provided sufficient information about the inputs, functions, and outputs of the identification encoder that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 68).

Because a person of ordinary skill in the art would have been able to make and use the identification encoder providing the stated functions without any undue experimentation, the enablement requirement has been met for the "identification encoder 112." (Weiss Decl., ¶ 68).

3. The "Converter 113"

a) Defendants once again ascribe features neither claimed nor required by the Court's construction.

Defendants contend that (1) there is no disclosure of any circuitry or software for distinguishing between analog and digital input signals or distinguishing between audio and video signals. (Round 3 Defendants' Motion, at 19:15-18); (2) the converter must accept input of all possible input information formats and media types. (Round 3 Defendants' Motion, at 15:3-10); and (3) there is no disclosure of what the single, predetermined format is. (Round 3 Defendants' Motion, at 19:22-20:4). There is no limitation in the Court's construction for "transmission system" or in any asserted claim which requires any of these features. Indeed, the Court addressed the issue of what would be required in the converter in its 6th CCO, stating that, although a converter 113 is essential, only an input receiver of one type (analog audio, analog video, digital audio, or digital video) is essential. (6th CCO, at 10:8-9; '992 patent, 6:62-68: "If items have only one format, only one type of input receiver 124 or 127 is necessary."; 5:63-65: "A preferred embodiment of transmission system 100 may preferably include only some of the elements shown in FIGS. 2a and 2b"). Therefore the inventors were not required to provide a description of such an unclaimed features. *See*, *Vas-Cath*, 935 F.2d at 1563.

b) The Original Disclosure Contains An Adequate Written Description of the "Converter 113."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "converter 113" component of the claimed "transmission system." But the "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "converter 113," because, among other things:

- ***The "Converter" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts a "converter 113" that is interconnected with the "identification encoding process 112" (elsewhere defined as the "identification encoder 112" e.g., 6:35-47) and time encoding 114 (elsewhere defined as "time encoders 114," e.g., 7:64-66);

- ***The Specification Describes the Input to the "Converter"***: The specification conveyed to one of ordinary skill in the art that "converter 113" receives information from the identification encoder 112, or, in instances where the storage encoding process does not occur prior to conversion, from the source material library. (6:35-47; 6:58-62; Weiss Decl., ¶ 69; Exhibit B, at 2);

- ***The Specification Describes the Function of the "Converter"***: The specification conveyed to one of ordinary skill in the art that the "converter 113" places retrieved information into a predetermined format as formatted data. (6:58-62; Weiss Decl., ¶ 69; Exhibit B, at 2);

- ***The Specification Describes the Output of the "Converter"***: The specification conveyed to one of ordinary skill in the art that the formatted information from the converter is passed from the converter 113 to the time encoder 114. (7:64-66; Weiss Decl., ¶ 69; Exhibit B, at 2).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention.

Conversion of both audio and video

If the converter required both the audio and video components and/or both the analog and digital components, because both audio and video and/or analog and digital would be input, one skilled in the art would have known that separate analog inputs for video and audio would have been necessary, as it was not easy to mix analog video and audio signals onto the same interface. (Weiss Decl., at ¶ 69). For digital signals, one skilled in the art would have known that it is possible to embed audio within a video data steam, so digital inputs could be over separate inputs for audio and video or over a single input when the audio from the source is embedded in the video. (Weiss Decl., ¶ 69). As discussed above in Section IV.A.1., there is no requirement that the original disclosure be identical to the claim language, and the written description requirement may be met when the claimed subject matter is inherently contained in the specification. *See, e.g., All Dental Prodx,* 309 F.3d at 779; *Schering*, 222 F.3d at 1352.

Digital and analog

The specification teaches that the inputted into the converter will not be in various formats, but instead will be in either an analog or digital format. (6:65-68). The specification describes how the items having information in the source material library are played back in a playback device and the output analog or digital information is input to the input devices of the converter, as described, for example, with respect to a film:

> If, for example, the retrieved information to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a digital telecine device to the digital input receiver 124. Format conversion is then preferably performed by digital video formatter 125b. Accompanying audio information is passed through an optical or magnetic digital playback device. This device is connected to digital audio formatter 125a.

('992 patent, 7:35-43).

Defendants recognize that the specification describes the telecine as an example of the conversion of the original sources of information to a format that is compatible with the inputs of the converter, but contend that "[s]ome other, undisclosed component must determine if information is in the format of a motion picture film or is in some other format." (Round 3 Defendants' Motion, at 20 n. 16). There is, however, nothing in the specification or in any asserted claim that requires that there be a component of the "transmission system" that determines what format the information is in, and therefore the inventors were not required to provide a description of such an unclaimed component. Even if such component were required, components used to handle the different media types were known and were designed to operate with specific types of media; interaction with a system operator would still be necessary. (Weiss Decl., at ¶¶ 61-62).

Predetermined format

If deemed to be a requirement of any asserted claim, the specification discloses an example of the predetermined format, thereby meeting the written description requirement:

> A formatter 125 sets the correct bit rates and encodes into least significant bit (lsb) first pulse code modulated (pcm) data.... Converter 123 preferably forms the digital data bytes into the same format as the output of formatter 125.... The analog audio converter 123a preferably converts the retrieved audio signal into pcm data samples at a fixed sampling rate. The analog video converter 123b preferably converts the analog video information, retrieved from identification encoder 123 [sic: 112], into pcm data also at fixed sampling rates.
>
> * * *
>
> The converted formatted information of the requested material is then preferably in the form of a series of digital data bytes which represent frames of video data and samples of the audio data. A preferred relationship of the audio and video bytes to each other is shown in FIG. 8.

(7:4-26; 8:7-12; Figure 8, and Weiss Decl., ¶ 69; Exhibit B, at 2). As discussed above in Section VI.A.2., claims may be broader than the specification and still meet the written description requirement. *See, e.g., Cordis*, 339 F.3d at 1365; *Ralston-Purina*, 772 F.2d at 1575; *In re Smythe*, 480 F.2d at 1384.

c) The Specification Contains an Enabling Disclosure of the "Converter 113."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "converter 113" component of the claimed "transmission system." One of ordinary skill in the art, using the knowledge available to such a person *circa* 1991 and the disclosure in the patent document could have made and used the "converter 113" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Converter"***: These are described in detail above in Section V.A.5.a.;

- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 69-74; and

- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Converter"***: The inventors provided sufficient information about the inputs, functions, and outputs of the converter that one could have been built and used readily by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss Decl., ¶ 75).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could not have made and used the "converter 113" component of the "transmission system," without undue experimentation, in January 1991. In fact, once again, Defendants have provided no evidence at all.

Analog and Digital Audio and video

Even if the converter required both the audio and video components and/or both the analog and digital components, components capable of distinguishing between analog and digital signals or audio and video signals would have been known by one of ordinary skill in 1991 and thus one skilled in the art in 1991 could have made and used a converter capable of accepting input of both analog video and audio and digital video and audio signals. (Weiss Decl., ¶ 69, 75).

Digital and analog

The specification teaches that, before being input to the converter 113, the source materials are converted to a format compatible with the inputs to the converter and provided an example for film using a telecine and an audio playback device. (6:15-19; 7:35-43). Defendants contend that "[s]ome other, undisclosed component must determine if information is in the format of a motion picture film or is in some other format." (Round 3 Defendants' Motion, at 20 n 16). But several components capable of distinguishing between different type of media formats (including human interaction from a system operator) would have been known by one of ordinary skill in 1991. (Weiss Decl., ¶ 61-62).

Predetermined format

If deemed to be a requirement of any asserted claim, contrary to Defendants' contention, the specification does disclose an example of the predetermined format at 7:4-6; 8:7-12; Figure 8. (Weiss Decl., ¶ 69, Exhibit B, at 2). The disclosure of this exemplary format is sufficient to meet the enablement requirement. (Weiss Decl., ¶ 75). As discussed above in Section IV.B.1., a patent claim may be broader than the specification and still meet the enablement requirement. *See, Spectra-Physics*, 827 F.2d at 1533.

4. The "Time Encoder 114"

a) The Original Disclosure Contains An Adequate Written Description of the "Time Encoder 114."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "time encoder 114" component of the claimed "transmission system." The original disclosure of the Yurt Patents, however, reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "time encoder 114," because, among other things:

- ***The "Time Encoder" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts "time encoding 114" (elsewhere defined as time encoders 114, e.g., at 7:65-66) that is interconnected with the "converter 113" and the "precompression data processing 115" (elsewhere described as the "precompression processor 115," e.g., 8:16-19; and

- ***The Specification Describes the Input, Function, and Output of the "Time Encoder"***: The specification conveyed to one of ordinary skill in the art that the "time encoder" "assigns relative time markers to the audio and video data as it passes from the converter 113 through the time encoder 114 to the precompression processor 115." (8:16-19; Weiss Decl., ¶ 76, Exhibit B, at 3).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention.

Defendants first contend that there is no disclosure as to where the "time code" is applied, how it is associated with the video frames, or what the "predetermined format" is. (Round 3 Defendants' Motion, at 21:14-18). As with other features identified by Defendants throughout their motions, there is no limitation in the claims, including the Court's construction of "transmission system," as to where the "time code" must be applied, how it is associated with the video frames, or what the predetermined format of the audio and video information must be, and therefore the inventors were not required to provide a description of such an unclaimed information. *See*, *Vas-Cath*, 935 F.2d at 1563.

If deemed to be a requirement of any asserted claim, the specification makes clear, in its example, that the time codes are assigned to the frames of the video data and to the samples of the audio data. This is evident from the specification's description of: (1) the predetermined format as being "in the form of a series of digital data bytes which represent frames of video data and samples of the audio data" (8:8-10); (2) the information being input to the time encoder in sequence by frames of video data and samples of audio data (8:12-16); (3) the time encoder assigning relative time markers to the audio and video data as it passes through the time encoder (8:16-19); and (4) the use of the address of the item and its frame number (*i.e.*, time code) to address any particular block of audio or video data (8:24-26 and 10:50-54). Mr. Weiss confirms that the time markers are affixed to the frames of video and audio data. (Weiss Decl., ¶¶ 76, 78).

Defendants next contend that the specification does not disclose how the time encoder creates a group of addressable data blocks. (Round 3 Defendants' Motion, at 21:18-22:15). Again, there is no such limitation any of the asserted claims, and therefore no description is needed. Regardless, one of ordinary skill in the art, reading the specification, would have understood how the "time encoder" can create a "group" of addressable data blocks. (Weiss Decl., ¶ 79). The specification discloses that the time encoder may place the blocks of converted formatted information from converter 113 into "a group of addressable blocks," and therefore there is written description of this feature. (7:66-8:1); (Weiss Decl., ¶ 80).

b) The Specification Contains an Enabling Disclosure of the "Time Encoder 114."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "time encoder 114" component of the claimed "transmission system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the “time encoder 114” component of the “transmission system,” without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the “Time Encoder”***: These are described in detail above in Section V.A.6.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 77-79; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the “Time Encoder”***: The inventors provided sufficient information about the inputs, functions, and outputs of the time encoder that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 80).

As discussed above, the features identified by Defendants as lacking an enabling disclosure with respect to the “time encoder” are not required by the claims, and therefore not the proper subject of an enablement analysis. Regardless, the Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could not have made and used the “time encoder 114” component of the “transmission system,” without undue experimentation, in January 1991. Specifically, one of ordinary skill in the art would have been able to make and use without undue experimentation a time encoder 114 from the specification and from the knowledge available to one of ordinary skill in the art. The specification makes clear, in its example, that the time codes are assigned to the frames of the video data and to the samples of the audio data. (8:8-10; 8:12-16; 8:24-26; and 10:50-54); (*See also,* Weiss Decl., ¶ 76). Similarly, one of ordinary skill in the art would have been able to make and use without undue experimentation a time encoder 114 which creates a group of addressable data blocks from the specification and from the knowledge available to one of ordinary skill in the art. (Weiss Decl., ¶¶ 77-79). Thus, the “time encoder” is sufficiently enabled. At a minimum, there exists a material dispute of fact regarding whether the Yurt patents provide an enabling disclosure for the “time encoder” rendering summary judgment inappropriate.

5. The "Precompression Processor 115" and the "Compressor 116"

a) The Original Disclosure Contains An Adequate Written Description of the "Precompression Processor 115" and the Compressor 116."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "precompression processor 115" and "compressor 116" components of the claimed "transmission system." As with the other limitations criticized by Defendants, the original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "precompression processor 115" and "compressor 116," because, among other things:

- ***The "Precompression Processor" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts the "precompression data processing elements 115" (elsewhere described as the "precompression processor 115," *e.g.*, 8:59-62) that are interconnected with the "time encoding 114" element (elsewhere defined as "time encoders 114," *e.g.*, 7:64-66) and the "compressors 116";

- ***The Specification Describes the Input to the "Precompression Processor"***: The specification conveyed to one of ordinary skill in the art that the "precompression processor 115" receives input formatted, time encoded data from the "time encoder 114" (*e.g.*, 8:16-19; Weiss Decl., ¶ 81, Exhibit B, at 3);

- ***The Specification Describes the Function of the "Precompression Processor"***: The specification conveyed to one of ordinary skill in the art that the "precompression processor 115": (1) buffers incoming video data, (2) converts the aspect ratio and frame rate of the data, as required by the compressor, (3) if necessary, places a chosen background around the interactive region of the video information, (4) processes incoming audio data for sample rate and word length optimization, (5) if necessary, transcodes the audio data, (6) blocks the audio data into frames; and (7) buffers the audio data. (8:67 – 9:40; Weiss Decl., ¶ 81, 84-85, Exhibit B, at 3);

- ***The Specification Describes the Output of the "Precompression Processor"***: The specification conveyed to one of ordinary skill in the art that the frames of audio and video in a compatible format from the "precompression processors 115" are passed to the "compressors 116." (9:41-42; Weiss Decl., ¶ 81, Exhibit B, at 3);

- ***The "Compressor" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts the "compressors 116" as being interconnected with the "precompression processors 115" and the "compressed data formatting section 117";

- ***The Specification Describes the Input to the "Compressor"***: The specification conveyed to one of ordinary skill in the art that the frames of audio and video in a compatible format from the "precompression processors 115" are passed to the "compressors 116." (9:41-42; Weiss Decl., ¶ 90, Exhibit B, at 3);

- ***The Specification Describes the Function of the "Compressor"***: The specification conveyed to one of ordinary skill in the art that the compressors 116 compress the audio and video data. (9:41-10:16; Weiss Decl., ¶ 90, Exhibit B, at 3); and

- ***The Specification Describes the Output of the "Compressor"***: The specification conveyed to one of ordinary skill in the art that the compressors output the compressed data to the compressed data storage means 117 (10:23-26) (aka, the compressed data formatting section 117, e.g., Figure 2a, aka, the compressed data formatter 117, *e.g.*, 7:48-50; 10:23-26; 12:65-68; Weiss Decl., ¶ 90, Exhibit B, at 3).

Defendants once again point to a series of features, neither claimed nor required by any of the Court's constructions, as their basis for asserting an inadequate written description. Defendants first contend that only the functions of the "audio precompression processor 115a" and the "video precompression processor 115b" are disclosed; *i.e.*, there is no description of how to implement these functions. (Round 3 Defendants' Motion, at 22:21-23:4). But again, nothing in the claims or the Court's construction for "transmission system" places any limitation on "how" the precompression processor performs its functions (*i.e.*, the specific software or circuitry). Thus, whether the specification discloses "how" the components of the precompression processor 115 implement these functions is irrelevant to the written description issue. *Vas-Cath*, 935 F.3d at 1563.

Moreover, by describing the functions of the precompression processor 115, as Defendants admit (Round 3 Defendants' Motion, at 22:21-23:4), the specification reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of these aspects of the invention. (Weiss Decl., ¶ 81-89). As discussed above in Section IV.A.2., the original disclosure need not teach, and preferably omits, what is well known in the art. *See, e.g.*, *Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Chiron*, 363 F.3d at 1254.

Defendants also contend that the "compressor 116" is only described in the specification by reference to prior art audio and video compression techniques, which were supposedly not capable of compression for "broadcast." (Round 3 Defendants' Motion, at 23:5-6). Once again, there is no limitation in the claims that the "compressor 116" be capable of compressing audio and video data to any specific level of quality, let alone to a "broadcast" quality level of transmission. Indeed, the asserted claims are not limited to any form of transmission, and the specification describes various forms of transmission, such as data over ISDN or B (broadband) ISDN, satellite, cable, local or metropolitan area computer networks, or telephone. (*See*, Figure 2b; 16:6-9).

Defendants quote Mr. Weiss' testimony from a prior hearing that in 1991, "compression systems were not quite at the level that, that you would need for broadcast." (Round 3 Defendants' Motion, at 23:9). As Mr. Weiss elaborates in his declaration, by the start of 1991, there were numerous video compression methods available and that, although "commercial products for video compression at a so-called 'broadcast quality' level were not yet available off the shelf in January, 1991, there were products available that could be described as having 'VHS quality.' Since competing with the rental of VHS tapes by consumers was one of the objectives of the invention, the compression hardware that was available for purchase at that point would have been competitive." (Weiss Decl., ¶ 93).

Mr. Weiss further described the Altieri and Colavin article "A Chip Set Core of Image Compression," which the inventors disclosed in the '992 patent at 10:10-11 (Exhibit D to Weiss Decl.), as providing "information on how to construct a pipeline architecture that would permit scaling the system to enable compression of high definition (HDTV) signals—*i.e.*, signals of a higher quality than were able to be broadcast" and therefore concluded that "[m]oreover, the patent provided information on techniques that could lead to embodiments that not only produced broadcast quality signals but that could produce signals for the next generation of broadcast quality—HDTV—which was only then being considered for adoption as a means for providing broadcast service to consumers." (Weiss Decl., ¶¶ 92-93).

Thus, according to Mr. Weiss, "it is evident that the inventors disclosed sufficient information about such subsystems [the audio and video compressors] that one of ordinary skill in the art of the patent would have recognized that they were in possession of that portion of the Transmission System in January, 1991." (Weiss Decl., ¶ 95).

b) The Specification Contains an Enabling Disclosure of the "Precompression Processor 115" and the Compressor 116."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "precompression processor 115" and "compressor 116" components of the claimed "transmission system." These components are enabled by the Yurt patent specification because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Precompression Processor" and "Compressor" and Provides Specific Examples of Compression Techniques***: These are described in detail above in Section V.A.7.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 82-88 and 91-94;
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Precompression Processor"***: The inventors provided sufficient information about the inputs, functions, and outputs of the precompression processor that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 89); and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Compressor"***: The inventors provided sufficient information about the inputs, functions, and outputs of the compressor that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 95).

In short, one of ordinary skill in the art would have been able to make and use, without undue experimentation, an audio precompression processor 115a and a video precompression processor 115b from the description in the specification of the functions of each and from the knowledge available to one of ordinary skill in the art. (Weiss Decl., ¶¶ 82-89).

Further, although not required by the claims, one of ordinary skill in the art would have also been able to make and use, without undue experimentation, a compressor capable of a "broadcast" quality level of compressed video and audio information from the description in the specification and knowledge available to them, as described by Mr. Weiss in his declaration: "[A] person of ordinary skill in the art of the patent, at the beginning of 1991, would have been aware of the techniques to be applied and of the equipment and components available in the marketplace that would have enabled implementation of both the Audio Compressor and the Video Compressor, i.e., the Compressor in its entirety. That person would have been aware of the various methods for applying that equipment or those components to implement systems built to achieve the purposes of the Compressor." (Weiss Decl., ¶ 94). Therefore, the compressor is enabled. (Weiss Decl., ¶ 95).

6. The "Compressed Data Formatter 117"

a) The Original Disclosure Contains An Adequate Written Description of the "Compressed Data Formatter 117."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "compressed data formatting section 117" component of the claimed "transmission system." The Court has construed the phrase from claim 1 of the '992 patent: "compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means" to mean the compressed data formatter 117 and the compressed data library 118:

> Pursuant to § 112, ¶ 6, the functions of the "compressed data storing means" inherent in the phrase "for storing as files" are (1) creating a file and (2) storing the file. ***The corresponding structure for creating and storing a file is the compressed data formatter 117***.

(1st CCO, at 23:6-18; emphasis added). As that claim phrase was construed pursuant to Section 112, ¶ 6, the Court was required to define the function of the means-plus-function claim phrase and then locate in the specification the structure for performing that function. The Court found the compressed data formatter 117 is the structure disclosed in the specification for performing the function of creating and storing a file. This demonstrates that the specification conveyed to the Court that the inventors were in possession of the compressed data formatter 117, which was part of the original disclosure.

The original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "compressed data formatter 117" of Figure 2a, because, among other things:

- ***The "Compressed Data Formatter" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2a depicts a "compressed data formatting section 117" (aka, the compressed data formatting section 117, *e.g.*, Figure 2a, aka, the compressed data formatter 117, *e.g.*, 7:48-50; 8:10:23-26; 12:65-68) which receives information from the "compressors 116" or the identification encoder 112 and passes information to the "compressed data library 118";

- ***The Specification Describes the Input to the "Compressed Data Formatter"***: The specification conveyed to one of ordinary skill in the art that, among other things, compressed audio and video are passed from the compressor 116 to the compressed data formatter 117 or that materials input as part of an inter-library transfer are received by the compressed data formatter from the identification encoder 112 (7:44-58; 10:23-26; Weiss Decl., ¶ 96, Exhibit B, at 4);

- ***The Specification Describes the Function of the "Compressed Data Formatter"***: The specification conveyed to one of ordinary skill in the art that the "compressed data formatter 117" is: (1) for creating and storing a file (*See*, 10:23-26; 10:36-39; 12:65-68; 1st CCO, at 23:6-18), (2) the place where realignment of the audio and video information after compression, as provided by the time codes, occurs (8:2-6), (3) the place in one embodiment to which retrieved items that are in a previously compressed form are passed from the identification encoder 112, wherein such materials may be received and stored in the short term storage 117 of the "compressed data formatting section 117" (Figure 2a and 7:44-58); and (4) the place, in one embodiment, to which item database records are input from another system and where, if necessary, the item database records are reformatted to be compatible with existing material in the compressed data library 118. (Figure 2a and 7:44-58; Weiss Decl., ¶ 96, Exhibit B, at 4); and

- ***The Specification Describes the Output of the "Compressed Data Formatter"***: The specification conveyed to one of ordinary skill in the art that the "compressed data formatter 117" passes a file containing the compressed audio and video information for an item to the "compressed data library 118" (10:36-39; Weiss Decl., ¶ 96, Exhibit B, at 4).

Defendants first complain that the specification is unclear about what the "compressed data formatting section 117"[25] component is supposed to do. (Round 3 Defendants' Motion, at 24:2-21). This contention, however, is contradicted by the Court's 1st CCO, wherein the Court found that the specification discloses the "compressed data formatter 117" as being the corresponding structure under Section 112, ¶ 6 for the functions of creating and storing a file. (1st CCO, at 23:6-18).

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[25] The "compressed data formatting section 117" of Figure 2a is referred to in the specification as the compressed data formatter 117. (e.g., 7:48-50; 8:10:23-26; 12:65-68).

Defendants next complain that the specification does not say how "block 117" is able to determine whether the format of received material is compatible or incompatible with the material in the compressed data library. (Round 3 Defendants' Motion, at 24:26-25:2). This contention only relates to the optional feature described in the specification for accepting "inter-library transfers," where the incoming materials "may be in a previously compressed form so that there is no need to perform compression by precompression processor 115 and compressors 128 and 129." (7:44-48). There is nothing in the claims or the construction of "transmission system" which requires that the compressed data formatting section 117 receive incoming inter-library transfer materials or that it determine whether material is or is not compatible with the material in the compressed data library 118, and thus there is no requirement to provide written description of this unclaimed, optional feature. But even assuming such disclosure was required, the software which would have comprised the compressed data formatter would have been capable of "recognizing whether data from inter-library transfers is compatible with the data format and structure in use on the local system and converting it to the appropriate format if it is not already compatible, and the like." (Weiss Decl., ¶ 97).

Defendants then contend that the specification is ambiguous as to which data is reformatted by the compressed data formatting section 117. (Round 3 Defendants' Motion, at 25:3-7). This contention also only relates to the optional feature described in the specification for accepting "inter-library transfers." Accepting inter-library transfers is not a requirement of the "transmission system," as construed by the Court, or of any asserted claim. But even if deemed to be a requirement of any asserted claim, one of ordinary skill in the art reading the sentence in the specification at 7:50-55 would have understood that it is the "item database records" that are reformatted. Mr. Weiss explains that this sentence means that the item database records may be input to the compressed data formatter, and, if necessary, the item database records can be reformatted for compatibility with other, similar information stored in the compressed data library. (cf. 11:40-44 and 12:58-61). (Weiss Decl., ¶¶ 182-183).

b) The Specification Contains an Enabling Disclosure of the "Compressed Data Formatter 117."

Contrary to Defendants' contentions, one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "compressed data formatter 117" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Compressed Data Formatter"***: These are described in detail above in Section V.A.8.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶ 97; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Compressed Data Formatter"***: The inventors provided sufficient information about the inputs, functions, and outputs of the compressed data formatter that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 98).

Defendants' only enablement argument is its contention that the specification does not describe how "block 117" is able to determine whether the format of received material is compatible or incompatible with the material in the compressed data library falls short. (Round 3 Defendants' Motion, at 24:26-25:2). Besides being an optional feature not required by any claim limitation (and therefore no enabling disclosure is needed) (7:44-48), one of ordinary skill in the art would have been able from the specification and the knowledge available to one of ordinary skill in the art to make and use without undue experimentation a compressed data formatter that is capable of determining whether the format of received material is compatible or not with the material already stored in the compressed data library. Indeed, this would have required nothing more than software programming to implement the disclosed functions. (Weiss Decl., ¶¶ 97-98). Defendants have failed to meet their heavy burden of establishing lack of enablement by clear and convincing evidence as to this claim limitation as well. Certainly, a material dispute of fact exists precluding entry of summary judgment.

7. The "Compressed Data Library 118"

a) The Original Disclosure Contains An Adequate Written Description of the "Compressed Data Library 118."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "compressed data library 118" component of the claimed "transmission system" even though the specification provides the following disclosure sufficient to convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "compressed data library 118":

- ***The "Compressed Data Library" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2b depicts the "compressed data library 118" that is interconnected with the "compressed data formatting section 117" and the "library system control computer 1123" elements and one or more of the "transmission format conversion CPUs 119";

- ***The Specification Describes the Input to the "Compressed Data Library"***: The specification conveyed to one of ordinary skill in the art that the "compressed data library 118" receives, among other things, files from the "compressed data formatter 117" and receives user requests and control commands from the library system control computer 1123 (*e.g.*, 10:36-39 and Figure 2b; Weiss Decl., ¶ 99, Exhibit B, at 4-5);

- ***The Specification Describes the Function of the "Compressed Data Library"***: The specification conveyed to one of ordinary skill in the art that the "compressed data library 118" stores files of compressed data, which can be accessed using unique address codes, and optionally stores program notes (*e.g.*, 10:36-39; 10:45-65; 12:65-68; Weiss Decl., ¶ 99, Exhibit B, at 4-5);

- ***The Specification Describes the Output of the "Compressed Data Library"***: The specification conveyed to one of ordinary skill in the art that the "compressed data library 118" outputs files, or portions of files, to the "transmission format conversion CPU(s) 119" or to the "library access interface 121." (*e.g.*, 13:40-45; Weiss Decl., ¶ 99, Exhibit B, at 4-5);

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. Defendants contend that the specification fails to describe the functions of "dynamically updating" and "dynamically moving" items based on popularity codes occur (*i.e.*, what is the structure, hardware or software, to perform these functions). (Round 3 Defendants' Motion, at 26:1-3). First, the specification makes clear that the functions referred to by Defendants ("dynamically updating" and "dynamically moving") are optional, as they only may occur when the optional popularity code is used. (*See,* 6:39-43: "Storage encoding, performed by identification encoder 112, aside form [sic] giving the item a unique identification code, ***optionally*** involves logging details about the item, called program notes, and assigning the item a popularity code." (emphasis added); and 12:38-39: "Once assigned, the popularity code ***may*** be dynamically updated, by factoring item usage against system usage." (emphasis added); *See,* Weiss Decl., ¶ 100). Consistent with the optional nature of these functions, there is nothing in the claims or the construction of "transmission system" which requires that identification encoder 112 be capable of assigning any popularity codes to any item and nothing which requires that the popularity code be dynamically updated or the items dynamically moved, and therefore the inventors were not required to provide a description of such unclaimed features. *See, Vas-Cath,* 935 F.2d at 1563.

Further, Defendants incorrectly contend that the specification requires that the "compressed data library 118" perform the functions of "dynamically updating" and "dynamically moving". However, the specification does not state that the "compressed data library 118" performs these functions; rather the specification discusses the fact that the compressed data library may utilize multiple media types ***allows*** for various features to be performed with the compressed data library. (*See,* 12:40-47). If deemed to be a requirement of any asserted claim, Defendants even acknowledge that the specification describes these functions, and the fact that these functions can be understood from the specification, in itself, is sufficient to meet the written description requirement. (Round 3 Defendants' Motion, at 26:02-26:1-12).

Defendants also contend that there is no disclosure of any hardware or software for storing, controlling, tracking, locating, and retrieving data that is stored on a multiplicity of different storage devices of various types. (Round 3 Defendants' Motion, at 26:3-9). But there is nothing in the claims or the construction of "transmission system" which requires that the compressed data library be capable of performing the functions of controlling, tracking, locating, and retrieving data that is stored on a multiplicity of different storage devices of various types, and therefore the inventors were not required to provide a description of such an unclaimed functions. *See, Vas-Cath,* 935 F.2d at 1563. Further, Defendants are incorrect that these functions are performed by compressed data library – the specification makes clear that these functions are performed by the database management software, as even Defendants themselves acknowledge when they quote the following from the specification: "[d]atabase management software controls the location and tracking of the compressed data library 118 which can be located across multiple clusters of file servers connected together by one or more high speed networks over multiple systems." (13:23-28; Round 3 Defendants' Motion, at 26:5-8). The fact that these functions are described in the specification itself is sufficient to meet the written description requirement. (*See* Weiss Decl., ¶ 102).

b) The Specification Contains an Enabling Disclosure of the "Compressed Data Library 118."

Defendants also contend that the Yurt Patents do not provide an adequate enabling description of the "compressed data library 118" component of the claimed "transmission system." The undisputed evidence here shows, however, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "compressed data library 118" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Compressed Data Library"***: These are described in detail above in Section V.A.9.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 100-101; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Compressed Data Library"***: The inventors provided sufficient information about the inputs, functions, and outputs of the compressed data library that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 102).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could not have made and used the "compressed data library 118" component of the "transmission system," without undue experimentation, in January 1991.

With respect to the so-called "dynamically updating" and "dynamically moving" features identified by Defendants, again, the specification makes clear that these functions are optional, as they may only occur when the optional popularity code is used. (*See*, 6:39-43 and 12:38-39; Weiss Decl., ¶ 100) The inventors were therefore not required to provide an enabling description of such unclaimed features. *See, Auto. Tech.,* 501 F.3d at 1285 ("Claims must be enabled to correspond to their scope.") Regardless, there is evidence of record showing that one of ordinary skill in the art would have been able from the specification and the knowledge available to them in 1991 to make and use without undue experimentation a compressed data library 118 in which items are dynamically updated and dynamically moved based on popularity codes. (Weiss Decl., ¶¶ 100-102).

With respect to Defendants' contention that there is no enabling disclosure of any hardware or software for storing, controlling, tracking, locating, and retrieving data that is stored on a multiplicity of different storage devices of various types, once again no such requirement exists in any of the limitations of the asserted claims, and no enabling disclosure is required. (Round 3 Defendants' Motion, at 26:3-9). Moreover, as discussed above, these functions are described in the specification as being performed by the database management software which controls the compressed data library. (13:23-28). Even if deemed to be a requirement of any asserted claim, taking this disclosure, together with the knowledge available in 1991, one of ordinary skill in the art could have made and used without undue experimentation a compressed data library 118 controlled by software and made and used such database management software. (Weiss Decl., ¶¶ 100-102)

8. The "Transmission Format Conversion CPUs 119"

a) Defendants again point to a series of features not required by any claim limitation, and therefore the written description and enablement requirements are inapplicable.

As with the other features identified by Defendants in their brief as lacking a written description or being non-enabled, Defendants have again cited features not required by any limitation in the asserted claims or by any of the Court's claim constructions. As such, the written description and enablement requirements are not applicable to these unclaimed features. This time, Defendants identify three such features.

Defendants first contend that the specification fails to describe how the functions of receiving a request, retrieving data from the compressed data library, or converting the format of the data occur (*i.e.*, what is the structure, hardware or software, to perform these functions). (Round 3 Defendants' Motion, at 26:19-25). Defendants then contend that the specification does not disclose what a suitable format is. (*Id.* at 26:25-26.) Defendants also contend that there is no written description of how the "third transmission format CPU 119" depicted in Figure 2b would format both satellite and cable television. (Round 3 Defendants' Motion, at 27:2-5). There is nothing in the claims or the construction of "transmission system" which requires these capabilities. Specifically, nowhere in the claims is it recited that that the "transmission format conversion CPUs" be capable of performing the functions of receiving a request, retrieving data from the compressed data library, or converting the format of the data.

Likewise, there is no limitation in the claims, or even any requirement in the Court's construction of "transmission system," that the "transmission format conversion CPUs" convert the information to any specific format or transmit the information over any specific communication channel. The third rectangle labeled "transmitter" in Figure 2b shows two exiting arrows, one for "satellite" and one for "cable TV." Defendants contend that this means that a single "transmission format conversion CPU 119" in Figure 2b associated with that transmitter would have to be capable of formatting both satellite and cable. But none of the limitations demand such a capability. In short, none of these features are required by the limitations of the asserted claims. Because they are not part of the claimed invention, these features are not subject to either the written description or enablement requirements of 35 U.S.C. §112.

b) The Original Disclosure Contains An Adequate Written Description of the "Transmission Format CPUs 119."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "transmission format conversion CPUs 119" components of the claimed "transmission system." The "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "transmission format conversion CPUs 119" because, among other things:

- ***The "Transmission Format CPU" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2b depicts the "transmission format CPUs 119" that are interconnected with the "compressed data library 118," "library system control computer 1123," and the "transceiver/transmitters 122" elements;

- ***The Specification Describes the Input to the "Transmission Format Conversion CPU"***: The specification conveyed to one of ordinary skill in the art that the "transmission format conversion CPUs 119" receives, among other things, files or portions of files from the "compressed data library 118" and receives requests and commands from the "library system control computer 1123" and/or requests from the remote order processing and item database 300 (*e.g.*, 13:29-47; 15:55-60; Figure 2b; Weiss Decl., ¶ 103, Exhibit B, at 5);

- ***The Specification Describes the Function of the "Transmission Format Conversion CPU"***: The specification conveyed to one of ordinary skill in the art that the "transmission format conversion CPUs 119": (1) retrieves the requested information from the compressed data library 118; and (2) converts the retrieved information into a format suitable for transmission by one or more of the transceivers and/or transmitters. (*e.g.*, 10:29-47; 15:55-60; Figure 2b; Weiss Decl., ¶ 103, Exhibit B, at 5); and

- ***The Specification Describes the Output of the "Transmission Format Conversion CPU"***: The specification conveyed to one of ordinary skill in the art that the "compressed data library 118" outputs transmission requests to the compressed data library and outputs files or portions of files having audio and/or video information to be transmitted to one or more of the transmitters or transceivers 122 (*e.g.*, 10:29-47; 15:55-60; 17:15-18; Figure 2b; Weiss Decl., ¶ 103, Exhibit B, at 5).

Receiving, retrieving, converting

Defendants acknowledge that the functions of receiving a request, retrieving data from the compressed data library, and converting the format of the data are described adequately in the specification (*See*, Round 3 Defendants' Motion at 26:19-23, citing '992 patent, at 13:40-45). Under the controlling Federal Circuit law, such a description in the specification would meet the written description requirement for any claim for which any one or more of these functions are required. Specifically, this functional description in the relevant art is sufficient to convey to a person of ordinary skill in the art that the inventors possessed the claimed invention.

Formatting

Any person of ordinary skill in the art reading the specification would have known that the transmission format conversion CPU would convert the information into a format suitable for transmission on the particular communication channel being utilized, *e.g.*, the transmission format conversion CPU would convert the information into a format suitable for transmission over a cable television system if a cable television communication channel is being used. (Weiss Decl., ¶ 103). *See, e.g., All Dental*, 309 F.3d at 779. As all of the possible communication channels described in the specification (4:61-63; 16:4-15, and 16:62-68) were known in 1991, when the Yurt Patent application was filed, one of ordinary skill in the art would have known what the specific format was required for any particular communication channel. (Weiss Decl., ¶ 104-105). Contrary to Defendants contentions, the inventors were not required to disclose these well-known transmission formats, and in fact are discouraged from doing so. *See, e.g., Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Christianson*, 822 F.2d at 1562.

Formatting by Transmission Conversion CPUs vs. other transmitters

Defendants also contend that the specification does not distinguish between the formatting performed by the transmission format conversion CPUs and the transmitters. (Round 3 Defendants' Motion, at 26:26-27:1). Defendants contend that the transmitters 122 must perform some formatting based on the following sentence from the specification:

> In these situations [distribution occurring through a broadcasting method such as a communications satellite], some further redundancy is included by ***transmission formatter 122*** with the data blocks for error correction processing to be performed in the reception system 200.

(17:15-17) (emphasis added). There is no "transmission formatter 122" depicted in Figure 2b or described in the specification, and therefore, one of ordinary skill in the art would have understood that this reference could be referring to either the "transmission ***format*** conversion CPU 119," or to the "transmitter ***122***," or to both. (Weiss Decl., ¶¶ 184-185). One of ordinary skill in the art would have understood in 1991 that both the "transmission format conversion CPU 119" and the "transmitter 122" were capable of adding further redundancy with the data blocks for error correction processing to be performed in the reception system 200. (Weiss Decl., ¶ 184).

Formatting for both satellite and cable

Although Defendants contend that the specification does not disclose formatting for both satellite and cable television, Defendants acknowledge that Figure 2b shows the two output lines from that transmitter. Thus, even if a written description were required for this unclaimed feature, the patent specification meets that requirement.

c) The Specification Contains an Enabling Disclosure of the "Transmission Format CPUs 119."

Similarly, the Yurt patents provide an enabling disclosure of the transmission format CPUs 119, though none is required by the claim limitations, based on the following information:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Transmission Format Conversion CPUs"***: These are described in detail above in Section V.A.10.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. ¶¶ 104-105); and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Transmission Format Conversion CPUs"***: The inventors provided sufficient information about the inputs, functions, and outputs of the transmission format conversion CPUs that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 106).

Though unclear, because Defendants conflate the written description and enablement requirements, Defendants' motions appear to only identify an enablement issue with respect to three unclaimed aspects of the "transmission format CPUs 119."

Receiving, retrieving and converting

Taking the disclosure in the specification of the functions of the transmission format conversion CPUs, together with the knowledge available in 1991, one of ordinary skill in the art could have made and used, without undue experimentation, transmission format conversion CPUs that were capable of performing the functions of receiving a request, retrieving data from the compressed data library, and converting the format of the data. (Weiss Decl., ¶ 106). As discussed above in Sections IV.A.2. and IV.B.2., the original disclosure need not teach, and preferably omits, what is well known in the art, and disclosure of the general functionality of a computer is often sufficient to meet the enablement requirement, because only routine skill is required to produce a computer program when its functions are known. *See, e.g., Hybritech*, 802 F.2d at 1384; *Northern Telecom*, 908 F.2d at 941 (writing of software code is usually within the skill of the art); *In re Sherwood*, 613 F.2d at 817 n 6; *Fonar*, 107 F.3d at 1549.

Formatting

If deemed to be a requirement of any asserted claim, any person or ordinary skill in the art reading the specification would have known that the transmission format conversion CPU would convert the information into a format suitable for transmission on the particular communication channel being utilized. (Weiss Decl., ¶¶ 103-106). *See, e.g., All Dental*, 309 F.3d at 779. As all of the possible communication channels described in the specification (4:61-63; 16:4-15, and 16:62-68) were known in 1991, when the Yurt Patent application was filed, one of ordinary skill in the art would have been able to make and use a transmission format conversion CPU capable of converting information into a format that could be transmitted over any one of the possible communication channels identified in the specification. *Id.*; *see, e.g., Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Chiron*, 363 F.3d at 1254.

Formatting of satellite and cable

If deemed to be a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation a transmission format conversion CPU that is capable of formatting information into both a cable transmission format and a satellite transmission format from the specification and the knowledge available to one of ordinary skill in the art in 1991. (*See*, Weiss Decl., ¶ 106); *See*, *Hybritech*, 802 F.2d at 1384 ("Furthermore, a patent need not teach, and preferably omits, what is well known in the art.")

9. The "Library System Control Computer 1123"

a) Defendants again rely on only unclaimed features for which no written description or enablement requirement applies.

For the "Library System Control Computer 1123," Defendants attempt to import no less than five (5) features described in the specification, but not recited in any of the asserted claims or

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required by any of the Court's claim constructions. These features Defendants identify are: (1) satisfying user requests for an item with respect to transmission to the location selected by the user and play back at the time selected by the user (Round 3 Defendants' Motion, at 27:15-28:6); (2) controlling the distribution of the requested items, keeping track of the user ID, the chosen program and price, user channel type, number of requests for a given program, latest delivery time, and compressed data library media type (Round 3 Defendants' Motion, at 28:7-14); (3) managing the file transmission process for multiple requests for a single file (Round 3 Defendants' Motion, at 28:15-20); (4) sending the titles from the item database on the library system control computer 1123 (Round 3 Defendants' Motion, at 29:7-10); and (5) confirming reception by the library control computer 1123. (*Id.* at 29:11-14.) None of these features is required by the asserted claims, and therefore the written description and enablement requirements cannot apply. Indeed, several of these features are expressly stated in the specification to be optional. For example, the features of the library system control computer 1123 having the item database master and confirming reception by the library system control computer 1123 are expressly stated as optional features. (*See*, 11:54-58; 17:13-15). The inventors were not required to provide a description of such unclaimed features.

b) The Original Disclosure Contains An Adequate Written Description of the "Library System Control Computer 1123."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "library system control computer 1123" component of the claimed "transmission system." The "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "library system control computer 1123" because, among other things:

- ***The "Library System Control Computer" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2b depicts the "library system control computer 1123" that is interconnected with the "compressed data library 118," "library access interface 121," and the "transmission format conversion CPUs 119" elements;

- ***The Specification Describes the Input to the "Library System Control Computer"***: The specification conveyed to one of ordinary skill in the art that the "library system control computer 1123" receives, among other things, requests for transmission of information via the "library access interface 121" or the "remote order processing and item database 300" and item database entries from the compressed data library (*e.g.*, 13:29-47; 15:23-27; 15:55-60; Figure 2b; Weiss Decl., ¶ 107, Exhibit B, at 11);

- ***The Specification Describes the Function of the "Library System Control Computer"***: The specification conveyed to one of ordinary skill in the art that, among other things, the "library system control computer 1123": (1) receives requests from the library access interface 121 and remote order processing and item database 300; (2) contains a searchable database of available titles; and (3) manages a transmission queue program (*e.g.*, 12:21-24; 15:6-10; 15:33-54; 17:4-11; 17:19-24; Figure 2b; Weiss Decl., ¶¶ 107-108, Exhibit B, at 11); and

- ***The Specification Describes the Output of the "Library System Control Computer"***: The specification conveyed to one of ordinary skill in the art that the "library system control computer 1123" outputs database information to users via application programs and outputs control information to the compressed data library 118 and to the transmission format conversion CPUs 119 (*e.g.*, 12:21-24; 15:6-10; 15:33-35; 15:33-54; 17:4-11; 17:19-24; Figure 2b; Weiss Decl., ¶ 107, Exhibit B, at 11).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention:

Satisfying user requests

If deemed to be a requirement of any asserted claim, Defendants acknowledge that a library system control computer 1123 capable of performing the functions of receiving a request having a designated address and play back time is disclosed in the specification (*See,* Round 3 Defendants' Motion at 27:15-18, citing '992 patent, at 12:21-27) and therefore such description would meet the written description requirement if any claim is deemed to require any of these functions. (Weiss Decl., ¶ 111).

Queue manager program

Queue manager programs were well-known to one of ordinary skill in the art in 1991 (*See*, Weiss Decl., ¶¶ 109-110). Further, Defendants acknowledge that a library system control computer 1123 capable of performing the functions of the queue manager program of controlling the distribution of the requested items, keeping track of the user ID, the chosen program and price, user channel type, number of requests for a given program, latest delivery time, and compressed data library media type is disclosed in the specification (*See,* Round 3 Defendants' Motion at 28:7-14, citing '992 patent, at 15:35-41; *See also*, 16:29-52; Figure 5) and therefore such description would meet the written description requirement for any claim for which any one or more of these functions are required. (Weiss Decl., ¶ 111).

Managing file transmission process

Defendants acknowledge that a library system control computer 1123 capable of performing the function of managing the file transmission process for multiple requests for a single file is disclosed in the specification (*See,* Round 3 Defendants' Motion at 28:15-20, citing '992 patent, at 15:47-54) and therefore such description would meet the written description requirement for any claim for which any one or more of these functions are required. (Weiss Decl., ¶ 111).

Content of "application programs"

Defendants contend that the specification does not describe the content of "application programs" described as running on the library system control computer 1123 and the reception system 200 or how these application programs interact. (Round 3 Defendants' Motion, at 29:1-6). Defendants describe the feature of the library system control computer 1123 of using an application to access the item master database as if it were a mandatory function of the library system control computer, but it is not. (Round 3 Defendants' Motion, at 29:1-6). The specification states that having an item database master that resides in the library system control computer 1123 is merely an optional function of the library system control computer 1123, and, if stored, the access by users of the item database master is also optional: "The item database master ***may*** reside in the system control computer 1123.… The data stored in the item database master ***may*** be accessed by users via application programs …" (11:54-58) (emphasis added). Alternatively, the specification states that the item database master, rather than residing in the library system control computer 1123, could be stored in the remote order processing and item database 300. (*See*, 11:66-12:7).

Consistent with the optional nature of the function, there is no requirement in the Court's construction of "transmission system" that an item data base master reside in the library system control computer 1123 or, if it does reside there, that the user access the item database master. Defendants acknowledge that a library system control computer 1123 capable of performing the function of storing and managing an item database master is disclosed in the specification (*See*, Round 3 Defendants' Motion at 29:1-6, citing '992 patent, at 11:54-60; *See also*, 12:8-27) and therefore such a description would meet the written description requirement for any claim for which any one or more of these functions are required. (Weiss Decl., ¶ 111).

Title information

Defendants acknowledge that a library system control computer 1123 capable of performing the function of sending titles from the library system control computer 1123 (*See*, Round 3 Defendants' Motion at 29:7-10, citing '992 patent, at 17:44-52; *See also* 12:8-27) and therefore such description would meet the written description requirement for any claim for which any one or more of these functions are required. (Weiss Decl., ¶ 111).

Confirm reception by the reception system

Defendants acknowledge that a library system control computer 1123 capable of performing the function of confirming receipt when a broadcasting transmission method is used is described in the specification (*See*, Round 3 Defendants' Motion at 29:11-14, citing '992 patent, at 17:19-23) and therefore such description would meet the written description requirement for any claim for which any one or more of these functions are required. (Weiss Decl., ¶ 111).

c) The Specification Contains an Enabling Disclosure of the "Library System Control Computer 1123."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "library system control computer 1123" component of the claimed "transmission system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "library system control computer 1123" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Library System Control Computer 1123"***: These are described in detail above in Section V.A.11.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 109-110; and

- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Library System Control Computer 1123"***: The inventors provided sufficient information about the inputs, functions, and outputs of the library system control computer that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 111).

Satisfying user requests

If deemed to be a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer 1123 running a distribution manager program that is capable of satisfying user requests for an item with respect to transmission to the location selected by the user and play back at the time selected by the user from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111); *See, Hybritech*, 802 F.2d at 1384 ("Furthermore, a patent need not teach, and preferably omits, what is well known in the art."); *Northern Telecom*, 908 F.2d at 941 (writing of software code is usually within the skill of the art); *In re Sherwood*, 613 F.2d at 817 n 6; *Fonar*, 107 F.3d at 1549.

Queue manager program

One of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer 1123 that is capable of running a queue manager program capable of controlling the distribution of the requested items, keeping track of the user ID, the chosen program and price, user channel type, number of requests for a given program, latest delivery time, and compressed data library media type from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111). As discussed above in Sections IV.A.2. and IV.B.2., the original disclosure need not teach, and preferably omits, what is well known in the art, and disclosure of the general functionality of a computer is often sufficient to meet the enablement requirement, because only routine skill is required to produce a computer program when its functions are known. *See, e.g., Hybritech*, 802 F.2d at 1384; *Northern Telecom*, 908 F.2d at 941 (writing of software code is usually within the skill of the art); *In re Sherwood*, 613 F.2d at 817 n 6; *Fonar*, 107 F.3d at 1549.

Managing file transmission process

One of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer that is capable of running a queue manager program capable of performing the function of managing the file transmission process for multiple requests for a single file from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111).

Content of "application programs"

One of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer that is optionally capable of running application programs to access the item database master from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111).

Title information

One of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer that is optionally capable of including the item master database and of sending titles from the item database master from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111).

Confirm reception by the reception system

One of ordinary skill in the art would have been able to make and use without undue experimentation a library system control computer that is capable of confirming reception, via telephone line connection, of broadcast transmitted data blocks from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 111).

10. The "Library Access Interface 121"

a) The Original Disclosure Contains An Adequate Written Description of the "Library Access Interface 121."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "library access interface 121" component of the claimed "transmission system." The "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "library access interface" because, among other things:

- ***The "Library Access Interface" is Depicted in the Figures as a Component of the "Transmission System"***: Figure 2b depicts the "library access interface 121" that is interconnected with the "library system control computer 1123" and the lines designation for two-way communications with "operator or customer access";

- ***The Specification Describes the Input to the "Library Access Interface"***: The specification conveyed to one of ordinary skill in the art that the "library access interface 121" receives requests for transmission of information and therefore provides access to the compressed information in the compressed data library 118 directly from users or indirectly by remote order processing and item database 300 and receives data from the compressed data library to be sent to users. (*e.g.*, 13:29-51; 15:6-27; 17:44-53; Figure 2b; Weiss Decl., ¶ 112, Exhibit B, at 5);

- ***The Specification Describes the Function of the "Library Access Interface"***: The specification conveyed to one of ordinary skill in the art that the "library access interface 121": (1) receives requests for transmission of information directly from users or indirectly by remote order processing and item database 300; (2) is the place from which information may be sent to the user (as an alternative to transmission via a transmitter 122); and (3) provides a title window to user receiving systems where a list of available titles are alphabetically listed (*e.g.*, 13:29-47; 15:23-25; 17:44-53; Figure 2b; Weiss Decl., ¶ 112, Exhibit B, at 5); and

- ***The Specification Describes the Output of the "Library Access Interface"***: The specification conveyed to one of ordinary skill in the art that the "library access interface 121" outputs received requests to the library system control computer 1123, compressed information to be sent to the user, and a title window where a list of available titles are alphabetically listed (*e.g.*, 13:45-47; 15:23-25; 17:44-53; Figure 2b; Weiss Decl., ¶ 112, Exhibit B, at 5).

Defendants contend that the specification does not state what kind of apparatus serves as the "library access interface 121" or what it actually does. (Round 3 Defendants' Motion, at 29:24-25). In their motion, the Round 3 Defendants acknowledge that the functions of the "library access interface 121" are described in the specification (*See*, Round 3 Defendants' Motion at 29:17-24, citing '992 patent, at 13:37-40; 13:45-47; and 15:23-27). Interfaces were well-known to persons of ordinary skill in the art in 1991. (Weiss Decl., ¶¶ 113-114). Such description therefore meets the written description requirement for the "library access interface," *i.e.*, that the original disclosure reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. (Weiss Decl., ¶ 115). As discussed above in Section IV.A.2., the original disclosure need not teach, and preferably omits, what is well known in the art. *See, e.g., Hybritech*, 802 F.2d at 1384; *Koito Mfg.*, 381 F.3d at 1155; *Christianson*, 822 F.2d at 1562.

Defendants also contend that the specification is "unclear" as to whether block 121 is in the transmission system or in the receiving system. (Round 3 Defendants' Motion, at 29:26-30:2). Block 121, the library access interface, is depicted in Figure 2b as being part of the "transmission system" and it is therefore part of the Court's construction for "transmission system." The "library access interface 121," therefore, appears in every claim that includes the term "transmission system," by virtue of this construction by the Court.

As described by Mr. Weiss, one of ordinary skill in the art in 1991, reading the patent specification, would have understood, based on the disclosures contained therein, that the sentence referred to by Defendants at 17:44-46 would have been understood as though it had been written as follows: "The information distributed by the library access interface 121, when presented by the reception system 200, preferably includes a title window where available titles are alphabetically listed." (Weiss May 18, 2007 Decl., ¶¶ 29-31; Exhibit 4 to Block Decl.).

b) The Specification Contains an Enabling Disclosure of "Library Access Interface 121."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "library access interface 121" component of the claimed "transmission system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "library access interface 121" component of the "transmission system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Library Access Interface 121"***: These are described in detail above in Section V.A.12.a.;

- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 113-114; and

- ***Steps to be Taken by One of Ordinary Skill in the Art to Make and Use the "Library Access Interface 121"***: The inventors provided sufficient information about the inputs, functions, and outputs of the library access interface that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss Decl., ¶ 115).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could not have made and used the "library access interface 121" component of the "transmission system," without undue experimentation, in January 1991. Defendants only address questions as to what is described in the specification, which Acacia has addressed above.

B. Each Of The Components Of The "Receiving System" Meets The Written Description And Enablement Requirements.

In its Sixth Claim Construction Order, the Court construed the claim term "receiving system" to mean a receiving system having the components depicted in Figure 6[26]:

> As used in Independent Claims 19 and 41[27] and their respective Dependent Claims of the '992 Patent[28], "receiving system" means: the configurable, interconnected, assemblage of components labeled and described in the specification as "receiving system 200," a detailed block diagram of which is shown on Figure 6.

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[26] Defendants agree that the Court construed the "receiving system" to mean the "receiving system" depicted in Figure 6: "The Court construed both the 'reception system' limitation of '702 claims 1-42 and the 'local distribution system' limitation of '863 claims 17-19 to mean 'receiving system 200' depicted in Figure 6." (Round 3 Defendants' Motion, at 34:12-14).

[27] Claim 41 of the '992 patent and its dependent claims do not use the term "receiving system," or otherwise refer to a receiving system, and therefore the Court's reference to claim 41 is incorrect. The term "receiving system" does appear in claim 19 of the '992 patent.

[28] The Court's construction is, on its face, limited to claims 19 and 41 of the '992 patent and their dependent claims. For the same reasons as those discussed with respect to "transmission system," the Court's construction for "receiving system" should not apply to any of the asserted system claims, such as asserted claims 1-42 of the '702 patent, which refer to specifically claimed reception systems, having the required components of the reception system defined in the claim itself.

(6th CCO, at 11:19-22).

In their motion, the Round 3 Defendants have parsed the "receiving system" into each of its separate components, and, separately for each component, have contended that there is no written description or enablement for that component. As with the "transmission system," Defendants have again imbued each component with all of the features and functions described in the specification, whether claimed or not or whether described as optional or mandatory in the specification. In other words, under Defendants' interpretation of the Court's construction of "receiving system," every component and function described in the specification is included regardless of whether that feature is claimed. Of course, the Court has not construed the "receiving system" (or any of its components) to include every feature of every embodiment in the specification, nor could it. *See*, *Amgen*, 314 F.3d at 1325; *SRI Int'l*, 775 F.2d at 1121.

"Receiving system," as construed by the Court, was adequately described in the original disclosure and that disclosure satisfied the written description requirement. The original disclosure included Figure 6. Figure 6 shows the components of the "receiving system" and the interconnections between and among them. The originally-filed claims also described "receiving systems" comprised of various combinations of the components of Figure 6.[29] (*See*, Exhibit 3 to Block Decl., the originally-filed claims).

Thus, there cannot be any written description violation, as a matter of law, because: (1) the specification depicts the claimed "receiving system," as construed by the Court in Figure 6; (2) the term "receiving system" was not added in a later-filed claim; and (3) the originally-filed claims provided their own description. *See*, *Vas-Cath*, 935 F.3d at 1563 (referring to "later claimed subject matter"); *Union Oil*, 208 F.3d at 998 n. 4 ("disclosure in an originally filed claim satisfies the written description requirement.”). The Court can therefore stop here and deny Defendants’ motion with respect to the written description issue as to the “receiving system” and each component of the “receiving system.” For completeness, however, Acacia shall, below, separately address Defendants’ specific written description (and enablement) contentions with respect to each of the components of the receiving system identified by Defendants in their motions.

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[29] Originally-filed claim 22 is an independent claim which claimed a "receiving system," comprising certain identified components listed directly in the claim itself (claim 22 required only some, but not all, of the components of Figure 6). (*See*, Exhibit 3 to Block Decl.). Originally-filed dependent claims 23-32 added limitations to the receiving system of claim 22, but still none of originally-filed claims 22-32 claim all of the components of Figure 6 (originally-filed claims 22-32 issued as claims 25-35, as amended, in the '992 patent.) Originally-filed claims 22-32 and issued claims 25-35 are descriptions of 11 different receiving system embodiments. *See, e.g., Jones*, 727 F.2d at 1528 ("Each claim must be considered as defining a separate invention.")

1. The “Receiver Format Converter 202”

a) The Original Disclosure Contains An Adequate Written Description of the “Receiver Format Converter 202.”

Defendants contend that the Yurt Patents do not provide an adequate written description of the “receiver format converter 202” component of the claimed “receiving system.” The original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the “receiver format converter 202,” because, among other things:

- ***The “Receiver Format Converter” is Depicted in the Figures as a Component of the “Receiving System”***: Figure 6 depicts a “receiver format converter 202” that is interconnected with the “transceiver 201” and storage 203;
- ***The Specification Describes the Input to the “Receiver Format Converter”***: The specification conveyed to one of ordinary skill in the art that “receiver format converter” receives compressed, formatted data blocks from the transceiver 201. (18:9-10; Weiss Decl., ¶ 118, Exhibit B, at 8);
- ***The Specification Describes the Function of the “Receiver Format Converter”***: The specification conveyed to one of ordinary skill in the art that the “receiver format converter 202” “converts the compressed formatted data blocks into a format suitable for playback by the user in real time.” Because the received data passes through the decompressors 205 only after passing through the “receiver format converter 202,” the output format must be in a compressed format. (18:10-13; Figure 6; Weiss Decl., ¶ 118, Exhibit B, at 8);
- ***The Specification Describes the Output of the “Receiver Format Converter”***: The specification conveyed to one of ordinary skill in the art that the information output from the converter is passed from the “receiver format converter 202” to the “storage 203,” depending upon whether the information is to be played back immediately or at some later time. (18:14-26; Weiss Decl., ¶ 118, Exhibit B, at 8).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. Defendants contend that there is no disclosure of the apparatus that performs the functions described in the specification, the "format suitable for playback," or how to implement the format conversion. (Round 3 Defendants' Motion, at 31:21-22).

Figure 6 depicts the "receiver format converter 202" as receiving information from the transceiver 201 and passing converted information to the storage 203 for further processing by the data formatter 204, decompressors, and converters 206, meaning that the output from the receiver format converter is compressed audio-video information which must be separated, decompressed, and converted to an appropriate analog or digital format to be viewed or heard. Consistent with the disclosure in Figure 6, the specification states that the receiver format converter performs the function of converting the compressed formatted data blocks into a format suitable for playback by the user in real time. (18:10-13).

One skilled in the art, viewing Figure 6 and reading the specification, would have understood that the transmitted information, which had been formatted for transmission by the "transmission format conversion CPUs 119," would, after being received at the receiving system, need to be re-formatted from its transmission format to a format suitable for play back and would have understood that the "receiver format converter 202" would be the apparatus for performing this function, as this is the first component after the transceiver (just as the "transmission format conversion CPUs 119" are the last component before the transmitters/transceivers in the transmission system.) (Weiss Decl., ¶¶ 118-119). The "receiver format converter 202" is therefore the structure at the receiving system that is analogous to the "transmission format conversion CPUs 119" of the transmission system. *Id.*

Nothing in the claims or the Court's construction for "transmission system" places any limitation on the specific format for the information or "how" to implement the format conversion. If deemed to be a requirement of any asserted claim, the specification discloses that, as the transmission format received from the transmission system by the transceiver of the receiving system would not have been suitable for playback, the "receiver format converter 202" is necessary to perform this conversion. (Weiss Decl., ¶¶ 118-119). In the specification, the "format suitable for playback by the user in real time" is a format from which the received information can be output to a playback system for playback in real time, such as a television or an audio amplifier. (18:36-37). According to the specification this format would still be compressed, as the output from the "receiver format converter 202" is to the storage (from which it then goes to the data formatter/decompressors). Once outputted from the "storage 203," the converted information can be decompressed, converted for output to the specific playback device for that specific type of information (*i.e.*, analog, digital, audio, or video) in real time. (Weiss Decl., ¶ 118).

b) The Specification Contains an Enabling Disclosure of the "Receiver Format Converter 202."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "receiver format converter 202" component of the claimed "receiving system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "receiver format converter 202" component of the "receiving system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Receiver Format Converter 202"***: These are described in detail above in Section V.B.3.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 118-119; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Receiver Format Converter 202"***: The inventors provided sufficient information about the inputs, functions, and outputs of the receiver format converter that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 120).

The Round 3 Defendants have also not met their burden with respect to enablement. The receiver format converter performs the function of converting the compressed formatted data blocks into a format suitable for playback by the user in real time. (18:10-13). As discussed above, one skilled in the art, reading the specification and viewing Figure 6 would have understood that the transmitted information, which had been formatted for transmission by the "transmission format conversion CPUs 119," would, after being received at the receiving system, need to be re-formatted from its transmission format to a format suitable for play back and would have understood that the "receiver format converter 202" would be the apparatus for performing this function, as this is the first component after the transceiver (just as the "transmission format conversion CPUs 119" are the last component before the transmitters/transceivers in the transmission system.") (Weiss Decl., ¶¶ 118-119). One of ordinary skill in the art would have been able to make and use without undue experimentation a receiver format converter that is capable of converting the compressed formatted data blocks from its transmission format into a format suitable for playback by the user in real time from the specification and the knowledge available to persons skilled in the art. (Weiss Decl., ¶¶ 118-120).

2. The "Storage 203"

a) The Original Disclosure Contains An Adequate Written Description of the "Storage 203."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "storage 203" component of the claimed "receiving system." The Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "storage 203," because, among other things:

- ***The "Storage" is Depicted in the Figures as a Component of the "Receiving System"***: Figure 6 depicts a "storage 203" that is interconnected with the "receiver format converter 202," "data formatting 204" (also referred to in the specification as "data formatter 204" (18:22-26));
- ***The Specification Describes the Input to the "Storage"***: The specification conveyed to one of ordinary skill in the art that "storage 203" receives from the receiver format converter 202 compressed data blocks formatted for playback (18:17-19); (Weiss Decl., ¶¶ 121-122, Exhibit B, at 9);
- ***The Specification Describes the Function of the "Storage"***: The specification conveyed to one of ordinary skill in the art that the "storage 203" "allows for temporary storage of the requested item until playback is requested." (4:68-5:9; 18:19-21; Weiss Decl., ¶ 121, Exhibit B, at 9);

- ***The Specification Describes the Output of the "Storage"***: The specification conveyed to one of ordinary skill in the art that the compressed formatted data is passed from the "storage 203" to either the "data formatter 204" or to the compressed portion of the output format conversion 206, depending upon whether the information is to be played back immediately or output in compressed form (5:22-33; 18:22-26; Figure 2b; Weiss Decl., ¶ 121, Exhibit B, at 9).

Managing playback functions

Defendants contend that that the storage must also be capable of managing playback functions: checking times, routing data, and automatically forwarding the data when the time requested for playback arrives. (Round 3 Defendants' Motion, at 32:11-17). Defendants contend that storage 203 lacks written description, because there is no disclosure of how storage 203 stores information when the user's initial request sought play back at a later time, *i.e.*, according to Defendants, the storage 203 must perform certain functions: checking times, routing data, and automatically forwarding the data when the time requested for playback arrives. (Round 3 Defendants' Motion, at 32:11-16). These functions are not required by the asserted claims and there is no basis for requiring these functions be performed by the claimed invention.

Defendants' error is that they presume that the storage 203 only stores information when the user has specified a playback time in their initial request for the information, but this is not the case.[30] One of the objects of the invention described by the patentees was that the ***user*** (not automatically by the storage device, as Defendants contend) may play back the information at any time selected by the user:

> Another object of the present invention is to provide a picture and sound transmission system wherein the user may play back the selected audio/video material at any time selected by the user and retain a copy of the audio/video material for multiple playbacks in the future.

('992 patent, at 2:5-10). Whether the user's initial request for the information to be sent includes a playback time is only an optional feature of the invention (*See*, 12:24-27). The specification describes five examples of how a receiving system having storage 203 may operate, but, in none of those examples is there any requirement that storage occur only when the user's initial request sought play back at a later time:

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[30] Defendants refer to the Court's discussion of the phrase "at a time requested by the user" in claim 19 of the '992 patent, however, the Court's construction of the phrase from claim 19 regarding the user's request is irrelevant to the written description for the storage 203, because the limitations of claim 19 are not limitations of the term "receiving system."

1. The storage of the receiving system may buffer the requested material for later viewing (4:37-51; 4:68-5:3);

2. The storage of the receiving system may perform a combination of buffering and non-buffering by buffering some of the requested material and decompressing the remainder of the requested material for immediate viewing. (5:3-9);

3. The storage of the receiving system may buffer the audio and video for viewing by a user "at a time of their choosing. (5:22-31);

4. The storage temporarily stores a requested item until playback is requested. (18:14-21); and

5. The storage buffers the information "so that it may be stored by the user for possible future viewings." (19:30-34; Figure 7, No. 418).

Thus, there is no requirement in the specification (or in the claims) that the storage function of the storage 203 only occurs when the user included a playback time in their initial request, and therefore the inventors were not required to provide a description of such an unclaimed feature.

If deemed to be a requirement of any asserted claim, Defendants acknowledge that the specification describes the optional feature of the receiving system of storing information and playing it back at time requested by the user. (*See*, Round 3 Defendants' Motion at 32:2-6, citing '992 patent, at 18:19-23) and therefore such description would meet the written description requirement. (Weiss Decl., ¶ 126).

Retrieving information from storage 203

Defendants contend that that there is no description of a component of the receiving system that is responsible for retrieving information from storage 203. (Round 3 Defendants' Motion, at 32 n 24). This complaint by Defendants only emphasizes the type of minutia Defendants claim must be included in the patent specification despite the clear Federal Circuit authority that such information is properly omitted from patent disclosures. One of ordinary skill in the art would have known that any storage, to be operable, would need some control to retrieve information stored within the storage device. Thus, it would have been inherent to one of ordinary skill in the art that a storage device in a system, such as the receiving system of Figure 6, would require such a control component, even though none is explicitly shown in Figure 6. (Weiss Decl., ¶¶ 123-125).

b) The Specification Contains an Enabling Disclosure of the "Storage 203."

Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "storage 203" component of the claimed "receiving system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "storage 203" component of the "receiving system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Storage 203"***: These are described in detail above in Section V.B.4.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶¶ 122-125; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Storage 203"***: The inventors provided sufficient information about the inputs, functions, and outputs of the storage that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 126).

The Round 3 Defendants have not met their burden. With respect to the management of playback functions, Defendants contend that there is no disclosure of how storage 203 stores information when the user's initial request sought play back at a later time, *i.e.*, according to Defendants, the storage 203 must perform certain functions: checking times, routing data, and automatically forwarding the data when the time requested for playback arrives. (Round 3 Defendants' Motion, at 32:11-16). As discussed above, whether the user's request includes a playback time is only an optional feature of the invention (*See*, 12:24-27) and, none of the five examples of the use of storage 203 for storing information in the receiving system require that storage occur only when the user's initial request sought play back at a later time (4:37-51; 4:68-5:3; 5:3-9; 5:22-31; 18:14-21; and 19:30-34). Thus, there is no requirement in the specification (or in the claims) that the storage function of the storage 203 only occurs when the user included a playback time in their initial request, and therefore the inventors were not required to provide an enabling description of unclaimed features, such as alleged management of playback functions. (*See* Weiss Decl., ¶ 121). Further, even if this were a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation a storage device that is capable of being controlled such that it may store information before playback occurs. (Weiss Decl., ¶ 126).

With respect to Defendants' contention that that there is no enabling description of a component of the receiving system that is responsible for retrieving information from storage 203, again, such trivial details are not required to be described in the patent specification. The retrieval of information from storage was commonplace in 1991 to almost any computer user, let alone a person of ordinary skill in the art. Clearly, one of ordinary skill in the art would have been able to make and use without undue experimentation a control component for the storage device from the specification and the knowledge available to persons skilled in the art. (Weiss Decl., ¶ 123-126).

3. The "Data Formatter 204"

a) The Original Disclosure Contains An Adequate Written Description of the "Data Formatter 204."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "data formatter 204" component of the claimed "receiving system." This too is false because of at least the following disclosures in the specification:

- ***The "Data Formatter" is Depicted in the Figures as a Component of the "Receiving System"***: Figure 6 depicts a block entitled "data formatting 204" (elsewhere referred to as "data formatter 204", *e.g.*, 18:22-26) that is interconnected with the "storage 203" and "decompression 205" (elsewhere referred to as "audio decompressor 209 and video decompressor 208", *e.g.*, 18:27-29);

- ***The Specification Describes the Input to the "Data Formatter"***: The specification conveyed to one of ordinary skill in the art that "data formatter 204" receives compressed data blocks suitable for playback from the storage 203 (18:22-26; Weiss Decl., ¶ 127, Exhibit B, at 9);

- ***The Specification Describes the Function of the "Data Formatter"***: The specification conveyed to one of ordinary skill in the art that the "data formatter" "distinguishes audio information from video information." (18:22-26; Weiss Decl., ¶ 127, Exhibit B, at 9);
- ***The Specification Describes the Output of the "Data Formatter"***: The specification conveyed to one of ordinary skill in the art that the separated audio and video information output from the data formatter 204 is passed, respectively, to the audio decompressor 209 and video decompressor 208 (18:22-29; Figure 2b; Weiss Decl., ¶ 127, Exhibit B, at 9).

Defendants argue that that the specification fails to describe what kind of apparatus performs the function of separating the audio information from the video information, how the information is distinguished, and what additional processing is performed. (Round 3 Defendants' Motion, at 32:22-33:2). As they have done throughout their motions, Defendants once again point to a feature that is required nowhere in the claims. Nothing in the Court's construction of "receiving system" limits the "data formatter 204" to any specific apparatus or requires any particular method for distinguishing video information from audio information. The written description requirement is only concerned with whether the original disclosure reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. As construed by the Court, the "receiving system" requires a "data formatter 204," and, as Defendants acknowledge, the specification depicts the "data formatter 204" in Figure 6 and describes it at 18:22-26. (*See,* Weiss Decl., ¶ 128).

b) The Specification Contains an Enabling Disclosure of the "Data Formatter 204."

Defendants also contend that the Yurt Patents do not provide an adequate enabling description of the "data formatter 204" component of the claimed "receiving system." One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "data formatter 204" component of the "receiving system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Data Formatter 204"***: These are described in detail above in Section V.B.5.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶ 127; and

- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Data Formatter 204"***: The inventors provided sufficient information about the inputs, functions, and outputs of the data formatter that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 128).

Thus, if deemed to be a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation a data formatter capable of distinguishing audio from video information and separating audio from video information from the specification and the knowledge available to persons skilled in the art in 1991. (Weiss Decl., ¶ 128)

4. The Decompressors 208 and 209

a) The Original Disclosure Contains An Adequate Written Description of Decompressors 208 and 209.

Defendants contend that the Yurt Patents do not provide an adequate written description of the "decompression" block 205 component of the claimed "receiving system." Figure 6 does not include a "decompression block 205"; Figure 6 depicts two decompressors, 208 and 209 (*See also,* 18:27-29). The original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "decompressors 208 and 209" because, among other things:

- ***The "Decompressors 208 and 209" Are Depicted in the Figures as Components of the "Receiving System"***: Figure 6 depicts two blocks entitled "decompression" (elsewhere referred to as "audio decompressor 209 and video decompressor 208", *e.g.,* 18:27-29) that is interconnected with the "data formatter 204" and "output format conversion 206" (elsewhere referred to as "digital video output converter 211," "analog video output converter 213," "digital audio output converter 212," and "analog audio output converter 214" *e.g.*, 18:18:29-34; Figure 6);

- ***The Specification Describes the Input to the "Decompressors 208 and 209"***: The specification conveyed to one of ordinary skill in the art that "audio decompressor 209 and video decompressor 208" receive separated audio and video information from the data formatter 204. (18:22-29; Figure 6; Weiss Decl., ¶ 129, Exhibit B, at 9);

- ***The Specification Describes the Function of the "Decompressors 208 and 209"***: The specification conveyed to one of ordinary skill in the art that the "audio decompressor 209 and video decompressor 208" decompress compressed audio and video information, respectively. (18:27-35; Weiss Decl., ¶ 129, Exhibit B, at 9);

- ***The Specification Describes the Output of the "Decompressors 208 and 209"***: The specification conveyed to one of ordinary skill in the art that the decompressed audio and video information is passed to the "output format conversion 206" (elsewhere referred to as "digital video output converter 211," "analog video output converter 213," "digital audio output converter 212," and "analog audio output converter 214" *e.g.*, 18:29-34; Figure 6) depending on the type of information decompressed. (Weiss Decl., ¶ 129, Exhibit B, at 9).

Defendants contend that, because compression is inadequately described with respect to the compressor component of the transmission system, there is similar lack of written description for the "decompressors." (Round 3 Defendants' Motion, at 33:5-10). Acacia's discussion as to why there is sufficient written description for the "compressors 116" is contained at Section V.A.7 and Weiss Decl., ¶¶ 90-95. As discussed therein, there is no limitation in the claims, or even any requirement in the Court's construction of "transmission system" or in the specification, that the "compressor 116" be capable of compressing audio and video data to any specific level of quality, let alone to a broadcast level of transmission. Indeed, the asserted claims are not limited to any form of transmission; the specification describes various forms of transmission, such as data over ISDN or B (broadband) ISDN, satellite, cable, local or metropolitan area computer networks, or telephone. (*See*, Figure 2b; 16:6-9). One of ordinary skill in the art would have recognized that the inventors disclosed sufficient information about the decompressors such that they were in possession of those portions of that component of the receiving system. (Weiss Decl., ¶ 130).

b) The Specification Contains an Enabling Disclosure of Decompressors 208 and 209

Figure 6 depicts two decompressors, 208 and 209 (*See also*, 18:27-29). One of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "decompressors 208 and 209" component of the "receiving system," without undue experimentation, in January 1991, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Decompressors 208 and 209"***: These are described in detail above in Section V.B.6.a.;

- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl., ¶ 129; and

- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Decompressors 208 and 209"***: The inventors provided sufficient information about the inputs, functions, and outputs of the decompressors that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss Decl., ¶ 130).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could not have made and used the "decompressors 208 and 209" components of the "receiving system," without undue experimentation, in January 1991. Defendants' argument with respect to enablement is the same as with respect to written description - that because compression is inadequately described with respect to the compressor component of the transmission system, there is similarly a lack of enablement for the "decompressors." (Round 3 Defendants' Motion, at 33:5-10). Again, Acacia's discussion as to why there is sufficient enablement for the "compressors 116" is contained at Section V.A.7 and Weiss Decl., ¶¶ 90-95, and Defendants' argument as to enablement is deficient for the same reasons as it is deficient with respect to written description. (Weiss, Decl., ¶ 130).

5. The "Converters 206"

a) The Original Disclosure Contains An Adequate Written Description of the "Converters 206."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "converter 206" component of the claimed "receiving system." The "converter 206" component is actually comprised of "digital video output converter 211," "analog video output converter 213," "digital audio output converter 212," and/or "analog audio output converter 214" and an unnumbered output for compressed data. The original disclosure of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the "converters 206," because, among other things:

- ***The "Converters" Are Depicted in the Figures as Components of the "Receiving System"***: Figure 6 depicts a series of blocks entitled "output format conversion 206" (comprised of a "digital video output converter 211," "analog video output converter 213," "digital audio output converter 212," and "analog audio output converter 214" *e.g.*, 18:29-34 and an unnumbered block for compressed data, as shown in Figure 6);

- ***The Specification Describes the Input to the "Converters"***: The specification conveyed to one of ordinary skill in the art that the specific "converter 206" receives decompressed audio and/or video information from the respective audio or video decompressors 208 and 209 (18:27-35; Weiss Decl., ¶ 131; Exhibit B, at 9);

- ***The Specification Describes the Function of the "Converters"***: The specification conveyed to one of ordinary skill in the art that the "converters 206" convert the decompressed audio or video information into analog or digital real time output, depending on the converter used. (18:29-35; Weiss Decl., ¶¶ 131-132; Exhibit B, at 9);

- ***The Specification Describes the Output of the "Converters"***: The specification conveyed to one of ordinary skill in the art that the output from the data converters is passed to a playback system such as a TV or audio amplifier or to an audio/video recorder (18:36-38; Weiss Decl., ¶ 131, Exhibit B, at 9).

The Round 3 Defendants have not met their burden of proving, by clear and convincing evidence, that the original disclosure did not reasonably convey to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. Defendants contend that the specification fails to describe how the converters are able to determine whether information is copy protected, and, if so, how to scramble it and fails to describe how the converters are able to provide playback controls. (Round 3 Defendants' Motion, at 33:27-34:2). Yet nothing in the claims, or in the Court's construction of "receiving system" requires the "converters 206" or the "receiving system" to determine whether the material is copy protected, and, if so, to output it in a scrambled format, or to include playback controls. The specification states that copy protection is an optional feature of the system: "In any of the transmission and receiving systems illustrated in FIGS. 1a-1g, the requested material ***may*** be copy protected." (5:34-36; emphasis added). No playback controls are depicted in Figure 6.

If deemed to be a requirement of any asserted claim, the written description requirement is only concerned with whether the original disclosure reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the claimed invention. As construed by the Court, the "receiving system" requires one or more "converters 206," and the specification depicts the "converters 206" in Figure 6 and describes them at 18:29-38 and therefore the written description requirement is met. (Weiss Decl., ¶ 133).

b) The Specification Contains an Enabling Disclosure of the "Converters 206."

Similarly, Defendants contend that the Yurt Patents do not provide an adequate enabling description of the "converter 206" component of the claimed "receiving system." Defendants have also failed to meet their burden on enablement, because, among other things:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "Converter 206"***: These are described in detail above in Section V.B.7.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl. at ¶ 132; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "Converter 206"***: The inventors provided sufficient information about the inputs, functions, and outputs of the converters that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss Decl., ¶ 133).

Nothing in the claims, the specification, or the Court's construction of "receiving system" requires the "converters 206" or the "receiving system" to output copy protected information or to include playback controls. Even if deemed to be a requirement of any asserted claim, one of ordinary skill in the art would have been able to make and use without undue experimentation converters capable of determining whether information is copy protected and of providing play back controls from the specification and the knowledge available to persons skilled in the art in 1991. (Weiss Decl., ¶ 133).

6. The "User/Computer Interface 207"

a) The Original Disclosure Contains An Adequate Written Description of the "User/Computer Interface 207."

Defendants contend that the Yurt Patents do not provide an adequate written description of the "user/computer interface 207" component of the claimed "receiving system." Specifically, Defendants contend that that the specification fails to mention the user/computer interface 207 or provide any information about the nature and function of "block 207." (Round 3 Defendants' Motion, at 33:16-18). Defendants' argument falls short, because, among other things:

- ***The "User/Computer Interface" Is Depicted in the Figures as a Component of the "Receiving System"***: Figure 6 depicts a user/computer interface 207 which interacts with the user and with the transmission system;

- ***The Specification Describes the Input to the "User/Computer Interface"***: The specification conveyed to one of ordinary skill in the art that the user/computer interface receives input from the user via a viewer control interface, depicted in Figure 6, and receives input, such as a list of available titles and other database, from the library system control computer of the transmission system information. (14:64-15:22; 17:44-53; Weiss Decl., ¶ 134, Exhibit B, at 9);

- ***The Specification Describes the Function of the "User/Computer Interface"***: The specification conveyed to one of ordinary skill in the art that the "user/computer interface 207" accepts the user input of instructions to be communicated to the transmission system and accepts information from the library system control computer of the transmission system, such as a list of available titles. (Figure 6 and 14:64-15:22; 17:44-53; Weiss Decl., ¶ 134, Exhibit B, at 9); and

- ***The Specification Describes the Output of the "User/Computer Interface"***: The specification conveyed to one of ordinary skill in the art that the output of user communications from the user/computer interface is passed to the library system control computer of the transmission system, and output of a listing of contents of item database in a title window to users. (Figure 6 and 14:64-15:22; 17:44-53; Weiss Decl., ¶ 134, Exhibit B, at 9).

Although Defendants complain that the specification provides no information about the "user/computer interface 207" depicted in Figure 6, one of ordinary skill in the art would have known what the user/computer interface 207 was from the specification. (Weiss Decl., ¶ 134-136). Further, although the words "user/computer interface" are not specifically used in the specification other than in Figure 6, the use of a user/computer interface is clearly described in the specification at

14:64-15:22 as one method by which a user can have access to the transmission system (another method described is by a separate, personal computer) and at 17:44-53 as displaying item database information, *i.e.*, a listing of available titles in a title window.

As discussed above in Section IV.A.1., the written description requirement is fact intensive, and therefore compliance with the written description requirement can be met in any manner and with any length of text. *See, In re Wertheim*, 541 F.2d at 262 ("how the specification accomplishes [the written description requirement] is not material."); *Lockwood*, 107 F.3d at 1572 (written description requirement can be met "by such descriptive means as words, structures, figures, diagrams, formulas, etc.")

b) The Specification Contains an Enabling Disclosure of the "User/Computer Interface 207."

Defendants also contend that the Yurt Patents do not provide an adequate enabling description of the "user/computer interface 207" component of the claimed "receiving system." As discussed above, Figure 6 of the specification in itself provides an adequate disclosure, including sufficient detail to enable the making and using of this feature in view of the following information available to one of ordinary skill:

- ***The Specification Describes the Inputs, Functions, and Outputs of the "User/Computer Interface 207"***: These are described in detail above in Section V.B.8.a.;
- ***Knowledge Available to One of Ordinary Skill in the Art***: Described in Weiss Decl., at ¶¶ 134-135; and
- ***One of Ordinary Skill in the Art Would Have Been Able to Make and Use the "User/Computer Interface 207"***: The inventors provided sufficient information about the inputs, functions, and outputs of the user/computer interface that one could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, by applying the processes of system design that were normal for the development of such technical objects. (Weiss, Decl., ¶ 136).

Even though the words "user/computer interface" are not specifically used in the specification, the use of a user/computer interface is clearly described in the specification at 14:64-15:22 and 17:44-53. One of ordinary skill in the art would have been able to make and use without undue experimentation a user/computer interface 207 from the specification and the knowledge available to persons skilled in the art. (Weiss Decl., ¶ 136).

7. The Reception Confirmation Function

a) The Original Disclosure Contains An Adequate Written Description of the Reception Confirmation Function.

Defendants contend that the specification lacks written description of the functionality of the receiving system to confirm reception of the initial data block. Nothing in the claims, or in the Court's construction of "receiving system" requires that the "receiving system" confirm reception of the initial data block. Figure 6 (the Court's construction of "receiving system") does not depict the "reception confirmation function."

If deemed to be a requirement of any asserted claim, the specification describes this feature of the "receiving system," and Defendants quote from this portion of the specification in their motion (Round 3 Defendants' Motion, at 34:6-8):

> In order that reception is performed efficiently, the reception system 200 confirms reception of the initial data block before receiving the remaining data blocks whenever possible (step 5060). After all data blocks have been received and reception is confirmed, the communications controller breaks the physical connection to the reception system 200 (step 5070). Then, confirmation of the transmission is sent to the queue manager (step 5080). Finally, the queue manager updates the list and sends the information to the billing program, which updates the account of the user (step 5090).

('992 patent, at 17:1-11).

The reception confirmation function was well-known to persons of ordinary skill in the art and this function was sufficiently described in the '992 patent specification that one skilled in the art would have recognized that the inventors were in possession of the reception confirmation function in 1991. (Weiss Decl., ¶¶ 137-139).

b) The Specification Contains an Enabling Disclosure of the Reception Confirmation Function.

Defendants contend that the specification lacks an enabling description of the functionality of the receiving system to confirm reception of the initial data block. One of ordinary skill in the art would have been able to make and use without undue experimentation a receiving system capable of confirming reception of the initial data block from the specification and the knowledge available to persons skilled in the art. (Weiss Decl., ¶ 139). As discussed above in Section Sections IV.A.2. and IV.B.2., the original disclosure need not teach, and preferably omits, what is well known in the art, and disclosure of the general functionality of a computer is often sufficient to meet the enablement requirement, because only routine skill is required to produce a computer program when its functions are known. *See, e.g., Hybritech*, 802 F.2d at 1384; *Northern Telecom*, 908 F.2d at 941 (writing of software code is usually within the skill of the art); *In re Sherwood*, 613 F.2d at 817 n 6; *Fonar*, 107 F.3d at 1549.

VI. NONE OF THE ASSERTED CLAIMS ARE INVALID FOR VIOLATING THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS BY "CLAIMING MORE BROADLY THAN THE SPECIFICATION DISCLOSES," AS DEFENDANTS' CONTEND.

In the section of the Round 3 Defendants' Motion entitled "Point III," Defendants address their contentions that each of the asserted claims of the '992 and '863 claim "more broadly than the specification discloses." Defendants contend that, as a result, these asserted claims are invalid for violating the written description and enablement requirements.

Before addressing Defendants' specific contentions, Acacia shall remind the Court that there is no rule that a claim has to be of equal or narrower scope than the specification, as the Round 3 Defendants' recitation of the law at 35-36 of their Motion would imply. Defendants' suggestion to the contrary defies both well-settled Federal Circuit law and logic. Claims are frequently stated more broadly than the description of the embodiments in the specification. Under Defendants' distorted statement of the law, there would be no need for claims at all, as they would be precisely the same scope as the specification and incorporate every aspect of the preferred embodiments. Clearly, this is not the law, and, as set forth above in Section V.A.2., the Federal Circuit has stated repeatedly that one may claim his or her invention more broadly than the preferred embodiments disclosed in the specification.

A. The Asserted Claims Of The '992 And '863 Patent Are Not Invalid For Claiming A "Sequence Of Addressable Data Blocks."

The Round 3 Defendants contend that claims having the phrase "sequence of addressable data blocks" are invalid for failing to meet the written description and enablement requirements, because, according to Defendants, the claim phrase "sequence of addressable data blocks" is a broad limitation which is not limited to, but could include time encoding, making it broader than the scope of the specification, which only discloses "time encoding." (*See,* Round 3 Defendants' Motion, at 37:1-39:5). Defendants are wrong.

Contrary to Defendants' contention, the claim phrase "sequence of addressable data blocks" is limited to "time encoding," because the Court's construction requires that the step of placing data into a "sequence of addressable data blocks" must occur "in the transmission system":

> In a distribution method in which a transmission system stores the information, "ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks means "***in the transmission system*** placing the converted analog signals and the formatted digital signals into a sequence of data blocks, such that the ordering of the data blocks permits the retrieval of portions of information from items." "Addressable" does not refer to physical storage locations, but rather to positions relative to the beginning of a file containing information.[31]

(3rd CCO, at 28:7-13) (emphasis added). The Court construed the "transmission system" to be limited to the components of Figures 2a and 2b. Figure 2a depicts only "time encoding 114." Thus, the "transmission system" must be limited to "time encoders," as Defendants themselves agree: "[t]he 'transmission system' contains 'time encoder 114,' depicted as four wall clocks in Figure 2." (*See*, Round 3 Defendants' Motion, at 20:7-8). Therefore the Court's requirement that the "sequence of addressable data blocks" be created in the "transmission system" means that the claim phrase "sequence of addressable data blocks" **is** limited to "time encoding."

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[31] This construction was specific to the use of the phrase "sequence of addressable data blocks" in claim 20 of the '992 patent. The Court made a similar construction with respect to the same phrase in claim 41 of the '992, which also required that the step occur in the "transmission system." (3rd CCO, at 31:1-9).

Thus, if the specification is limited to "time encoding," as Defendants contend, and if the claim phrase "sequence of addressable data blocks" is limited by the Court's construction to "time encoding," no written description violation is possible, because the scope of the claims and the specification are identical, making it clear that the inventors disclosed, and therefore possessed, time encoding in 1991. *See, e.g., Vas-Cath*, 935 F.3d at 1563. Further, as discussed above in Section V.A.6.B., one of ordinary skill in the art, using the knowledge available to such a person and the disclosure in the patent document could have made and used the "time encoder 114" component of the "transmission system," without undue experimentation, in January 1991 to create a sequence of time encoded data blocks. (*See*, Weiss Decl., ¶ 80).

Even if the scope of the claim phrase "sequence of addressable data blocks" includes, but is not limited to, "time encoding," as Defendants' contend, claims having this phrase still meet the written description and enablement requirements. The Federal Circuit has repeatedly held that the written description requirement may be met where the scope of the claims is broader than the specification.[32] This situation is exactly like that described in *In re Smythe*, 480 F.2d at 1384, where the court described the hypothetical situation of a specification which narrowly describes only a 1-pound "lead weight," as a counterbalance to determine the weight of a pound of flesh, as providing adequate written description for a broader claim to a "weight" or to a different type of weight, "a pound of feathers." Thus, as in *Smythe*, the narrower term "time encoding" in the specification is adequate written description support for the broader claim term "sequence of addressable data blocks" in the claims.[33]

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[32] *See, Cordis Corp.*, 339 F.3d at 1365 ("'A specification may, within the meaning of 35 U.S.C. § 112, para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses.' *Utter v. Hiraga*, 845 F.2d 993, 998 (Fed. Cir. 1988)."); *Ralston Purina*, 772 F.2d at 1575 ("In addition, a predecessor to this court has held 'that a claim may be broader than the specific embodiment disclosed in the specification is in itself of no moment.'"), *quoting*, *In re Rasmussen*, 650 F.2d 1212, 1215 (C.C.P.A. 1981); *The Regents of the University of California*, 03-CV-05669-JW, 2007 WL 2580594 ("However, there is no general proposition in patent law that the written description requirement is violated if the original description is narrower than a broad claim."); *Bilstad*, 386 F.3d at1124 (Fed. Cir. 2004) ("Thus, this court has continued to apply the rule that disclosure of a species may be sufficient written description support for a later claimed genus including that species.")

The Federal Circuit has also repeatedly held that the enablement requirement may be met where claims are broader than the specification.[34] In this case, one of ordinary skill in the art using the knowledge available to such a person and the disclosure in the patent document could have made and used a transmission system capable of placing formatted information into a sequence of addressable data blocks (where this claim phrase is not limited to time encoding), without undue experimentation, in January 1991, even if the specification was limited to "time encoding." As evidenced by the testimony of Dr. Stephen M. Walters, in his declaration dated July 17, 2007, submitted by Defendants in support of their opposition to Acacia's Motion for Reconsideration, persons of ordinary skill in the art in 1991 would have known, apart from the patent, that sequences other than time encoding were used as addressing schemes:

> Many ways of "addressing" and "relative addressing" other than using time codes are well known. For example, "relative addressing" can be achieved by using simple sequential numbering of data blocks from 1 to N in conjunction with the storage location of the start of the file. Those of ordinary skill in the

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[33] Claims having the phrase "sequence of addressable data blocks" meet the written description requirement for the additional reason that the phrase "sequence of addressable data blocks" is part of the original disclosure (2:25-39; 7:59-62; and 8:59-62), including originally-filed claim 1. (Exhibit 3 to Block Decl.). *See, e.g., Vas-Cath*, 935 F.3d at 1563 (referring to "later claimed subject matter") and *Union Oil*, 208 F.3d at 998 n 4 ("disclosure in an originally filed claim satisfies the written description requirement.")

[34] *See, Spectra-Physics*, 827 F.2d at 1533 ("If an invention pertains to an art where the results are predictable, mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment, [citations omitted], and is not invalid for lack of enablement simply because it reads on another embodiment of the invention which is inadequately disclosed."); *U.S. v. Telectronics*, 857 F.2d at 786 ("Since one embodiment is admittedly disclosed in the specification, along with the general manner in which its current range was ascertained, we are convinced that other permutations of the invention could be practiced by those skilled in the art without undue experimentation. *See SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (the law does not require an applicant to describe in his specification every conceivable embodiment of the invention)."); *Chiron*, 363 F.3d at 1253 ("'That is not to say that the specification itself must necessarily describe how to make and use every possible variant of the claimed invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art.' *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003).")

> art would not understand the concepts of addressing or relative addressing to be limited to the use of time codes.

(Decl. of Stephen M. Walters, at ¶ 40; Exhibit 5 to Block Decl.).

B. Claims 41 And 45 Of The ‘992 Patent And Claims 17-19 Of The ‘863 Patent Are Not Invalid For Claiming Sending Information Without A User Request.

Defendants contend in both of their Motions, that the asserted claims 41 and 45 of the ‘992 patent and 17-19 of the ‘863 patent are invalid for violating the written description requirement as these claims do not include the limitation that the information be sent in response to a user request. (*See*, Round 3 Defendants’ Motion, at 39:6-41:23 and Satellite Defendants’ Motion, at 4:7-9:18). Defendants contend that the specification only describes that the transmission of information occurs in response to a user request and therefore claims 41 and 45 of the ‘992 patent and claims 17-19 of the ‘863 patent, which do not require a user request, are broader than the supporting specification. *Id.*

The written description requirement is satisfied for claims 41 and 45 of the ‘992 patent and claims 17-19 of the ‘863 patent, because the “original disclosure” of the Yurt Patents (including the originally-filed claims) reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of a method of transmitting information without first receiving a user request. *See*, *Vas-Cath*, 935 F.3d at 1563 (referring to “later claimed subject matter”); *Union Oil*, 208 F.3d at 998 n. 4 (“disclosure in an originally filed claim satisfies the written description requirement.”)

The “original disclosure” of the Yurt Patents discloses the transmission of information ***without*** a user request. In the “Summary of the Invention” section of the original disclosure, the patentees described the system needed “[t]o achieve the objects in accordance with the purposes of the present invention” as including a transmitter means, but the system described therein did not require a user request before any information is transmitted or even require any component in the transmission system capable of receiving a user request:

> ***To achieve the objects in accordance with the purposes of the present invention, as embodied and described herein, the transmission and receiving system for providing information to remote locations comprises*** source material library means prior to

> identification and compression; ... compressed data storing means, coupled to the compression means, for storing as a file the compressed sequenced data received from the compression means with the unique identification code assigned by the identification encoding means; and ***transmitter means, coupled to the compressed data storing means, for sending at least a portion of a specific file to a specific one of the remote locations***.

('992 patent, at 2:25-48) (emphasis added).

The Court itself, in its 3rd CCO, held that this very description of the transmission system was the patentees' "definition" of the components of the "transmission system." (3rd CCO, 6:22-25). Indeed, the Court, in the 3rd CCO, construed the "transmission system," consistent with this so-called patentees' definition of the transmission system, as not including any component capable of receiving a user request. (3rd CCO, at 8:21-24).

Further, Defendants ignore originally-filed claim 1 of the Yurt Patents, which discloses a transmission system that is capable of transmitting information ***without receiving a user request.*** Originally-filed claim 1 claimed a "transmission system," and specified which components were required to be present in the claimed "transmission system." *See, Union Oil*, 208 F.3d at 998 n 4 ("disclosure in an originally filed claim satisfies the written description requirement.") None of the components specified in originally-filed claim 1 were capable of receiving a request.[35] (Weiss Decl., ¶ 142).

The Court itself recognized that claim 1 does not require a user request for transmission of an item:

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[35] Originally-filed claim 1 uses the transitional term "comprising," meaning that other components, in addition to those specified in the claim, such as a library access interface 121, could be included, but are not required. *See, Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) ("'Comprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.") The presence of originally-filed dependent claim 7 makes clear that originally-filed claim 1 does not require any component capable of receiving a user request. Originally-filed claim 7 depends from claim 6, which depends from claim 2, which depends from claim 1 and adds the limitation that the transmission system includes a "library access interface means, coupled to the transmission format means, ***for receiving transmission requests to transmit items*** …" (emphasis added) (Exhibit 3 to Block Decl.). The presence of dependent claim 7 demonstrates that there is no requirement in claims 1, 2, or 6 that there be a component capable of receiving requests to transmit items. *See, SRI Int'l*, 775 F.2d at 1122 ("It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement.")

> Unlike other claims of the '992 patent that describe systems responsive to requests from a user (e.g., claims 19 and 47), there is no such limitation in independent claims 1 and 41.

(1st CCO, at 4:23-24).

Thus, the "original disclosure" of the Yurt Patents would have reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the subject matter of claims 41 and 45 of the '992 patent and claims 17-19 of the '863 patent, as the "original disclosure" described the transmission of information without any user request. (Weiss Decl., ¶ 141-143). [36]

C. Claims 41 And 45-46 Of The '992 Patent Are Not Invalid For Claiming Transmission Of Information To One of a Plurality of "Remote Locations."

Defendants contend that claims 41 and 45-46 of the '992 patent are invalid for allegedly violating the written description requirement, because these claims do not require that the information be transmitted to a receiving system; instead, they only require that the information be transmitted to one of a plurality of remote locations. (Round 3 Defendants' Motion, at 42:1-43:7).

The written description requirement is satisfied for claims 41 and 45-46 of the '992 patent, because the "original disclosure" of the Yurt Patents (including the originally-filed claims) reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of a method of transmitting information to one of a plurality of remote locations. (Weiss Decl., ¶¶ 144-146). The Court construed the term "remote locations" to mean "positions or sites distant in space from the transmission system." (3rd CCO, at 12:6-9).

The "original disclosure" of the Yurt Patents discloses more than once the transmission of information to at least one of a plurality of remote locations (rather than only to a receiving system). For example, in the "Summary of the Invention" section of the original disclosure, the patentees described the system needed "[t]o achieve the objects in accordance with the purposes of the present invention" as transmitting information to "a specific one of the remote locations":

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[36] In addition to the written description, the Round 3 Defendants contend that Section 112, ¶ 2 is violated, as they contend that claims 41 and 45 of the '992 patent and claims 17-19 of the '863 patent do not "set forth the subject matter which the applicant regards as his invention." (Round 3 Defendants' Motion, at 41:16-23). But, as demonstrated above, the patentees made clear in the specification and originally-filed claims that they did regard, as at least one embodiment of their invention, transmitting information without a user request.

> To achieve the objects in accordance with the purposes of the present invention, as embodied and described herein, the transmission and receiving system for providing information to remote locations comprises ... transmitter means, coupled to the compressed data storing means, ***for sending at least a portion of a specific file to a specific one of the remote locations***.

('992 patent, at 2:25-48) (emphasis added).

Elsewhere in the "Summary" section, the inventors described transmission to a remote location:

> The present invention further comprises a distribution method responsive to requests identifying information ***to be sent from a transmission system to a remote location***, the method comprising the steps of storing audio and video information in a compressed data form; requesting transmission, by a user, of at least a part of the stored compressed information ***to the remote location***; sending at least a portion of the stored compressed information ***to the remote location***; receiving the sent information ***at the remote location***; buffering the processed information ***at the remote location***; and playing back the buffered information in real time at a time requested by the user.

('992 patent, 2:49-61) (emphasis added).

Similarly, in the Detailed Description section of the Yurt Patents, the inventors stated that "[t]he transmission system 100 of the present invention preferably further includes transmitter means 122, coupled to the compressed data library 118, for sending at least a portion of a specific file to at least one remote location." (15:61-65). Further, originally-filed claim 1 related to a "transmission system for providing information ***to remote locations*** … comprising: ... transmitter means, coupled to the compressed data storing means, ***for sending at least a portion of a file to one of the remote locations***." (Exhibit 3 to Block Decl.) (emphasis added).

Originally-filed claim 18 also related to transmission to remote locations:

> 18. A distribution method responsive to requests identifying information to be sent from a transmission system ***to remote locations***
> ...
>
> requesting transmission, by a user, of at least a part of the stored compressed data ***to a remote location*** selected by the user;

> sending at least a portion of the stored compressed information to the remote location; receiving the sent information ***at the remote location***;
>
> buffering the received information ***at the remote location***;"

(Exhibit 3 to Block Decl.) (emphasis added).

In other sections of the specification, the inventors made clear that the "remote location" to which the information is transmitted can be the location of the playback of the video and/or audio information, i.e., the user's playback device, rather than the location of the receiving system, as Defendants contend. According to the specification, the user's playback device may be at a different location than the receiving system. For example, in Figures 1d-1g, the "user" is remote from the receiving system, which can be, for example, a cable head end. The inventors further described how the user's request may include the identity of a delivery location, which is not a receiving system, but rather is the playback location:

> If the confirmation performed in step 3070 is correct, the user so indicates and then inputs a desired delivery time and delivery ***location*** (step 3090).... The user then preferably confirms that the order is correct (step 3100). The confirmation performed in step 3100 includes confirmation of the entire transaction including the selected item, the selected time of playback, and ***the location of the playback***.

(14:30-33 and 14:41-45; Figure 3) (emphasis added); (*see also*, (1) 15:20-22: "After the desired item is found, the user selects the item for transmission at a specific time and ***location*** (step 4030)"; (2) 12:24-27: "The request contains the ***address of the user***, the address of the item, and optionally includes the specific frame numbers, and a desired viewing time of the item"; and (3) Figure 7 "send to remote location" (416) and "receive at remote location" (417)).

At 42:13-43:2 of their Motion, the Round 3 Defendants cite to portions of the specification in which the transmission is described as being to a receiving system, rather than to a remote location. Defendants, however, ignore the many embodiments in the specification, described above, in which the audio/video information is explicitly described as being sent to remote locations.

Defendants further contend that there is "no support in the specification for a transmission system sending information to a location that does not have a receiving system." (Round 3 Defendants' Motion, at 42:11-13). Defendants are wrong, because the specification describes, for example, broadcasting information using a satellite transmitter. (*See,* Figure 2b; 16:4-11; 16:62-68; 17:12-24). Persons of ordinary skill in the art would have understood that such transmitters broadcast information generally to all remote locations within a geographic area, whether or not a receiving system exists at any particular remote location. (Weiss Decl., ¶ 145).

Thus, the "original disclosure" of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the subject matter of claims 41 and 45-46 of the '992 patent, as the "original disclosure" described the transmitting information to one of a plurality of remote locations.[37] (Weiss Decl., ¶¶ 144-146).

D. Claims 17-19 Of The '863 Patent Are Not Invalid Regarding Storage of Compressed Data.

Defendants contend that claims 17-19 of the '863 patent are invalid as allegedly violating the written description requirement, because, according to Defendants, in claim 17, the compressed data is "immediately" transmitted by the transmission system without storing the compressed data in a compressed data library 118. (Round 3 Defendants' Motion, at 43:9-44:10). Nothing in claim 17 states that the compressed data is "immediately" transmitted by the transmission system; those are Defendants' words, not the claim's words. Defendants contend that the sentence from the specification at 6:35-39 requires that the compressed information be stored prior to being made accessible to a user: "Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112." ('992 patent, 6:35-39).

Claim 17 of the '863 patent meets the written description requirement. First, claim 17 of the '863 patent, as construed by the Court, does require that the item be stored in a compressed data library 118 prior to being made accessible to the user, because claim 17 requires that the compressed data be transmitted from a "transmission system"[38] to a local distribution system. The Court construed the "transmission system" to require the configurable, interconnected, assemblage of components of Figures 2a and 2b, which, as Defendants acknowledge, includes a compressed data library 118: "The 'transmission system' contains 'compressed data library 118.'" (Round 3 Defendants' Motion, at 25:14). As claim 17 requires a "transmission system," and as the "transmission system" requires, as one of its interconnected components, a "compressed data library 118," claim 17, as construed by the Court, requires that the compressed data be stored in a "compressed data library 118."

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[37] In addition to the written description, the Round 3 Defendants contend that Section 112, ¶ 2 is violated, as they contend that claims 41 and 45-46 of the '992 patent do not "set forth the subject matter which the applicant regards as his invention." (Round 3 Defendants' Motion, at 43:3-7). But, as demonstrated above, the patentees made clear in the specification and originally-filed claims that they did regard, as at least one embodiment of their invention, transmitting information to one or more remote location.

Claim 17 of the '863 patent also requires that the compressed item be stored in a compressed library in the local distribution system prior to being made accessible to a user of the transmission and receiving system. Claim 17 explicitly requires that the compressed item be transmitted from the central processing location (i.e., transmission system) to the local distribution system, where an entire copy of the item is stored prior to being made accessible to the user: "storing the received compressed, digitized data representing the complete copy of the at least one item at a local distribution system." (Claim 17 of the '863 patent, at 22:31-34). The Court has construed the "local distribution system" to be "a reception system, as previously defined, located geographically close to subscriber receiving stations which are coupled to the reception system." (4th CCO, at 8:6-8). The reception system contains storage 203, which stores compressed items, and therefore comprises a compressed data library. (See Weiss Decl., ¶ 122).

Lastly, contrary to Defendants' contention, there is no requirement in the original disclosure that the item must be stored in a compressed data library 118 prior to being made accessible to the user. The original disclosure includes an embodiment of the invention in originally-filed claim 22 which does not require storage of the item in a compressed data library prior to being made accessible to the user. Originally-filed claim 22 claimed "a receiving system responsive to a user input identifying a choice of an item stored in a source material library to be played back to the subscriber at a location remote from the source material library, the item containing information to be sent from a transmitter to the receiving system." (Exhibit 3 to Block Decl.). Nowhere does original claim 22 require that the item be stored in a compressed data library prior to its transmission to the receiving system.

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[38] Claim 17 requires transmission from a "central processing location," which the Court has construed to be a "transmission system." (4th CCO, at 6:18-20).

Thus, even if the Court were to agree with Defendants that claim 17 does not require that the item be stored in a compressed data library before being made accessible to the user, the Court nevertheless cannot invalidate claim 17 on this basis, because there is written description support in originally-filed claim 22 for a method of transmitting a compressed item to a user without the limitation that the item be stored in a compressed data library 118 before being made accessible to the user.

E. Claim 46 Of The '992 Patent Is Not Invalid Regarding A Request That Specifies a Reception System.

Defendants contend that claim 46 of the '992 patent violates the written description requirement, because, as Defendants contend, the request of claim 46 does not require that the user specify the reception system to which the information is to be transmitted. (Round 3 Defendants' Motion, at 44:11-45:11).

The Court should not address this issue, because it was not properly raised by Defendants. Defendants did not identify this issue to Acacia in any of Defendants' letters or submissions to the Court prior to the filing of Defendants' motion. (See, Exhibit 6 to Block Decl. which are Defendants' letters). Pursuant to the Court's Order of March 12, 2008 (D.I. No. 272, referring to D.I. 267), Defendants were to have identified to Acacia all Section 112 grounds for invalidity to be included in these motions, so that Acacia could consider such issue and determine how to proceed against such contention. (March 12, 2008 Order, at 1). The Court's Order of May 27, 2008 (D.I. No. 282) only authorized Defendants to bring dispositive motions on "the disputed issues ***identified in the Defendants' letters***." (May 27, 2008 Order, at 1:21-23; emphasis added).

Defendants' new contention is that the specification discloses that the user is required to identify in his or her request the identity of the reception system to which the information will be sent, but this limitation is not included in claim 46 of the ‘992 patent.[39] Defendants, however, ignore portions of the original disclosure which do not require that the identity of the destination be included with the request, and which do not even require that a request be made, and therefore claim 46 of the ‘992 patent is adequately described. For example, when discussing the meaning of “remote locations” in the claims, the Court specifically held that the specification discloses a configuration that ***does not require a user to select a particular location***:

> ***The specification discloses a configuration that does not require a user to select a particular location***. Figure 1g of the ‘992 patent shows a transmission system distributing to a receiving system, which preferably transmits requested material over airwave communication channels to a plurality of users. (‘992 patent, 4:53-57). Also, the specification discloses “[t]he transmission system 100 of the present invention preferably further includes transmitter means 122, coupled to the compressed data library 118, for sending at least a portion of a specific file to at least one remote location.” (‘992 patent, 15:61-65).

(1st CCO, at 5:15-21; emphasis added).

Further, as discussed in more detail above in Section VI.B., the original disclosure of the Yurt Patents describes a number of embodiments in which no request at all is required, let alone a request that includes the identity of a receiving system. (*See*, ‘992 patent, at 2:25-48; originally-filed claim 1; Exhibit S to Block Decl.; and 1st CCO, at 4:23-24).

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[39] Defendants’ purported quote of 5:10-21 of the ‘992 patent is incomplete and leaves the false impression that the description in that quote applies to all embodiments, when, in fact, it does not. (*See*, Round 3 Defendants’ Motion, at 44:19-24). Defendants leave off the qualifier (emphasized portion) from the first sentence which states that “***In direct connection configurations, such as reception systems 200 shown in FIGS. 1e and 1f,*** the user preferably selects the reception system 200 to which the requested material is sent ...” (‘992 patent, 5:10-13).

VII. NONE OF THE ASSERTED CLAIMS ARE INVALID FOR VIOLATING THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS BY "CLAIMING METHOD STEPS THAT ARE NOT DESCRIBED, OR ARE INADEQUATELY DESCRIBED, IN THE SPECIFICATION," AS DEFENDANTS' CONTEND.

A. Claims 17-19 of the '863 Patent Are Not Invalid For Claiming "Inputting an Item Having Information Into The Transmission System."

Defendants contend that the phrase of claim 17 of the '863 patent—"inputting an item having information into the transmission system"—does not meet the written description or enablement requirements. (Round 3 Defendants' Motion, at 45:15-48:4; Satellite Defendants' Motion, at 16:3-18:7). The Court construed the phrase "inputting an item having information into the transmission system" as follows:

> In a distribution method in which compressed, digitized data is transmitted to a local distribution system, the phrase "inputting an item having information into the transmission system" means "putting physical items containing audio information or video information or both into the transmission system."

(4th CCO, at 12:10-12).

The Court's construction places no limitation that would require that the step of "inputting an item having information into the transmission system" be performed by the "transmission system," as Defendants contend. (Round 3 Defendants' Motion, at 45:20-22 and Satellite Defendants' Motion, at 16:13). The Court's construction is correct, because neither the claim nor the specification states that the transmission system must input items having information into itself.[40]

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[40] Defendants do not cite to the Court's construction as proof that the "transmission system" must input information into itself, because there is no such limitation in the Court's construction. Instead, the Round 3 Defendants cite to a prior stipulation of the parties, regarding a number of claim limitations. The Court, however, in construing this phrase, did not refer to the stipulation and it did not include any limitation that the step of inputting items having information into the transmission system" must be performed by the transmission system. It is worth noting that, when the Court wanted to include the limitation that the step be performed by the "transmission system," the Court made this explicit in its constructions. (*See*, e.g., construction for "placing the formatted data into a

The written description requirement is satisfied for claim 17 of the '863 patent, because the "original disclosure" of the Yurt Patents (including the originally-filed claims) reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the step of inputting an item having information into the transmission system. (*See* Weiss Decl., ¶¶ 58.60).

It is true that the disclosure of the Yurt Patents does not use the specific words or present drawings which explicitly state or depict that an item of information is input into the "transmission system" or, more specifically, is input into the "source material library" of the "transmission system" (the Court having construed the "transmission system" so as to require the presence of a source material library).[41] This fact, however, does not mean that the claim phrase "inputting an item having information into the transmission system" lacks written description, because, as described above in Sections IV.A.1: (1) the specification need not provide *in haec verba* support for the claimed subject matter;[42] (2) the written description can be met when the claimed subject matter is inherently contained in the original application;[43] (3) a specification need not include what is

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sequence of addressable data blocks" (3rd CCO, at 31) and "storing items having information in a source material library" (3rd CCO, at 30)).

[41] The Round 3 Defendants contend that Acacia is "judicially estopped" from changing its position on whether the specification of the Yurt Patents explicitly describes and depicts the input of items having information into the source material library. (Round 3 Defendants' Motion, at 46:16-48:2). Acacia is not changing its position, so whether Acacia is judicially estopped is not an issue in this Motion. Moreover, Acacia would like to correct Defendants' mischaracterization of Acacia's position. In the paragraph at 46:16-27 of the Round 3 Defendants' Motion, Defendants cite to Acacia's contentions regarding the construction of the term "storing" in claim 41 of the '992 patent at pages 22-23 of Acacia's Motion for Reconsideration and make the statement that "'Putting in,' however, is not supported by the specification," attempting to imply that Acacia had conceded that "putting in" is not supported by the specification. (*See*, Round 3 Defendants' Motion, at 46:24). Acacia, however, never stated or implied that "putting in" is not supported by the specification. (*See*, Acacia's Memorandum of Points and Authorities in Support for its Motion for Reconsideration, Docket No. 237, at 22:24-23:10). Acacia was only contending that the use of the two terms "inputting" and "storing" in the claims means that these terms should be construed so as to have different meanings, *i.e.*, that "storing" should be construed to mean "retaining" and "inputting" should be construed to mean "putting in."

[42] *See, e.g., All Dental Prodx*, 309 F.3d at 779; *Lampi*, 228 F.3d at 1378.

[43] *See, e.g., Schering*, 222 F.3d at 1352; *Tronzo*, 156 F.3d at 1159.

already known to and available to one of ordinary skill in the art;[44] and (4) the written description requirement is a highly intensive factual inquiry determined on a case-by-case basis that can be met in any manner.[45]

Here, it would have been inherent to one of ordinary skill in the art reading the specification in 1991 that the items having information that are stored in the source material library would have been input to the source material library. "In order for a disclosure to be inherent, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure." *Tronzo*, 948 F.2d at 1268. Necessarily present in the specification's disclosure of the items having information being stored (*i.e.*, retained) in the source material library (*i.e.*, "a collection of original sources of information") is the fact that the item having information must first have been input (*i.e.*, put into) the source material library. (Weiss Decl., ¶ 58-60; Exhibit B, at 1).

The Satellite Defendants further contend that the written description requirement cannot be met, because the specification does not describe "how" the items having information are input into the source material library. (Satellite Defendants' Motion, at 16:23-24; 17:20-22). However, the written description requirement is not concerned with "how" the claimed subject matter is performed, unless the claim so requires.[46] Here, there is no requirement in the claims that the inputting of the item having information into the transmission system be performed in any specific manner, and therefore the patentees were not required to describe "how" an item having information would have been input to the source material library to meet the written description requirement. The specification describes examples of the types of items having information that are stored in the source material library (6:2-22), and one of ordinary skill in the art in 1991 would have known how to input such items into a source material library. (Weiss Decl., ¶ 58-60).

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[44] *See, e.g., Koito*, 381 F.3d at 1155; *Christianson*, 822 F.2d at 1562.

[45] *See, e.g., Union Oil*, 208 F.3d at 1000-1001; *Capon*, 418 F.3d at 1357-58; *Wertheim*, 542 F.2d at 262.

[46] The written description requirement is only concerned with whether the specification reasonably conveyed to one of ordinary skill in the art that, at the time that the application was filed, the inventors were in possession of the claimed invention. *Vas-Cath*, 935 F.3d at 1563.

Defendants also contend that the enablement requirement is violated with respect to the step of "inputting an item having information into the transmission system." The enablement requirement is met, because one of ordinary skill in the art would have been able to perform the step of inputting an item having information into the transmission system without undue experimentation from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶64). One of ordinary skill in the art would certainly have known in 1991 how to input physical items, such as disks, tapes, etc. (6:2-22) into a source material library. (Weiss Decl., ¶¶ 58-64).

B. Claims 17-19 of the '863 Patent Are Not Invalid For Claiming "Assigning a Unique Identification Code to the Item Having Information."

Defendants contend that claim 17 of the '863 patent fails to meet the written description and enablement requirements, because the claim requires the step of "assigning a unique identification code to the item having information," which, Defendants contend, is not described in the specification. (Round 3 Defendants' Motion, at 48:5-49:10). According to Defendants, the Court construed the term "item having information" to be limited to a physical item,[47] but the specification never states that the identification is assigned to a physical item.

The specification describes the fact that the physical objects in the source material library are converted from their various media formats into specific media formats that are compatible with the inputs of the system. (6:8-22). The specification further describes how items stored in the source material library are encoded (assigned a unique identification code) by identification encoder 112:

> Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item must be stored in at

[47] Claims 18 and 19 of the '863 patent depend from claim 17. Claims 18 and 19 add the limitation to claim 17 that the item having information is ***not*** a physical item, but is either "blocks of digital data" (claim 18) or an analog signal that is converted to blocks of digital data (claim 19). Thus, Defendants' contention with respect to the item having information being a physical item can only address claim 17 and cannot address dependent claims 18 and 19.

> least one compressed data library 118, and given a unique identification code by identification encoder 112.
>
> * * *
>
> The items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form.

(‘992 patent, at 6:35-39; 6:62-64).

One skilled in the art in 1991 was well-aware of the use of “house numbers” and bar coding for identifying physical sources of media in the television industry, and thus would have been aware of and expected that the physical media would have been assigned unique identification codes. (Weiss Decl., ¶¶148-149). Thus, the written description requirement is satisfied for claim 17 of the ‘863 patent, because the “original disclosure” of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the step of “assigning a unique identification code to the item having information.” (Weiss Decl., ¶¶ 147-151).

The enablement requirement is also met, because one of ordinary skill in the art would have been able to assign a unique identification code to a physical item having information without undue experimentation from the specification (6:48-54 and 6:62-64) and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 152).

C. Claims 17-19 of the ‘863 Patent Are Not Invalid For Claiming a “Local Distribution System.”

Defendants contend that claim 17 of the ‘863 patent fails to meet the written description, enablement, and definiteness requirements, because the claim requires a “local distribution system” and, as Defendants contend, the specification does not disclose the distance of the reception system from the subscriber’s location in order to be “local.” (Round 3 Defendants’ Motion, at 49:11-50:7).

The Court construed the term “local distribution system” as follows:

> A reception system, as previously defined, located geographically close to the subscriber receiving stations[48] which are coupled to the reception system.

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[48] The Court separately construed the “subscriber receiving stations” to be “a receiving device at the subscriber’s location.” (4th CCO, at 10:21-23).

(4th CCO, at 8:6-8).

In construing the "local distribution system," the Court specifically construed the "local" limitation to "have its commonly understood meaning to skilled artisans in this field, namely, a geographic location in close proximity to the user or subscriber." (4th CCO, at 8:3-5). The Court further cited the use of the term "local" in the communications field:

> In the communications field, "local" is commonly understood as something in close proximity to a user's device. For example, "local access and transport area (LATA): (1) In the United States, a local geographic area in which a local telephone company is allowed to offer communications services;" "local area network (LAN); … (3) A communication network to interconnect a variety of intelligent devices (e.g., personal computers, workstations, printers, file storage devices) that can transmit data over a limited area, typically within a facility." IEEE 100: The Authoritative Dictionary of IEEE Standards Terms, 633 (7th ed. 2000).

(4th CCO, at 8 n. 3).

Further, the specification, in its examples, describes systems and communication methods which would have communicated to one of ordinary skill in the art what is meant by "local distribution system." For example, Figures 1d-f depict cable television systems that are described in the specification as having cable head ends (*i.e.*, "local distribution systems"). (4:14-51). (Weiss Decl., ¶ 153-154). The specification also described exemplary communication channels over which communications may be made from the transmission system to the reception system and/or from the reception system to the display device and/or recorder. (16:4-13; 16:62-68; Figure 2b). (Weiss Decl., ¶ 154). According to Mr. Weiss, "[i]n the configurations cited [in the '992 patent], it would have been clear to a person of ordinary skill in the art of the '992 patent, in January 1991, that the Reception Systems were at locations remote from the Transmission System and could be part of a redistribution function. It similarly would have been clear to such a person that the redistribution of the content from the Reception Systems to end users (subscribers) was local to the redistribution systems in juxtaposition to the remote locations of the redistribution systems relative to the Transmission System." (Weiss Decl., ¶ 155).

Thus, the written description requirement is satisfied for claim 17 of the '863 patent, because these disclosures in the specification of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of a "local distribution system." (Weiss Decl., ¶ 156).

The enablement requirement is also met, because one of ordinary skill in the art would have been able to make and use a local distribution system without undue experimentation from the specification (Figures 1d-1f, 2b; 4:14-51; 16:4-13; 16:62-68) and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶¶ 157-158).

Lastly, Defendants, in one sentence, contend that the claims having the term "local distribution system" are also invalid for indefiniteness. This contention was not included in Defendants' letters identifying the issues to be raised in these motions. (*See*, Exhibit 6 to Block Decl.). Some of the Defendants, during claim construction, urged the Court to find the "local distribution system" term to be indefinite.[49] (See, Round 2 Cable Defendants' Claim Construction Brief ('863 Patent), Docket No. 194, August 11, 2006, at 2:18-8:23). The Court, however, rejected this contention, and construed the term "local distribution system." (4th CCO, at 8:6-8). Defendants' indefiniteness contention in this brief is therefore actually an improper request for reconsideration of the Court's previous holding that the term "local distribution system" was definite and construable.

D. Claims 41 and 45-46 of the '992 Patent Are Not Invalid For Claiming "Storing Items Having Information in a Source Material Library."

Defendants contend that claims 41 and 45-46 of the '992 patent fail to meet the written description and enablement requirements, because the step of "storing items having information in a source material library" was interpreted to mean "retaining" the items having information, and, as Defendants contend, the specification does not describe any component capable of retaining, does not say how retaining is accomplished, and does not describe any action associated with retaining

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[49] The Round 3 Defendants who now contend that the "local distribution system" is indefinite, previously contended during claim construction that the term "local distribution system" was definite and, in fact, should be construed identically to the construction proposed by Acacia. (*See*, Round 3 Defendants' Claim Construction Memorandum Regarding the Asserted '863 Claims and the Previously-Construed Terms, D.I. 198, August 11, 2006, at 70:1-8).

(as described in Mr. Weiss' Declaration of May 18, 2007). (*See*, Round 3 Defendants' Motion, at 49:11-50:7).

The written description requirement is satisfied for claims 41 and 45-46 of the '992 patent, because the specification of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the step of retaining items having information in a source material library, as described at 5:66-6:2: "Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion and storage in a compressed data library means." (*See also*, Weiss Decl., ¶¶ 58-64). Whether the specification described "how" the retaining was achieved is irrelevant to the written description issue, as "how" retaining is achieved is not a limitation of claims 41 or 45-46.

Defendants also address enablement. The Court, in discussing the possibility of a motion on this step did not discuss an enablement motion. (5th CCO, at 17:5-6). The enablement requirement is met, because one of ordinary skill in the art would have been able to perform the step of storing (retaining) items having information in a source material library without undue experimentation from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶¶ 58-64).

E. Claims 41 and 45-46 of the '992 Patent Are Not Invalid For Claiming "Retrieving the Information in the Items from the Source Material Library."

Defendants contend that the specification of the Yurt Patents does not meet the written description and enablement requirements for the step of claim 41 of the '992 patent—"retrieving the information in the items from the source material library." (Round 3 Defendants' Motion, at 51:5-52:16; Satellite Defendants' Motion, at 13:9-16:2).

The written description requirement is satisfied for claim 41 of the '992 patent. For example, the specification describes an embodiment of the transmission system which is capable of retrieving information from the items in the source material library:

> To achieve the objects in accordance with the purposes of the present invention, as embodied and described herein, the transmission and receiving system for providing information to remote locations

> comprises ... ***identification encoding means for retrieving the information for the items from the source material library means*** ...

('992 patent, at 2:25-33; emphasis added). Elsewhere, the specification similarly describes the step of retrieving the information in the items from the source material library:

> As illustrated in FIG. 7, the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user of the distribution system (step 412).

('992 patent, at 18:53-56; Figure 7). Further, originally-filed claim 1 claimed a transmission system, including an identification encoding means "for retrieving the information for the items from the library means …" (Exhibit 3 to Block Decl.). These statements from the original disclosure reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of the step of retrieving the information in the items from the source material library. (*See*, Weiss Decl., ¶¶ 58-64).

The enablement requirement is also met with respect to the claim step of retrieving. The specification describes how the items in the source material library are converted or recorded "on a media format compatible to the digital and analog inputs of the system prior to being compressed and stored in compressed data library 118," such as, preferably, "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges." (6:15-22).

In one example, the specification teaches one of ordinary skill in the art how the information in a film (an item in the source material library) is retrieved using a telecine machine (a type of playback device which electronically records the images from a film) and how accompanying audio information is retrieved by passing the "audio information through an optical or magnetic digital playback device":

> If, for example, the retrieved information to be converted from the source material library 111 is a motion picture film, the picture frames in the film are passed through a digital telecine device to the digital input receiver 124. Format conversion is then preferably performed by digital video formatter 125b. Accompanying audio information is passed through an optical or magnetic digital playback device.

('992 patent, 7:35-43).

This example of retrieving information from a film using a telecine machine and retrieving audio information using an optical or magnetic digital playback device would have been sufficient for one of ordinary skill in the art to have understood that, for all of the types of materials in the source material library, a playback device would have been used to retrieve the information in the items having information in the source material library. (Weiss Decl., ¶ 58-64; 147); *See also, e.g., Cordis Corp.*, 339 F.3d at 1365 ("'A specification may, within the meaning of 35 U.S.C. § 112, para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses.'") One of ordinary skill in the art would have been aware of the playback devices required to retrieve the information in "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges" in 1991, as all of these formats and corresponding playback devices were known in 1991. (6:19-22); (Weiss Decl., ¶ 59-63).

Defendants further contend that: (1) because the specification describes the identification encoding means as being the structure that retrieves the information in the item, (2) because the identification encoder is the only structure disclosed in the specification corresponding to the identification encoding means, and (3) because the Court could not construe the identification encoder, the enablement (and written description) requirement cannot be met. (Round 3 Defendants' Motion, at 51:14-20; *See also*, Satellite Defendants' Motion, at 13:19-14:3). The Court, however, has held that the identification encoder performs ten functions, ***none*** of which are the retrieval of information in the items. (*See*, 2nd CCO, at 15:11-16:9). Further, even if required to perform the function of retrieving information in the items, the specification does meet the enablement and written description requirements. (Weiss Decl., ¶ 65, 68).

Defendants further contend that the specification does not describe how the "retrieving" step is initiated by a user request. Nothing in claim 41, however, requires a user request to the source material library or to the compressed data library, and therefore there is no requirement to provide a written description or enabling description of how the "retrieving information from the items in the source material library" step would be initiated. *See, e.g., Vas-Cath*, 935 F.3d at 1563.

Lastly, Defendants contend that there is no disclosure in the specification for assigning one unique identification code to the information from multiple items having information. No such requirement exists in the claims or patent specification. The Court construed the phrase of "assigning a unique identification code to the retrieved information" to mean "assigning a one-of-a-kind identifier to the information retrieved from ***an item*** that identifies the retrieved information through the conversion, ordering, compression, and storing processes." (1st CCO, at 14:14-17) (emphasis added). This is consistent with the specification, which states that each ***item*** is given a unique identification code: "Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112" (6:35-39) and "[a]s described in more detail later, a user may preferably access ***an item*** via ***its unique identification code*** [in the compressed data library 118], via its title, or the user may use other known facts for accessing an item." (11:22-25; emphasis added). Further, as described by Mr. Weiss, in claim 41, each item is assigned a unique identification code and each item is stored in its own file associated with the unique identification code for that item. (Weiss Decl., ¶ 175). Thus, the information is retrieved separately from each item and, as a result, each item is stored as its own file. (*Id.*)

F. Claim 46 of the '992 Patent Is Not Invalid For Claiming "Generating a Listing of Available Items."

Defendants contend that claim 46 of the '992 patent fails to meet the written description and enablement requirements, because, as Defendants contend, the specification does not describe the claim 46 step of "generating a listing of available items." (Round 3 Defendants' Motion, at 52:17-53:2).

The specification describes the step of "generating a listing of available items." For instance, the specification describes an example of a user searching for an item about Tibetan Medicine. In the process of searching for that item, a list of all available items matching the user's request is generated and displayed:

> If the user does not know the title of the desired item, he or she may request the item by naming other unique facts related to the item. For example, a user would be able to access an item about Tibetan Medicine by asking for all items which include information about "Tibet" and include information about "Medicine." The remote order processing and item database 300 would then be searched for all records matching this request. ***If there is more than one item with a match, each of the names of the matching items are preferably indicated to the user***. The user then selects the item or items that he or she desires.

('992 patent, 12:10-21) (emphasis added) (Weiss Decl., ¶ 159).

> In another example, the specification also describes generating a listing of available items in response to a user's search request from which the user may select their desired item:
>
> FIG. 4 is a flowchart of a preferred method of user request via a user interface of the present invention. In the preferred method of FIG. 4, the user first logs onto the user terminal interface (step 4010). After the user logs on, ***the user may preferably select a desired item by searching the database of available titles in the library system control computer 1123 or any remote order processing and item database 300*** (step 4020). The search may preferably be performed using the database containing the program notes, described above with respect to FIGS. 2a and 2b. ... ***After the desired item is found, the user selects the item*** for transmission at a specific time and location (step 4030).

('992 patent, at 15:3-22) (emphasis added).

The Yurt Patents also disclose updating the item database master with new entries. ('992 patent, 11:54-65). The item database master is a listing of available items. (Weiss Decl., ¶ 159).

The written description requirement is satisfied for claim 46 of the '992 patent, because the specification of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed that the inventors were in possession of the step of generating a listing of available items. (Weiss Decl., ¶ 159-161). As discussed above in Section IV.A.1., the written description requirement can be met even though the description in the specification is not identical to the claim language so long as persons skilled in the art recognize that what is claimed is described in the specification. *See, All Dental*, 309 F.3d at 779; *Schering*, 222 F.3d at 1352.

The enablement requirement is met, because one of ordinary skill in the art would have been able to perform the step of generating a listing of available items without undue experimentation from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 162).

G. Claim 11 of the '720 Patent Is Not Invalid For Claiming "Subscriber Selectable Receiving Stations."

The Satellite Defendants contend that claim 11 of the '720 patent violates the written description and enablement requirements, because the claim requires a "subscriber selectable receiving station," but the specification does not "describe how subscribers can designate specific receiving stations, what the devices are, or how one of skill in the art would design and make such devices." (Satellite Defendants' Motion, at 18:8-23:11).

The Court construed the "subscriber selectable receiving stations" to be a "receiving device or devices which can be designated by the subscriber." (4th CCO, at 15:5-6). According to the Court's construction for "subscriber receiving station," (upon which the Court based its construction for "subscriber selectable receiving station," 4th CCO, at 14:25-15:6), the receiving device is the device to which the receiving system outputs information (4th CCO, at 10:16-20, citing '863 patent, at 17:43-61). The specification states that the receiving system outputs information to a playback device or to a recorder ('992 patent, 18:36-38) and this is how Acacia understands the Court's use of the term "receiving device" in its construction.[50]

Defendants contend that there is no disclosure in the specification as to how a subscriber designates a receiving device or what components are used to select the receiving device. (Satellite Defendants' Motion, at 20:5-10). Defendants are wrong.

The specification describes certain optional embodiments whereby a user may, in their request, select a specific location having a receiving device. (Weiss Decl., ¶165). The description in the specification of the inclusion of the "address of the user," the "destination," or the "location of the playback" in the user's request all describe how a user can select the receiving device to which the information is to be sent, because: (1) receiving devices may have addresses, (2) the "address of the user" is not necessarily the same as the address of the receiving system, and (3) information is described as being sent to a "destination" where playback can occur, and playback can only occur on a receiving device:

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[50] According to Mr. Weiss, the term "subscriber selectable receiving stations" could describe both: (1) direct connection systems, i.e., where a reception system is directly connected to the display devices (television sets) or recording devices (videotape recorders) or (2) reception systems that redistribute the contents of the items to users through redistribution systems, for example, cable television or direct broadcast satellite systems. (Weiss Decl., at ¶ 163). In claim 11 of the '720 patent, there is a transmission of the information to a local distribution system then to at least one of a plurality of "subscriber selectable receiving stations" coupled to the local distribution system, and thus, the "subscriber selectable receiving stations" described in that claim must be referring to the second type of systems.

> A still further object of the present invention is to provide a picture and sound transmission system wherein the selected audio/video material is sent over any one of several existing communication channels in a fraction of real time to ***any location chosen by the user that has a specified receiver.***

('992 patent, 1:67-2:4; emphasis added).

> The user then selects the item or items that he or she desires. Upon selection and confirmation, by the user, a request for transmission of a particular item or items is sent to the distribution manager program of the system control computer 1123. The request contains the ***address of the user***, the address of the item, and optionally includes specific frame numbers, and a desired viewing time of the item.

('992 patent, 12:20-27; emphasis added).

> Once there is confirmation, the user enters the ***playback*** time and ***destination*** in step 3090. ... The confirmation performed in step 3100 includes confirmation of the entire transaction including the selected item, the selected time of playback, and ***the location of playback***.

('992 patent, 14:39-45; emphasis added).

> Once the chosen program is identified, the operator informs the user of the price. After the user confirms the order, the user indicates the desired delivery time and ***destination***. The operator then enters the user request into the system.

('992 patent, 14:58-62; emphasis added).

> To complete an order, the remote order processing and item database 300 preferably connects to the compressed data library 118 of choice via the library access interface 121 and communicates with the library system control computer 1123. Preferably, the user's account ID, identification of the item for transmission and ***the chosen destination for the item*** are communicated.

('992 patent, 15:23-29; emphasis added).

Further, in 1991, "conditional access" technology was available and widely known. (Weiss Decl., ¶166). This technology would permit information which is sent from a reception system over

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a communication path shared by many users such that individual users will only receive content that is addressed to them. (Weiss Decl., ¶¶ 165-166). Thus, the written description requirement is satisfied for claim 11 of the '720 patent with respect to the term "subscriber selectable receiving device," because, as shown above, the specification of the Yurt Patents reasonably conveyed to one of ordinary skill in the art, at the time that the application was filed, that the inventors were in possession of "subscriber selectable receiving stations." (Weiss Decl., ¶ 168).

Defendants further contend that the enablement requirement is not met for the "subscriber selectable receiving stations," because "the specification has *no* disclosure regarding what such devices are or how they would operate in an interconnected transmission and reception system." (Satellite Defendants' Motion, at 23:5-7). However, as discussed above, the "receiving device," as construed by the Court, is a playback device or recorder and the specification describes, in a number of places, how it is possible for a user, in an optional embodiment, include in their request a designation of their address or otherwise designate the destination or playback location for the requested item. (Weiss Decl., ¶165).

The enablement requirement is met, because the necessary "conditional access " technology was known in 1991 and one of ordinary skill in the art would have been able to make and use a system having a "subscriber selectable receiving station" without undue experimentation from the specification and the knowledge available to one of ordinary skill in the art in 1991. (Weiss Decl., ¶ 169).

VIII. EXCEPT AS TO THE COURT'S PRIOR FINDINGS WITH RESPECT TO "SEQUENCE ENCODER" AND "IDENTIFICATION ENCODER" (AND ITS INCLUSION IN EVERY CLAIM DUE TO THE COURT'S CONSTRUCTION OF "TRANSMISSION SYSTEM"), THE ASSERTED CLAIMS OF THE '992 AND '863 PATENTS ARE NOT INVALID FOR INDEFINITENESS.

A. The Parties Agree that All Asserted Claims Are Indefinite Under 35 U.S.C. § 112, ¶ 2 Based On the Court's Ruling that "Identification Encoder" is Indefinite, that "Transmission System" Includes an "Identification Encoder," and that "Central Processing Location" Includes a "Transmission System."

The Round 3 Defendants include in their motion two sections relating the indefiniteness of all of the asserted claims based on: (1) the Court's finding that the term "identification encoder" is indefinite and the fact that the Court's construction for "transmission system" includes an "identification encoder" as one of its components, and (2) the Court's finding that the term "sequence encoder" is indefinite. (*See*, Round 3 Defendants' Motion, at 54:1-23).

There is no dispute between the parties as to this issue, because Acacia has already stipulated that all of the asserted claims are indefinite based on these constructions.[51]

B. Claims 17-19 of the '863 Patent Are Not Indefinite For Claiming Transmitting "To At a Plurality of Receiving Stations."

Defendants re-visit the issue of whether the phrase of claim 17 of the '863 patent "using the stored compressed, digitized data to transmit a representation of the at least one item to at a plurality of subscriber receiving stations coupled to the local distribution system" is indefinite. Defendants previously raised this issue during claim construction (as described in the Round 3 Defendants' Motion, at 55, n 37), but the Court did not address this issue in any claim construction order and therefore the Court did not hold that this phrase is indefinite. (*See*, 4th CCO).

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[51] Acacia expressly reserved all rights on appeal and stated that its stipulation and Motion shall not serve as a waiver of any right that Acacia may have to object to or appeal from any of the above-mentioned rulings or any other finding or ruling set forth in the Court's 1st CCO, 2nd CCO, 3rd CCO, 4th CCO, 5th CCO, or 6th CCO that is not the subject of the stipulation or Motion.

Defendants misrepresent Acacia's contention with respect to the portion of the phrase "to at a plurality of subscriber receiving stations." Defendants address Acacia's oral argument statements as though Acacia were asking the Court to correct the claim language. (*See,* Round 3 Defendants' Motion, at 55:6-57:3). This is not Acacia's contention. Acacia asked the Court to interpret the claim phrase, as it is, to mean "transmitting a copy of the stored compressed digitized data[52] such that it is received by a plurality of subscriber receiving stations."

The presence of the words "to at" in this phrase do not render this phrase indefinite. According to Mr. Weiss, one of ordinary skill in the art would easily have understood the phrase to mean that "a copy of the stored compressed, digitized data representing an item of information was to be sent to multiple subscriber receiving stations through a local distribution system." (Weiss Decl., ¶ 172).[53]

The Round 3 Defendants are asking the Court to ***correct*** this phrase of claim 17 under 35 U.S.C. §§ 254 and 255 by changing the words of the claim such that the claim would read as either: (1) "transmitting to a plurality of subscriber receiving stations" or (2) "transmitting to at least one of a plurality of subscriber receiving stations." (*See*, Round 3 Defendants' Motion, at 56:3 – 57:3). But, Acacia is not asking the Court to correct the claim language under 35 U.S.C. §§ 254 and 255 by changing the words of the claim to correct an error, and then interpreting the changed claim; Acacia is only asking the Court to construe the claim as it is written, as described above.

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[52] In its 4th CCO, the Court did address the construction of the portion of the phrase "using the stored compressed, digitized data to transmit a representation" to mean "transmitting a copy of the stored compressed digitized data." (4th CCO, at 13:22-24).

[53] *See, e.g., Exxon Research*, 265 F.3d at 1375 ("Under a broad concept of indefiniteness, all but the clearest claim construction issues could be regarded as giving rise to invalidating indefiniteness in the claims at issue. But we have not adopted that approach to the law of indefiniteness. We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what we have asked is that the claims be amenable to construction, however difficult that task may be. If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds. [citations omitted]. By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity [citation omitted] and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.")

The *Novo* case cited by the Round 3 Defendants is inapplicable. In *Novo*, the patent claim, which included the phrase "stop means formed on a rotatable with," was indefinite. To overcome this indefiniteness, the patentee asked the court to correct the claim language pursuant to 35 U.S.C. §§ 254 and 255. The Court, however, held that it could not correct the claim language, because "the nature of the error is not apparent from the patent itself." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003).

Unlike the phrase in *Novo*, the phrase "to transmit a representation of the at least one item of audio/video information to at a plurality of subscriber receiving stations" in claim 17 is not indefinite, because it would have been understood by a person of ordinary skill in the art in 1991, when the claim is read in light of the specification, as described by Mr. Weiss. (Weiss Decl., ¶ 172). Sending the information such that it is received by a plurality of users is fully described in the specification. (*See, e.g.*, 4:52-57; 15:46-54; and 15:61-64) (Weiss Decl., ¶ 172).

C. Claims 41 and 45-46 of the '992 Patent Are Not Indefinite for the Additional Reasons Alleged by Defendants.

1. The Step of "Storing Items Having Information In A Source Material Library" In Claim 41 of the '992 Patent Is Not Indefinite.

Defendants contend that the step of claim 41 of "storing items having information in a source material library" is indefinite, because: (1) the Court held that the step of "storing items having information in a source material library" of claim 41 of the '992 patent means "retaining items" (5th CCO, at 17:7-11), and (2) the Court held that, in claim 41 of the '992 patent, "a step, which is an antecedent to a succeeding step, must commence before the succeeding step commences, and the antecedent step must finish before the succeeding step can finish." (3rd CCO, at 29:23-26).

Defendants attempt to adopt their own interpretation of the Court's construction and contend that the step of "retaining" is an ongoing process that never finishes. Thus, according to Defendants, it would be impossible for any of the next steps of claim 41 to ever finish. (Round 3 Defendants' Motion, at 57:13-17).

Nothing in the specification, in the language of claim 41 of the '992 patent, in the Court's construction of the phrase "storing items having information in a source material library," or in the ordinary meaning of the term “retaining” ***requires*** that the step of “retaining” be an ongoing process that never finishes. This is merely Defendants’ misinterpretation of the Court’s construction.

Because claims must be read in view of the specification, if Defendants’ interpretation of the meaning of “retaining” were correct then there should be some statement in the specification which would cause one of ordinary skill in the art to have understood that the step of “storing items that information in a source material library” is an ongoing process that never finishes. *See, e.g., Phillips,* 415 F.3d at 1315 (“claims ‘must be read in view of the specification, of which they are a part.’”). Here, however, the specification describes the exact opposite, *i.e*., that storage (*i.e*., “retaining”) of items in the source material is “temporary” and describes how, once the items of information are retrieved, the remaining steps of claim 41 are performed:

> Transmission system 100 of a preferred embodiment of the present invention preferably includes source material library means for ***temporary storage of items prior to conversion and storage in a compressed data library means***. The items of information may include analog and digital audio and video information as well as physical objects such as books and records which require conversion to a compatible media type before converting, compressing and storing their audio and video data in the compressed data library means.

(5:66-6:7) (emphasis added).

The specification at 18:53-19:29 describes the steps of claim 41, which occur after the storing step and depicts those steps in Figure 7. If, as Defendants contend, the storing step is an ongoing process that never finishes, then the inventors would not have described in the specification any of the steps of claim 41 as occurring, because according to Defendants, it is impossible for these steps to even occur. Defendants’ interpretation of the Court’s construction of the phrase “storing items having information in the source material library” is clearly wrong and the Court must reject it.

Consistent with the specification, one of ordinary skill in the art would have understood that the “retaining” step of claim 41 must finish when the process of retrieving the data representing the item was completed, because the patent teaches that the retaining of items in the source material library is to be only temporary and, once the information is retrieved, there would be no further need for the source material to be retained. (Weiss Decl., ¶¶ 173-174). There is thus nothing indefinite about the step of "storing items having information in the source material library."

2. Dependent Claim 45 Of The '992 Patent Is Not Indefinite

Defendants contend that claim 45 is indefinite, based on their prior briefing of the indefiniteness issue. (*See*, Round 3 Defendants' Motion, at 57:17-58:2; and D.I. No. 246, July 18, 2007, at 37:3 – 39:23). Claim 45 of the '992 patent adds the step of "separately storing a plurality of files, each including compressed, sequenced data blocks" to the claim 41 step of "storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code."

The Court, in its 3rd CCO addressed the parties' contentions regarding claim 45, but "declined to construe the phrase 'separately storing a plurality of files' as arguably indefinite," based on the Court's belief that the "[t]he specification does not describe storage in multiple files." (3rd CCO, at 33:2-12 and '992 patent, 10:23-26 and 10:36-39). The Court relied on two portions of the specification as evidence that the specification does not describe "storage in multiple files"—10:23-26 and 10:36-39 – however, those portions relate to the "compressed data storage means 117," not to the compressed data library 118:

> After compression processing by compressor 116, the compressed audio and video data is preferably formatted and ***placed*** into a single file by the ***compressed data storage means 117***. ... After the data is ***processed*** into a file by the ***compressed data storage means 117***, it is preferably ***stored*** in a compressed data library 118.

(10:23-26 and 10:36-39) (emphasis added).

Claim 45 uses the term "storing," but neither sentence from the specification relied upon by the Court states that the compressed data storage means 117 ***stores*** data only a single file; instead, these sentences state that the compressed data storing means 117 either: (1) "***places***" data into a file; or (2) "***processes***" data into a file. Therefore, claim 45 cannot be referring to the compressed data storing means 117 or the functions of "placing" or "processing," which are performed by this component. The sentence at 10:36-39, relied upon by the Court, does disclose that the act of "storing" files occurs in the compressed data library 118: "After the data is processed into a file by the compressed data storage means 117, it is preferably ***stored in a compressed data library 118***."

In the same paragraph, quoted above, the inventors disclosed that the compressed data library 118 separately stores ***multiple*** files. (10:31-45).

The fact that claim 45, which refers to separately storing a plurality of files, is supported in the specification by the reference to the compressed data library 118, which stores multiple files, (and not the compressed data storage means, which places or processes data into a file) is confirmed by the presence of claim 6 of the '992 patent and the statement in the file history of the '992 patent that claim 45 corresponds to claim 6.[54] Claim 6 claims a "transmission system" and adds the limitation that the compressed data storing means further includes "compressed data library means for separately storing a plurality of files, each including at least one compressed, sequenced data block." The Court recognized that claim 6 claims the compressed data library means 118 as the component of the transmission system which is "capable of storing (holding) more than one file. In other words, 'separately storing a plurality of files' is an attribute of the compressed data storing means 118." (3rd CCO, at 33 n. 12).

Further, the plurality of files being described in claim 45 are not the files created in claim 41 and the claim 45 files do not include the compressed, sequenced data blocks created in the steps of claim 41. This is clear from the fact that the term "compressed, sequenced data blocks" in claim 45 does not have antecedent basis to the data blocks in claim 41, *i.e.*, claim 45 does not state: "separately storing a plurality of files, each including ***the*** compressed, sequenced data blocks." Therefore, claim 45 must be describing different files than the file described in claim 41.

Accordingly, one of ordinary skill in the art in 1991, reading claim 45 together with the specification of the '992 would have understood the phrase of claim 45 "separately storing a plurality of files, each including compressed, sequenced data blocks" to mean that "in addition to the files created and stored by a transmission system, that transmission system could separately store other files, perhaps created elsewhere, each including compressed, sequenced data blocks, and each presumably including the unique identification code assigned to the item." (Weiss Decl., ¶¶ 175-177).

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[54] When the patentees added claim 45 to the application which issued as the '992, the patentees stated that claim 45 corresponded to claim 6: "Dependent claims 42, 43, 45, 46, and 55-57, respectively, correspond generally to claims 3, 4, 6, 7, 19, 26, 29, and 31." (Amendment dated September 30, 1991 at pp. 17-18; Exhibit 7 to Block Decl.).

3. Dependent Claim 46 Of The '992 Patent Is Not Indefinite.

Defendants contend that claim 46 of the '992 patent is indefinite. (Round 3 Defendants' Motion, at 58:3-10). This is yet another issue which Defendants did not identify in any of their letters as a ground for any proposed Section 112 motion. (Exhibit 6 to Block Decl.).

In their current motion for summary judgment, the Round 3 Defendants, for the first time in this litigation, contend that claim 46 is indefinite, because it requires retrieving data blocks corresponding to requests from users. According to Defendants, there is no way of knowing whether the data blocks retrieved in claim 46 relate to the single file that is sent to the "one" "remote location" in claim 41.

Claim 46 is clear and understandable. In addition to the steps of claim 41 and claim 45, claim 46 requires that three additional steps occur: (1) a listing of available items is generated, (2) transmission requests to transmit available items (from the plurality of files stored in claim 45 and the file of claim 41) are received, and (3) stored formatted data blocks data blocks corresponding to requests from users are retrieved. The retrieval of data blocks corresponding to a portion of a file or to the entire file is disclosed in the specification. (*See, e.g.*, 8:32-50; 15:61-64; Weiss Decl., ¶ 179). The receipt of user requests based upon the list of available items is also disclosed in the specification (12:8-27; 15:3-11; Weiss Decl., ¶ 180).

Thus, as Mr. Weiss states in his declaration, one of ordinary skill in the art would have understood the phrase of claim 46, "retrieving stored formatted data blocks corresponding to requests from users" in light of the specification as meaning that "stored formatted data blocks containing the particular content requested by users were to be retrieved from the files containing the requested items or parts thereof." (Weiss Decl., ¶¶ 178-181).

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IX. CONCLUSION

For the foregoing, Acacia respectfully requests that the Court deny Defendants' Motions for Summary Judgment in their entirety.

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